

MALAYSIA

TRADEMARKS REGULATIONS 2019

Enter into force on 27 December 2019

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PART I PRELIMINARY

1. Citation and commencement

(1) These regulations may be cited as the Trademarks Regulations 2019.

(2) These Regulations come into operation on 27 December 2019.

2. Interpretation

In these Regulations, unless the context otherwise requires—

“agent” means a registered trademark agent whose name is entered in the Register of Trademark Agents;

“Journal” means the Intellectual Property Official Journal published by the Registrar under section 148 of the Act; and

“transformation application” means an application to register a trademark where that trademark was the subject of an international registration prior to that international registration being cancelled.

3. Prescribed fees

(1) The fees payable under these Regulations shall be as prescribed in the First Schedule and in respect of international registration in the Second Schedule.

(2) The fees paid shall not be refunded except as provided for in regulation 16.

PART II REGISTRATION OF TRADEMARKS

Division 1 Registrability of trademarks

4. Signs subject to absolute grounds for refusal of registration

(1) The Registrar shall refuse to register a trademark if the trademark contains or consists of any of the following signs or a sign similar to any of those signs as is likely to be taken for that sign, unless in relation to paragraphs (m), (n), (o) and (p) consent of the person or authority entitled to give such consent has been obtained for the use of the sign for the purposes of registration and use of the trademark:

(a) the words "To counterfeit this is a forgery", "Registered Trademark", "Registered Service Mark", or any words to the like effect in any language;

(b) the words "Bunga Raya" and the representations of the hibiscus or any colourable imitation of the hibiscus;

(c) representations of or words referring to Seri Paduka Baginda Yang di-Pertuan Agong, Ruler of a State or any colourable imitation of such representations or words;

(d) the representations of any of the royal palaces or of any building owned by the Federal Government or State Government or any foreign government or any colourable imitation of such representations;

(e) the word "ASEAN" and the representation of the ASEAN logotype or any colourable imitation of such word and representation;

(f) the words "Red Crescent" or "Geneva Cross";

(g) representations of Red Crescent, Geneva Cross and other crosses in red or such representations in similar colour or colours;

(h) the words "Swiss Federal Cross", and representations of the Swiss Federal Cross in white or silver and on a red ground, or similar colour or colours;

(i) representations of the "national emblem" as defined in section 2 of the National Emblems (Control of Display) Act 1949;

(j) representations of the "specified emblem" as defined in section 2 of the Emblems and Names (Prevention of Improper Use) Act 1963

(k) representations of, or mottoes of or words referring to the badge or devices to indicate that any person is a member of the Police Force as provided for under section 89 of the Police Act 1967

(l) representations of, or mottoes of or words referring to the decorations, badge or emblems as provided for under the Armed Forces

Act 1972;

(m) name, initials and flags of, and representations of the name, initials and flags of, any international organization or Convention country including any city, borough, town or place of the Convention country;

(n) armorial bearings, insignia, orders of chivalry, decorations or flags of, or representations of the armorial bearings, insignia, orders of chivalry, decorations or flags of, any Convention country including any city, borough, town or place of the Convention country;

(o) name, initials or devices of, or representations of the name, initials or devices of, any society, body corporate or institution; and

(p) pictorial representation of any person, whether living or dead.

(2) Relating to paragraphs 1(g) and (h), where there appears in a trademark, the registration of which is applied for, a representation of a crescent or a cross in any colour, not being one of those referred to in paragraphs (1)(g) and (h), the Registrar may require the applicant, as a condition of acceptance, to undertake not to use the crescent or cross device in red, or in white or silver on a red ground, or in any similar colour or colours.

5. Criteria of well-known trademark

In determining whether a trademark is well-known in Malaysia, the Registrar or the Court shall have regard to the following criteria:

(a) the extent of knowledge or recognition of the trademark in the relevant sector of the public;

(b) the duration and extent, and geographical area of any use of the trademark;

(c) the duration and extent of any promotion of the goods or services where the trademark applies and the geographical area where the promotion is carried out;

(d) the duration and place of registration, or duration and place of application for registration, of the trademark, to the extent that they reflect use or recognition of the trademark;

(e) the record of successful enforcement of rights in the trademark, in particular, the extent to which the trademark was recognized as well-known by competent authorities; and

(f) the value associated with the trademark.

6. Use of trademark on internet

(1) In relation to the use of a sign or trademark on the internet, the Registrar or the Court shall have regard to the provisions of the Act, these Regulations and the Joint Recommendation.

(2) In this regulation, "Joint Recommendation" means the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet adopted at the Thirty-Sixth Series of Meetings of the Assemblies of the Member States of the World Intellectual Property Organization on 24 September to 3 October 2001.

Division 2 Application for registration

7. Application for registration

(1) An application for the registration of trademark including a series of trademarks shall be filed with the Registrar accompanied by payment of the prescribed fee.

(2) An applicant, upon filing the application under subregulation

(1) shall provide—

(a) a clear indication of the nature of the trademark;

(b) graphical representation of the trademark; and

(c) for trademark relating to colour, the limitation as to the colour of the trademark.

8. Application for expedited examination

(1) An applicant for the registration of trademark may, except for collective mark, certification mark and sign which are colour, sound, scent, hologram, positioning or sequence of motion, request the Registrar, accompanied by payment of the prescribed fee, for an expedited examination.

(2) A request for expedited examination shall only be made to the Registrar based on the following grounds:

(a) the request is in the national or public interest;

(b) there are infringement proceedings taking place or evidence showing potential infringement in respect of the trademark applied for; or

(c) registration of trademark is a condition to obtain monetary benefits from the Government or institutions recognized by the Registrar.

(3) Each request for an expedited examination may be made in the same application in respect of goods or services in more than one class accompanied by payment of the prescribed fee.

9. Representation of trademark

(1) The applicant shall provide a clear and durable graphical representation of the trademark in the column provided for that purpose in the application for registration of trademark.

(2) Where the Registrar reasonably believes that the representation

provided by the applicant does not sufficiently show the particulars of the trademark or does not allow all the features of the trademark to be properly examined, the Registrar may, by provisional refusal, require the applicant to provide within such time as the Registrar may specify in the provisional refusal, any or all of the following:

- (a) another representation of the trademark consisting of a single view of the trademark or of several different views of the trademark;
- (b) a description of the trademark expressed in words;
- (c) such other information as the Registrar may require.

(3) The Registrar may at any time, by provisional refusal, if dissatisfied with any representation of a trademark, require the applicant to file another representation satisfactory to the Registrar before examining the application, and the applicant shall file an application with the Registrar to amend the application for registration of trademark, accompanied by payment of the prescribed fee, to substitute the representation.

(4) If the applicant fails to respond to the provisional refusal, the application shall be deemed withdrawn.

10. Claim to priority

(1) Where a right of priority is claimed by reason of an application for the registration of trademark filed in a Convention country or declared foreign country, the applicant shall include the particulars of that claim in the application for registration of trademark at the time of filing the application or not later than three days from the date of filing of such application.

(2) The particulars referred to in subregulation (1) are as follows:

- (a) the Convention country or declared foreign country and the date of filing of the priority application, or where there is more than one priority application, the date of filing of each priority application;
- (b) the goods or services in respect of which the right of priority is claimed which is based on—
 - (i) the right of priority in respect of some or all of the goods or services for which registration was sought in the priority application; or
 - (ii) the right of priority of more than one priority application.

(3) For the purposes of claiming the date of priority, after the date of filing of the application but within three days of such filing, the applicant shall file a request to amend the application accompanied by payment of the prescribed fee.

(4) The Registrar may, if dissatisfied with the particulars given under subregulation (2), require the applicant to file a certificate of the competent authority of the Convention country or declared foreign country concerned certifying or verifying—

- (a) the date of filing of the priority application;
- (b) the representation of the trademark; and
- (c) the goods or services covered by the priority application.

(5) If the Registrar requires the applicant to file the certificate in subregulation (4), the applicant shall file the certificate within two months from the date of the provisional refusal failing which the Registrar shall not consider the priority date claim.

(6) Where the certificate referred to in subregulation (4) is not in the English language, there shall be annexed to the certificate a translation in English of the contents of the certificate.

11. Classification of goods or services

(1) Every application for registration of trademark, for each class of goods or services to which the application relates, shall contain the following:

- (a) class number as provided in the classification of goods or services as specified in the Third Schedule; and
- (b) a specification of those goods or services—
 - (i) which is appropriate to that class; and
 - (ii) which is described in such a manner—
 - (A) as to indicate clearly the nature of those goods or services; and
 - (B) as to allow those goods or services to be classified in accordance with the classification system as specified in the Third Schedule.

(2) For the purposes of paragraph (1)(b), the classification of goods or services as specified in the Third Schedule, which shall include such classification as set out in a pre-approved list made

available by the Registrar, from which a specification may be adopted by the applicant.

(3) An application under subregulation (1) may be made in respect of more than one class of goods or services from the classification of goods or services as specified in the Third Schedule, and in such a case, paragraph (1)(b) shall apply for each class of the goods or services to which the application relates.

(4) In the case of an application for registration in respect of all the goods or services included in a particular class in the Third Schedule, or of a large variety of goods or services, the Registrar may refuse the application unless the Registrar is satisfied that the specification is justified by the use of the trademark which the applicant has made, or intends to make if and when the trademark is registered.

(5) When a trademark is registered, the trademark shall be classified according to the version of the system of classification of goods or services as specified in the Third Schedule which is in force on the date of filing of the application for registration of such trademark.

(6) In this regulation, "specification" means the specification of goods or services in respect of which a trademark is registered or intends to be registered.

12. Translation and transliteration

(1) Where a trademark contains or consists of a word which is not in Roman characters, or the national language or English language, the applicant shall, unless the Registrar otherwise directs, upon filing the application for registration of the trademark, furnish the Registrar with the following information:

- (a) a translation of the word in the national language or English language;
- (b) a transliteration of the word, if the case requires; and
- (c) the language to which the word belongs.

(2) If the applicant fulfills the requirement under subregulation (1) on different days, the date of filing shall be subject to subregulation 14(5).

(3) The Registrar may, if dissatisfied with the translation or transliteration, require the applicant to file a copy of the translation or transliteration, certified or verified to the satisfaction of the Registrar.

(4) Where the applicant fails to furnish a copy of the translation or transliteration, the application shall be deemed withdrawn.

13. Voluntary disclaimer

(1) The applicant may disclaim any right to the exclusive use of any specified element of the trademark upon filing the application for registration of trademark.

(2) Where the applicant does not make any disclaimer, the Registrar shall proceed with the application for registration of trademark.

(3) Where relating to the application for registration of trademark, the Registrar issues a provisional refusal, the applicant may apply for voluntary disclaimer accompanied by a request for an amendment of the application for registration of trademark, accompanied by payment of the prescribed fee.

14. Non-compliance affecting application for registration of trademark

(1) Where an application for registration of trademark does not comply with subsection 17(2) or (3) of the Act or regulation 7, 9, 11 or 12, the Registrar shall send a provisional refusal in a written notice to the applicant to remedy the non-compliance or, in the case of subsection 17(2) of the Act, to remedy the default of payment, within the period as specified in the provisional refusal.

(2) The Registrar may accept or refuse any response by the applicant to the written notice.

(3) Where, after the expiry of the period specified under subregulation (1), the applicant fails to remedy any non-compliance or default of payment, the application affected by the provisional refusal shall be deemed withdrawn.

(4) Before the expiry of the period to remedy the non-compliance or

default of payment, the applicant may apply, accompanied by payment of the prescribed fee, for an extension of time for a period not exceeding one month, subject to under regulation 59.

(5) If the applicant remedies the non-compliance or makes payment within the extended period, the Registrar shall issue a new date of filing of the application for registration of trademark which shall be the date of the remedial of the non-compliance or the making of payment.

15. Application for grounds of decision of Registrar

(1) Where the Registrar refuses to register a trademark, the applicant shall be notified of the decision in writing.

(2) The applicant may, within two months from the date of being notified of the decision of the Registrar, file a request for the written grounds of such decision accompanied by payment of the prescribed fee.

16. Refund of fee under section 13 of the Act

(1) Where in respect of an application for preliminary advice and search by an applicant, for the purpose of applying for registration of trademark, the Registrar issues an affirmative result—

(a) the applicant, relying on the affirmative result, files an application for registration of trademark as soon as the Registrar issues the affirmative result;

(b) upon examining the application for registration of trademark under paragraph (a), the Registrar issues a provisional refusal raising grounds in section 23 or 24 of the Act; and

(c) pursuant to the issuance of the provisional refusal under paragraph (b) and subject to the applicant filing an application of withdrawal of the application for registration of trademark within two months from the date of issuance of the provisional refusal, the applicant shall be entitled to a refund of the fee paid for the filing of the application for registration of trademark.

(2) The request for the refund of fee of filing for the application for registration of trademark shall be made to the Registrar accompanied by payment of the prescribed fee.

(3) The Registrar shall not allow any extension of time for the

purposes of this regulation.

Division 3 Examination of application for registration

17. Applicant's response during examination

(1) Where the Registrar refuses to register a trademark, the Registrar shall issue a provisional refusal in a written notice which shall also contain the grounds for the provisional refusal to which the applicant may respond—

(a) by making representations either in writing, or by applying to the Registrar for a hearing accompanied by payment of the prescribed fee;

(b) by amending the application for registration of trademark so as to meet the conditions, amendments, modifications or limitations imposed or directed by the Registrar through an application to amend the application for registration of trademark accompanied by payment of the prescribed fee; or

(c) by furnishing additional or any other information or evidence by way of statutory declaration or, viva voce in lieu of or in addition to the statutory declaration.

(2) The applicant may apply for an extension of time accompanied by payment of the prescribed fee to extend the time specified by the Registrar in the written notice for a period not exceeding six months.

(3) Upon receiving the application for a hearing, the Registrar shall give a notice to the applicant fixing a date on which the Registrar will hear the applicant's representation.

(4) After considering the applicant's response, the Registrar shall accept or refuse to register the trademark.

(5) Where the Registrar refuses to register the trademark, such refusal shall be a total provisional refusal and the total provisional refusal shall be notified to the applicant in writing.

(6) The applicant may, within two months from the date of issuance of the decision of the total provisional refusal, file, accompanied by payment of the prescribed fee, a request for the Registrar's written grounds of decision of the total provisional refusal.

(7) The Registrar shall not allow an extension of time for the

purpose of subregulation (6).

(8) The date on which the Registrar's written grounds of decision of the total provisional refusal is issued to the applicant shall be deemed the date of the Registrar's decision for the purpose of an appeal to Court.

(9) Any appeal to the Court against the Registrar's decision shall be made within one month from the date the Registrar's written grounds of decision of the total provisional refusal is issued to the applicant.

(10) An applicant may apply to the Registrar for an extension of time as specified in subregulation (9) to file an appeal to Court accompanied by payment of the prescribed fee and the Registrar may grant such extension for a period not exceeding two months.

18. Acceptance and publication of application

(1) Upon the examination of an application for registration of trademark, where the Registrar is satisfied that the application fulfills the requirements for registration, the Registrar may accept the application whether absolutely or subject to conditions, amendments, modifications or limitations.

(2) After an application for registration of trademark is accepted and published in the Journal, the Registrar may give written notification of the publication to the applicant.

19. Revocation of acceptance

(1) Where pursuant to subsection 29(12) of the Act, the acceptance for registration of trademark is revoked, the Registrar shall publish such revocation in the Journal and issue a written notice of provisional refusal to the applicant.

(2) Where the Registrar refuses to register a trademark, the applicant may, within the time specified in the written notice, respond—

(a) by making representations either in writing, or by applying to the Registrar for a hearing accompanied by payment of the prescribed fee;

(b) by amending the application so as to meet the conditions,

amendments, modifications or limitations imposed or directed by the Registrar through an application to amend the application for registration of trademark accompanied by payment of the prescribed fee; or

(c) by furnishing additional or any other information or evidence by way of statutory declaration or, viva voce in lieu of or in addition to the statutory declaration.

(3) The application shall be deemed as withdrawn if the applicant does not respond within such period as specified in the written notice.

(4) Upon receiving the application for a hearing under paragraph (2) (a), the Registrar shall give a notice to the applicant of the date fixed for the Registrar to hear the applicant's representation.

(5) After considering the applicant's response, the Registrar shall accept or refuse to register the trademark.

(6) Where the Registrar refuses to register a trademark, such refusal shall be a total provisional refusal and the total provisional refusal shall be notified to the applicant in writing.

(7) The applicant may, within two months from the date of issuance of the decision of the total provisional refusal, file, accompanied by payment of the prescribed fee, a request for the Registrar's written grounds of decision.

(8) The Registrar shall not allow an extension of time for the purpose of subregulation (7).

(9) The date on which the Registrar's written grounds of decision of the total provisional refusal is issued to the applicant shall be deemed the date of the Registrar's decision for the purpose of an appeal to Court.

(10) Any appeal to the Court against the Registrar's decision shall be made within one month from the date the Registrar's written grounds of decision of the total provisional refusal is issued to the applicant.

Division 4 Withdrawal of application, restriction of goods or services covered in an application and amendment of application

20. Withdrawal or restriction of application for registration of trademark

(1) Where any person on whom any right or interest has been vested applies for a withdrawal of the registration of trademark or for restriction of the goods or services covered by the application for registration of trademark, such person may notify the Registrar of such withdrawal or restriction.

(2) The person referred to in subregulation (1) shall file with the Registrar, accompanied by payment of the prescribed fee, the application to withdraw or restrict the application of such person.

(3) The Registrar may require the person referred to in subregulation (1) to furnish such information as the Registrar thinks fit before accepting the withdrawal or restriction.

(4) Where the Registrar accepts the application for withdrawal or restriction, the Registrar shall record such withdrawal or restriction.

21. Restriction of goods or services covered by application after publication

(1) Upon the recording under subregulation 20(4) and the publication under subsection 32(4) of the Act by the Registrar of any restriction of goods or services, any person may oppose such restriction.

(2) Any person who wishes to make an opposition against any restriction of goods or services shall, within two months after the date of publication of the notice of restriction of goods or services, file with the Registrar a notice of opposition.

(3) The notice of opposition shall contain a statement of the grounds upon which the person opposes the restriction of goods or services, including, where relevant, how the restriction of goods or services would become grounds of opposition.

(4) Regulations 23 to 34 shall apply to a notice of opposition under

this regulation as follows:

(a) references to the application for registration of trademark in subregulations 26(3) and (4) and subregulation 29(1) shall be construed as references to the application for a restriction of goods or services referred to in regulation 20;

(b) references to the date of publication of the acceptance of the application for registration of trademark in subregulation 23(1) shall be construed as references to the date of publication of the restriction of goods or services;

(c) references to the notice of opposition in regulation 23, subregulations 24(1), 29(3) and 32(1) and regulation 34 shall be construed as references to the notice of opposition referred to in subregulations (2) and (3); and

(d) references to the opponent in subregulations 23(3), (7), (8) and (9), subregulations 24(1), (2) and (3), subregulations 25(1), (2) and (3), subregulations 26(2) and (3), subregulation 27(1), regulation 28, subregulations 29(2) and (3), regulation 30, subregulations 31(1) and (3), subregulation 32(1), paragraphs 32(1)(a) and (b), subregulation 33(4) and regulation 34 shall be construed as references to the person referred to in subregulations (2) and (3).

22. Amendment of application after publication

(1) Where an application for an amendment is made to the application for the registration of trademark, in respect of which the acceptance of such application for registration has been published in the Journal, and such application for amendment is to amend the representation of such trademark but which does not substantially affect the identity of the trademark or extend the goods or services covered by the application for registration of trademark, such application for amendment shall also be published in the Journal.

(2) Any person who wishes to oppose the amendment under subregulation (1) shall, within two months after the date of publication of the amendment, file with the Registrar a notice of opposition to the amendment.

(3) The notice of opposition shall contain a statement of the grounds upon which the person opposes the amendment, including, where relevant, how the amendment would become grounds of opposition.

(4) Regulations 23 to 34 shall apply to a notice of opposition as follows:

(a) references to the application for registration of trademark in subregulations 26(3) and (4) and subregulation 29(1) shall be construed as references to the application for amendment referred to in subregulation (1);

(b) references to the date of publication of the acceptance of the application for registration of trademark in subregulation 23(1) shall be construed as references to the date of publication of the amendment;

(c) references to the notice of opposition in regulation 23, subregulations 24(1), 29(3) and 32(1) and regulation 34 shall be construed as references to the notice of opposition referred to in subregulations (2) and (3); and

(d) references to the opponent in subregulations 23(3), (7), (8) and (9), subregulations 24(1), (2) and (3), subregulations 25(1), (2) and (3), subregulations 26(2) and (3), subregulation 27(1), regulation 28, subregulations 29(2) and (3), regulation 30, subregulations 31(1) and (3), subregulation 32(1), paragraphs 32(1)(a) and (b), subregulation 33(4) and regulation 34 shall be construed as references to the person referred to in subregulations (2) and (3).

Division 5 Opposition

23. Filing of notice of opposition

(1) A notice of opposition to the application for registration of trademark which shall include the statement of the grounds of such opposition shall be filed, accompanied by payment of the prescribed fee, with the Registrar within two months from the date of the publication of the acceptance of such application for registration of trademark.

(2) For the purpose of filing a notice of opposition, the Registrar shall not allow an extension of time for more than two months after the expiry of the period for filing the notice of opposition.

(3) An opponent who opposes the registration of trademark for goods or services in more than one class shall pay the prescribed fee for each class.

(4) Where a notice of opposition is filed on the basis of a registered trademark, there shall be included in the statement of the grounds of such opposition a representation of that trademark and the following particulars:

- (a) the details of the authority with which the trademark is registered;
- (b) the registration number of that trademark; and
- (c) the goods or services in respect of which that trademark is registered and the opposition is based.

(5) Where the opposition is based on a trademark in respect of which an application for registration of trademark has been made, there shall be included in the statement of the grounds of opposition a representation of that trademark and the particulars in paragraphs (4) (a) to (c).

(6) Where the opposition is based on an unregistered trademark or other sign or by virtue of earlier rights under subsection 24(4) of the Act, there shall be included in the statement of the grounds of opposition a representation of that trademark or sign and the goods or services in respect of which protection is claimed.

(7) If the opponent fails to comply with any requirement relating to

the notice of opposition, the opposition shall be deemed never to have been made.

(8) At the same time as the filing of the notice of opposition, the opponent shall send a copy of the notice of opposition to the applicant.

(9) The opponent shall file with the Registrar an affidavit of service, within fourteen days from the date of sending the copy of the notice of opposition to the applicant, where the affidavit of service shall contain proof of the date of receipt by the applicant of the notice of opposition, and failure to do so shall result in the opposition deemed withdrawn.

24. Filing of counterstatement

(1) The applicant shall, within the period of two months from the date of receipt of the notice of opposition from the opponent, file a counterstatement with the Registrar accompanied by payment of the prescribed fee.

(2) At the same time as the filing of the counterstatement, the applicant shall send a copy of the counterstatement to the opponent.

(3) The applicant shall file with the Registrar an affidavit of service, within fourteen days from the date of sending the copy of the counterstatement to the opponent, where the affidavit of service shall contain proof of the date of receipt by the opponent of the counterstatement, and failure to do so shall result in the application for registration of trademark deemed withdrawn.

(4) Where the applicant fails to file a counterstatement within the specified period, the application for registration of trademark, in so far as it relates to the goods or services in respect of which the opposition is directed, shall, unless the Registrar otherwise directs, be deemed withdrawn.

25. Evidence in support of opposition

(1) The opponent shall, within two months from the date of receipt of the counterstatement, file with the Registrar such evidence by way of statutory declaration in support of his opposition.

(2) At the same time as the filing of the evidence in support of his opposition, the opponent shall send a copy of such evidence to the applicant.

(3) The opponent shall file with the Registrar an affidavit of service, within fourteen days from the date of sending the copy of such evidence in support of his opposition to the applicant, where the affidavit of service shall contain proof of the date of receipt by the applicant of such evidence, and failure to do so shall result in the opposition deemed withdrawn.

(4) If no evidence is filed in accordance with this regulation, the opposition shall be deemed withdrawn.

26. Evidence in support of application for registration of trademark

(1) The applicant shall, within two months from the date of receipt of the evidence in support of opposition, file with the Registrar such evidence by way of statutory declaration in support of his application for registration of trademark.

(2) At the same time as the filing of the evidence in support of his application for registration of trademark, the applicant shall send a copy of such evidence to the opponent.

(3) The applicant shall file with the Registrar an affidavit of service, within fourteen days from the date of sending the copy of such evidence in support of his application for registration of trademark to the opponent, where the affidavit of service shall contain proof of the date of receipt by the opponent of such evidence, and failure to do so shall result in the application for registration of trademark deemed withdrawn.

(4) If no evidence is filed in accordance with this regulation the application for registration of trademark shall be deemed withdrawn.

27. Evidence in reply by opponent

(1) The opponent may, within two months from the date of receipt of evidence in support of the application for registration of trademark, file such evidence in reply by way of statutory declaration and shall, at the same time, send a copy of that evidence to the applicant.

(2) The evidence in reply shall be confined to matters strictly in reply to the applicant's evidence.

28. Further evidence

No further evidence may be filed by the opponent or applicant unless with the leave of the Registrar and upon such terms as to costs, or otherwise as the Registrar thinks fit.

29. Application for voluntary disclaimer during opposition proceedings

(1) During any opposition proceedings, the applicant may apply for voluntary disclaimer to disclaim any right to the exclusive use of any specified element of the trademark accompanied by a request for amendment of the application for registration of trademark and payment of the prescribed fee.

(3) The Registrar, before accepting the voluntary disclaimer as requested by the applicant, shall take into consideration the opponent's consent.

(4) If the Registrar accepts the voluntary disclaimer, the opponent shall withdraw the notice of opposition.

30. Written submission

Upon completion of the filing of the evidence including exhibits, the Registrar shall give a notice to the opponent and applicant to submit written submissions to the Registrar relating to the opposition, within two months from the date of issuance of the notice by the Registrar.

31. Extension of time for opposition proceedings

(1) The Registrar may grant an extension of time upon request by the opponent or applicant accompanied by payment of the prescribed fee.

(2) The request for an extension of time may be applied for a period not exceeding six months.

(3) Where an application for extension of time is requested by the opponent or applicant, the party seeking the extension of time shall

at the same time inform the other party of the proceedings that a request for extension of time has been filed with the Registrar.

32. Circumstances in which opposition may proceed in the name of other person

(1) An opposition may proceed in the name of any person other than the opponent who filed the notice of opposition, if—

(a) after the opponent has filed the notice of opposition, the right or interest on which the opponent relied on to file the notice of opposition becomes vested in such other person; and

(b) where the opponent does not withdraw the opposition, the other person referred to in paragraph (a) notifies the Registrar in writing accompanied by the proof to the satisfaction of the Registrar by way of statutory declaration that the right or interest vested in such other person has been entered in the record.

(2) An opposition may proceed in the name of any person other than the applicant who filed the counterstatement if—

(a) after the applicant has filed the counterstatement, the right or interest on which the applicant relied on to file the counterstatement becomes vested in such other person; and

(b) where the applicant does not withdraw the counterstatement, the other person referred to in paragraph (a) notifies the Registrar in writing accompanied by the proof to the satisfaction of the Registrar by way of statutory declaration that the right or interest vested in such other person has been entered in the record.

33. Registrar's decision in opposition proceedings

(1) As soon as may be after the expiration of the period specified in regulation 30, the Registrar shall consider the evidence, exhibit and any written submissions and may within two months communicate his decision in accordance with subsection 35(8) of the Act and the grounds of his decision in writing to the parties of the opposition proceedings.

(2) The date on which the Registrar's written grounds of decision is issued to the parties shall be deemed to be the date of the Registrar's decision for the purpose of an appeal in Court.

(3) Any appeal to the Court against the Registrar's decision shall be made within one month from the date referred to in subregulation

(2).

(4) An applicant or opponent may apply to the Registrar for an extension of time to file an appeal in Court for a period not exceeding two months.

34. Costs in uncontested oppositions

In the event of an uncontested opposition, the Registrar in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was filed.

Division 6 Deferment

35. Deferment of examination or opposition proceedings

(1) Any request for deferment, may be made with the Registrar accompanied by payment of the prescribed fee, by—

- (a) an applicant in relation to the application for registration of trademark under subsection 29(7) of the Act; or
- (b) an applicant or opponent in relation to the opposition proceedings under subsection 35(9) of the Act.

(2) The Registrar may allow a maximum period of deferment of six months and may extend the period of deferment subject to the filing of a new request for deferment.

(3) The Registrar may defer any action under paragraph (1) (a) subject to the following circumstances:

- (a) there is an ongoing application in Court relating to the application for registration of trademark owned by the applicant; and
- (b) there is an ongoing application in Court involving opposition proceedings relating to the application for registration of trademark owned by the applicant.

(4) The Registrar may defer any action under paragraph (1) (b) subject to the following circumstances:

- (a) both the opponent and the applicant are parties who are involved in any Court proceedings in Malaysia; or
- (b) any other reasonable circumstances as the Registrar thinks fit.

Division 7 Registration

36. Certificate of registration

Upon being notified of the publication in the Journal of the registration of trademark, the registered proprietor may request, accompanied by payment of the prescribed fee, the Registrar to issue a certificate of registration.

37. Death of applicant before registration

(1) Where an applicant for the registration of trademark dies, after the date of his application and before the date the trademark is entered in the Register, any other person who proves to the satisfaction of the Registrar that the rights under the trademark has become vested in such other person—

(a) such other person shall file, with the Registrar accompanied by payment of the prescribed fee, an application to substitute in the notification of registration the name of the deceased with the name of such other person; and

(b) the Registrar may enter in the notification of registration and the Register, in place of the name of the deceased, the name, address and other particulars of such other person.

(2) The application for registration of trademark in subregulation (1) shall be proceeded with in such other person's name as if such other person were the applicant.

38. Registration of series of trademarks

(1) An application for registration of a series of trademarks may be made for the registration of the series of trademarks in a single application provided that the series comprises of not more than six trademarks.

(2) Where an application for registration of a series of trademarks comprises two or more trademarks, the application shall be subject to the payment of the prescribed fee for each trademark in the series of trademarks.

(3) Subject to section 21 of the Act and after being satisfied that the application of the series trademarks constitute a series of trademark, the Registrar shall accept the application.

(4) An application may be made to request for the deletion of one or more series trademark by filing a request for amendment of application or alteration of registration accompanied by payment of the prescribed fee.

(5) After considering the request for amendment of application or alteration of registration, the Registrar shall delete the series of trademark.

PART III DIVISION OR MERGER

39. Division of application for registration of trademark

(1) At any time before the registration of trademark, an applicant of the application for the registration of trademark may request, accompanied by payment of the prescribed fee, for a division from such application in respect of the classes or goods or services within such application.

(2) The request for a division shall contain the following information:

- (a) the applicant's name and address for service;
- (b) the number of the application for trademark;
- (c) in the case of division of classes of goods or services, a list of the classes sought to be divided out;
- (d) in the case of division of goods or services, a list of the goods or services sought to be divided out; and
- (e) if the trademark is the subject of proceedings filed in Court, a statement that the other party, or parties, to the proceedings has or have consented to the request for division.

(3) If the Registrar raises any query, on the request for the division, which the applicant is to respond to within the period specified in a written notice, the applicant shall not be allowed to request for extension of time under regulation 59 to respond to the query.

40. Effect of division of application for registration of trademark

(1) If the Registrar allows a request for division, the part that is divided out shall be independent from the original application for registration.

(2) Notwithstanding subregulation (1), the filing date of the original application for registration shall be retained in respect of that part of the application for registration that has been divided out.

(3) Where the request to divide an application is made after the publication of the application, any provisional refusal in respect of, or opposition to, the original application shall be taken to apply to each divisional application, wherever applicable, and shall

be proceeded with.

(4) Where an opponent who opposes some of the classes or goods or services filed by the applicant in the original application, which is now the subject of an application for division, the Registrar may only allow such application for division if the applicant in the original application has not filed a counterstatement.

(5) Upon the division of the original application, particulars relating to the grant of a licence, or any security interest or right in or under the licence, in respect of which notice has been given to the Registrar, shall be deemed to apply in relation to each of the applications into which the original application has been divided.

41. Division of registration of trademark

(1) A registered proprietor may request, accompanied by payment of the prescribed fee, for a division from the registration of classes or goods or services within the registration.

(2) The request for division shall contain the following information:

(a) the registered proprietor's name and address;

(b) the original registration number of the registration of trademark;

(c) in the case of a division of classes of goods or services, a list of the classes sought to be divided out;

(d) in the case of division of goods or services, a list of the goods or services sought to be divided out; or

(e) if the trademark is the subject of proceedings filed in Court, a statement that the other party, or parties, to the proceedings has or have consented to the request for division.

(3) If the Registrar raises any query, on the request for the division, which the applicant is to respond to within the period specified in a written notice, the applicant shall not be allowed to request for extension of time under regulation 59 to respond to the query.

42. Effect of division of registration of trademark

(1) If the Registrar allows a request for division, the part that is

divided out shall be independent from the original registration of trademark.

(2) Notwithstanding subregulation (1), the filing date of the original registration of trademark shall be retained in respect of that part of the application for registration of trademark that has been divided out.

(3) A request under regulation 41 shall not be accepted, where the request would introduce a division amongst the goods or services registration of trademark which is the subject of proceedings for its revocation or invalidation.

(4) Where the original registration is subject to any conditions, disclaimer or limitation, the divisional registrations shall also be restricted.

(5) Where the original registration has been registered together with particulars relating to the grant of the licence, any security interest or right in or under that original registration or any memorandum or statement of the effect of the memorandum, the Registrar shall enter in the Register the same particulars in relation to each of the divisional registrations into which the original registration has been divided.

43. Merger of separate applications or registrations

(1) An applicant for registration of trademark, or a registered proprietor, as the case may be, may apply for the merger of two or more applications or two or more registrations.

(2) The Registrar may merge the applications or registrations if the applications or registrations—

- (a) are for the identical trademark;
- (b) have the same filing dates;
- (c) relating to applications, the applications sought to be merged have the same status;
- (d) relating to registrations, the registrations sought to be merged have the same status;
- (e) are in the name of the same applicant or registered proprietor;
- (f) have the same address of service of the applicant or registered proprietor; and

(g) are classified according to the classification system as specified in the Third Schedule or the same previous edition of the classification system as specified in the Third Schedule, as the case may be.

(3) A request for merger shall be filed with the Registrar accompanied by payment of the prescribed fee and contain the following information:

(a) the applicant's or registered proprietor's name and address for service;

(b) the agent's name and address for service;

(c) classes or goods or services sought to be merged; and

(d) the application or registration number of each application or registration sought to be merged.

44. Effects of merger

(1) No application of merger may be accepted by the Registrar in respect of the registration of trademark which—

(a) is the subject of proceedings for its revocation by the Registrar or Court or invalidation of registration by Court; or

(b) is the subject of an international registration as a basic registration which has not become independent of the trademark as provided for in accordance with Article 6 of the Madrid Protocol.

(2) Where any registration of trademark sought to be merged is subject to any conditions, disclaimer or limitation, the merged registrations shall also be restricted.

(3) Where any registration of trademark sought to be merged has had registered in relation to it particulars relating to the grant of a licence or any security interest or right in or under it, or of any memorandum or statement of the effect of the memorandum, the Registrar shall enter in the Register the same particulars in relation to the merged registrations.

PART IV REGISTER OF TRADEMARKS

45. Entry in Register of particulars of registered trademark

The Registrar shall enter into the Register in respect of each registered trademark the following particulars:

- (a) the date of the filing of the application for registration;
- (b) the date of registration;
- (c) the date of entry of the trademark in the Register;
- (d) the representation of the trademark;
- (e) the priority date, if any, accorded pursuant to a claim to a right to priority under section 26, 27 or 28 of the Act;
- (f) the name and address of the registered proprietor;
- (g) the name and address of the assignor, licensee or any person who has an interest in or charge of the registered trademark;
- (h) the address for service of the registered proprietor, assignor, licensee or any person who has an interest in or charge of the registered trademark;
- (i) where the registered proprietor, assignor, licensee or any person who has an interest in or charge of the registered trademark is represented by an agent, the name of the agent and his address for service;
- (j) any conditions to, amendment to, disclaimer of, modification of, restriction of or limitation of, rights;
- (k) the goods or services in respect of which the trademark is registered;
- (l) where the trademark is a collective mark or certification mark, that fact;
- (m) description of the trademark;
- (n) where the trademark is registered with the consent of the proprietor of an earlier trademark or other earlier right, that fact;
- (o) where the trademark is registered pursuant to a transformation application—
 - (i) the number of the corresponding international registration;
 - (ii) the date of the international registration in accordance with Article 3(4) of the Madrid Protocol, if applicable; and
 - (iii) where the request for extension of protection to Malaysia was made subsequent to that international registration, the date of recordal of that request in accordance with Article 3ter (2) of the Madrid Protocol, if applicable; and
- (p) particulars on the certificate of validity granted by the Court.

46. Amendment or substitution of classification of goods or services

(1) The Registrar may at any time amend an entry in the Register, which relates to the classification of a registered trademark so that it accords with the version of the classification that has effect at that time.

(2) Before making any amendment to the Register, the Registrar shall give the registered proprietor a written notice of the proposed amendment and shall at the same time advise the registered proprietor that—

(a) the registered proprietor may make written objections to the proposal, within two months of the date of the notice, stating the grounds of those objections; and

(b) if no written objections are received within the period specified in paragraph (a), the Registrar shall publish the proposal, and the registered proprietor shall not be entitled to make any objections to the proposal upon such publication.

(3) If the registered proprietor makes no written objections—

(a) the registered proprietor may give the Registrar a written notice of that fact; and

(b) the Registrar shall, as soon as practicable after the expiration of the period specified in paragraph (2) (a) or upon receipt of the written

notice from the registered proprietor, as the case may be, publish the proposal in the Journal.

(4) Where the registered proprietor makes written objections within the period specified in paragraph (2) (a), the Registrar shall, as soon as practicable after having considered the objections, publish the proposal in the Journal or, where the Registrar has amended the proposal, publish the proposal as amended in the Journal.

(5) Regulations 39 and 41 shall be read together with this regulation.

47. Opposition to proposals

(1) Any person may, within two months of the date on which the proposal is published, give notice to the Registrar of opposition to the proposals which shall include a statement of the grounds of

opposition which shall, in particular, indicate why the proposed amendment by the Registrar would be contrary to section 34 of the Act.

(2) For the purpose of the opposition in subregulation (1), the procedures on opposition proceedings in regulations 23 to 34 shall apply.

(3) If no notice of opposition is filed within the time specified, or where any opposition has been determined, the Registrar shall make the amendment as proposed and shall enter in the Register the date of the making of such amendment.

(4) Regulations 39 and 41 shall be read together with this regulation.

PART V ALTERATION, CORRECTION AND VOLUNTARY CANCELLATION OF REGISTERED TRADEMARK

48. Request to alter registered trademark

(1) The registered proprietor may request to the Registrar for an alteration of the registered trademark as allowed under subsection 42(2) of the Act, accompanied by payment of the prescribed fee, and upon such request the Registrar may by written notice require proof as to the circumstances in which the request is made.

(2) If the Registrar requires any proof referred to in subregulation (1), the registered proprietor shall file the proof within the period specified in the written notice and may apply for an extension of time not exceeding two months to extend the time of filing of the proof.

(3) Where the Registrar allows any alteration to a registered trademark, the Registrar shall publish the trademark as altered in the Journal and notify the registered proprietor.

(4) The Registrar may issue a new certificate of registration substituting the previous certificate of registration upon request filed by the registered proprietor accompanied by payment of the prescribed fee.

49. Application to correct the Register

(1) A request for the correction of the Register under paragraphs 43(1)(a), (b) and (c) of the Act may be filed by the registered proprietor, and a request for the correction of the Register under paragraph 43(1)(a) of the Act may be filed by a licensee of a registered trademark, with the Registrar and accompanied by payment of the prescribed fee.

(2) Notwithstanding subregulation (1), in respect of payment of the prescribed fee, the Registrar shall not impose any fee if the change of address of a registered proprietor or licensee is occasioned by a public authority.

(3) For the purposes of a change of name and description in subregulation (1) and for the purpose of subregulation (2), the registered proprietor or licensee shall file supporting documents to

the satisfaction of the Registrar.

(4) A request made by the registered proprietor to the Registrar for the purposes of paragraph 43(1)(b) or (c) of the Act shall be filed with the Registrar, accompanied by a statement setting out fully the nature of the applicant's interest, the facts on which the applicant has based his request and the relief which the applicant seeks, accompanied by payment of the prescribed fee.

(5) For the purpose of subregulation (3), the Registrar may by written notice require any further supporting documents and the registered proprietor or licensee shall file such documents within the period specified in the written notice.

(6) Where after considering the supporting document, the Registrar allows the correction under this regulation, the Registrar shall issue a new notification of registration.

50. Request for voluntarily cancellation of registered trademark or registration in relation to certain goods or services

(1) A request for voluntary cancellation of a registered trademark in respect of some or all of the goods or services under subsection 44(1) of the Act may be filed by the registered proprietor, accompanied by payment of the prescribed fee, and in such request the registered proprietor shall—

- (a) state the name and address of any person claiming a right in respect of, or an interest in, the trademark; and
- (b) declare that any such person referred to in paragraph (a), has been sent not less than two months' notice of the registered proprietor's intention to cancel the registration of trademark, and is not affected, or if affected, consents to the cancellation.

(2) For the purpose of subregulation (1), the Registrar may by written notice require any further supporting documents or information and the registered proprietor shall file such documents or information within the period specified in the written notice.

(3) Upon receiving the request under subregulation (1), the Registrar shall notify the persons referred to in subsection 44(2) of the Act.

(4) The cancellation of the registration of trademark under this regulation shall take effect upon the Registrar being satisfied that the requirements under this regulation have been fulfilled.

(5) The Registrar shall, upon the cancellation taking effect, make the appropriate entry in the Register and publish the date of cancellation in the Journal.

PART VI REVOCATION ON THE GROUNDS OF NON-USE OR INVALIDATION OF THE REGISTER BY COURT

51. Application to Court

Any person who files an application in Court for the correction in the Register under subsection 43(5) of the Act, any aggrieved person who files an application in Court for the revocation by the Court on the grounds of non-use under section 46 of the Act and any aggrieved person who files an application in Court for the invalidation of registration under section 47 of the Act shall furnish to the Registrar, accompanied by payment of the prescribed fee, the following particulars relating to such application in Court as soon as practicable after receiving the sealed copy of the application from the Court:

- (a) the registration number of the trademark;
- (b) the goods or services affected by the application;
- (c) the name of the registered proprietor of the trademark which is the subject of the application for revocation or invalidation;
- (d) the number of the writ of summons or originating summons;
- (e) the date of filing of the application in Court;
- (f) the Court of hearing;
- (g) the parties to the application; and
- (h) the cause of action of the application.

52. Order of Court

(1) Where an order is made by the Court following the filing of the application to Court under subregulation 51(1), the person in whose favour the Court's order is made, or if there is more than one, any such one of them shall file a sealed copy of the Court's order with the Registrar.

(2) If a correction of the Register is required—

(a) the person referred to in subregulation (1) shall file an application, accompanied by payment of the prescribed fee, for correction of the Register supported by a copy of the Court's order; and

(b) the Register shall, where appropriate, be corrected by the Registrar.

(3) If the Registrar considers that the Court's order should be given publicity, the Registrar may publish it in the Journal.

PART VII COLLECTIVE MARKS AND CERTIFICATION MARKS

53. Filing of rules of collective marks or certification marks

(1) The applicant shall, within two months after the date of the application for the registration of collective marks pursuant to subparagraph 5(1) or (3) of the First Schedule to the Act, or certification marks pursuant to subparagraph 5(1) or (3) of the Second Schedule to the Act, file with the Registrar, accompanied by payment of the prescribed fee, the rules of collective marks or certification marks.

(2) If the applicant does not file the rules within the specified period under subregulation (1), the application for registration of collective marks or certification marks shall be deemed withdrawn.

(3) Notwithstanding subregulation (2), the applicant may request for an extension of time to file the rules of collective marks or certification marks, as the case may be, for a period not exceeding two months.

(4) If the applicant files the rules within the extended period, the Registrar shall issue a new date of filing to the applicant which shall be the date of filing of such rules.

54. Filing of amended rules of collective marks or certification marks

(1) The filing of amended rules of the collective marks pursuant to subparagraph 6(5) of the First Schedule to the Act, or amended rules of the certification marks pursuant to subparagraph 6(5) of the Second Schedule to the Act, shall be made with the Registrar.

(2) The filing of amended rules of collective marks or certification marks shall be accompanied by a copy of the amended rules with the amendments shown in red and payment of the prescribed fee.

(3) Where the Registrar accepts the amended rules, the Registrar shall publish a notice indicating that the rules have been amended by the applicant under subparagraph 6(5) of the First Schedule to the Act, or subparagraph 6(5) of the Second Schedule to the Act, and the amended rules may be inspected.

55. Opposition to registration of collective marks or certification marks

(1) Regulations 23 to 34 shall, with the necessary modifications, apply to the opposition to registration of collective marks or certification marks proceedings as they apply to an opposition to an application for registration of trademark.

(2) Any person may, in the application of regulations 23 to 34 relating to publication, within two months after the date of the publication of an application for registration of collective marks or certification marks, give notice of opposition to the Registrar opposing the registration.

56. Amendment of rules of registered collective marks or certification marks

(1) An application for the amendment of the rules governing the use of registered collective marks or certification marks under subparagraph 8(1) of the First Schedule to the Act or subparagraph 8(1) of the Second Schedule to the Act shall be filed with the Registrar.

(2) The application under subregulation (1) shall be accompanied by a copy of the amended rules with the amendments shown in red and payment of the prescribed fee.

(3) Where the Registrar accepts the amended rules, the Registrar shall publish a notice indicating that the rules have been amended by the registered proprietor of the collective marks or certification marks and the amended rules may be inspected.

57. Opposition of amendment of rules of collective marks or certification marks

(1) Any person may, within two months after the date of the publication of the notice referred to in subregulation 56(3), file with the Registrar—

- (a) a notice of opposition to the amendment to the rules; and
- (b) a statement indicating the grounds of opposition for non-compliance of the requirements of paragraph 6(1) of the First Schedule to the Act or paragraph 6(1) of the Second Schedule to the Act, as the case may be.

(2) The person filing the notice and statement under subregulation (1) shall, at the same time, serve copies of the notice and statement on the registered proprietor of collective marks or certification marks.

(3) Regulations 23 to 34 shall apply, to the opposition of amendment of rules of collective marks or certification marks proceedings as the regulations apply to an opposition to an application for registration of trademark, as follows:

(a) references to the applicant shall be construed as references to the applicant for the amendment of the rules;

(b) references to the application shall be construed as references to the application for the amendment of the rules;

(c) references to the date of the publication of the application for registration shall be construed as references to the date of the publication of the notice referred to in subregulation 56(3);

(d) references to the notice of opposition shall be construed as references to the notice and statement referred to in subregulation (1); and

(e) references to the opponent shall be construed as references to the person who filed the notice and statement referred to in subregulation (1).

PART VIII EVIDENCE AND PROCEDURE

58. Statutory declarations

(1) Any statutory declaration required, or used in any proceedings, under the Act or these Regulations, shall be made as follows:

(a) in Malaysia, in accordance with the provisions of the Statutory Declarations Act 1960;

(b) in any other part of the world, before any court, judge, justice of the peace, magistrate, notary public or other officer authorized by law to administer an oath for the purpose of any legal proceedings.

(2) Any document purporting to have affixed, impressed or subscribed thereon or thereto the seal and signature of any person authorized by law to take a declaration may be admitted by the Registrar without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

PART IX EXTENSION OF TIME

59. Request for extension of time

(1) Every request for an extension of time under subsection 153(1) of the Act shall be filed with the Registrar, accompanied by payment of the prescribed fee, and shall state the circumstances in sufficient detail to enable the Registrar to determine whether the extension is justified.

(2) If, upon receiving a request for an extension of time, the Registrar is satisfied that the circumstances are such as to justify an extension of the time for doing any act or thing under the Act or these Regulations, not being a time expressly provided in the Act or regulations 14, 17, 33, 48 dan 53, the Registrar may extend the time upon such terms as the Registrar may direct, and the extension may be granted notwithstanding after the expiration of time for such act or thing to be done.

PART X INTERNATIONAL TRADEMARK UNDER MADRID PROTOCOL

Division 1 General

60. Interpretation

(1) In this Part, unless the context otherwise requires—

“basic application” in respect of an international application, means an application for registration of trademark filed with the Registrar under section 17 of the Act and regulation 7;

“basic registration” in respect of an international application, means a registration of trademark registered by the Registrar under section 36 of the Act;

“change of ownership” includes assignment or transmission;

“Common Regulations” means the regulations, adopted under Article 10 of the Madrid Protocol, with effect from 1 April 1996, as replaced, revised, or amended from time to time;

“designation” and “subsequent designation” mean a request for extension of protection or territorial extension to Malaysia under Article 3ter(1) or (2) of the Madrid Protocol, as the case may be, and which extension shall be as recorded in the International Register;

“holder” refers to the natural person or legal entity in whose name an international registration is recorded in the International Register;

“international application” means an application to the International Bureau for registration of trademark in the International Register under the Madrid Protocol;

“International Bureau” means the International Bureau of the World Intellectual Property Organization;

“international registration designating Malaysia” means an international registration in which a request has been made either in the relevant international application or subsequently for extension of protection to Malaysia under Article 3ter (1) or (2) of the Madrid Protocol;

“Office of origin” means the Office of the Contracting Party where, in accordance with Article 2(2) of the Madrid Protocol, the international application was filed;

“transformation application” means the application provided for in subregulation 104(1); and

“transformation date” means the date the transformation application is filed.

(2) References to a numbered form in this Part shall be references to the current version of the form bearing the corresponding number, as described in the Second Schedule, which is made available on the World Intellectual Property Organization's website.

Division 2 International applications originating from Malaysia

61. Entitlement to file for international application

(1) Any application for an international registration of trademark shall be filed with the International Bureau through the intermediary of the Registrar accompanied by payment of the prescribed fee.

(2) The application for international registration shall only be made where the applicant is—

- (a) a citizen of Malaysia;
- (b) a body or corporation incorporated or constituted under the law of Malaysia;
- (c) a person domiciled in Malaysia; or
- (d) a person who has a real and effective industrial or commercial establishment in Malaysia.

(3) Where a person is qualified under subregulation (2) such person is entitled to file an international application with the Registrar provided that the basic application or basic registration, as the case may be, used as a basis to file the international application is in the name of such person.

(4) Two or more persons as provided for under rule 8 of the Common Regulations may jointly apply for international registration of trademark.

(5) The applicant for international registration of trademark shall provide at the request of the Registrar such evidence as may be necessary to satisfy the Registrar that the applicant is entitled to make the application in accordance with subregulation (2).

(6) For the purposes of filing an international application, Form MM2 (E) as prescribed by the International Bureau and Form MP1 shall be submitted to the Registrar accompanied by payment of the handling fee as prescribed for the filing of an international application.

62. Examination of international application where Malaysia is the Office of origin

Where an international application is filed with the Registrar to be submitted to the International Bureau, the Registrar shall verify

that—

(a) the Trademarks Office may be considered as the Office of origin for the international application; and

(b) the particulars appearing in the international application correspond to the particulars appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

63. Certification by Registrar

(1) Where an international application fulfills the requirements in regulations 61 and 62, the Registrar shall—

(a) certify that the particulars appearing in the international application corresponds to the particulars appearing in the basic application or basic registration, as the case may be;

(b) indicate the date of receipt of the international application; and

(c) submit the international application to the International Bureau.

(2) Where the international application does not fulfill the requirements in regulations 61 and 62, the Registrar shall not submit the international application to the International Bureau and shall issue a written notice to the applicant to correct or amend to the international application within the period specified in the written notice.

(3) Upon receiving the written notice under subregulation (2), the applicant shall file, accompanied by payment of the prescribed fee, an application for corrections or amendments to the international application to satisfy the requirements in subregulation (1).

(4) If the applicant fails to make any correction or amendment to the international application, or fails to make payment of the handling fee, the international application shall be deemed withdrawn.

64. Irregularities raised by the International Bureau

(1) If the International Bureau raises any irregularities pursuant to rule 11, 12 or 13 of the Common Regulations to be remedied by the Office of origin, the Registrar may by a written notice request the applicant, the international application of whom the irregularities is directed, to submit any necessary information with the Registrar

within the period specified in the written notice.

(2) If the applicant submits any information requested within the specified period, the Registrar shall submit such information to the International Bureau.

(3) The Registrar shall not allow an extension of time under this regulation.

65. Classification of goods or services of international application

For the purpose of an international application, the classification of goods or services shall be subjected to rule 9(4) (xiii) of the Common Regulations where the decision of the International Bureau shall be final.

66. Notification to the International Bureau on the ceasing of effect of the basic application or basic registration

(1) In accordance with Article 6 of the Madrid Protocol and rule 22 of the Common Regulations, after the Registrar has submitted an international application to the International Bureau, the Registrar shall—

(a) notify the International Bureau of any occurrence of any of the events referred to in subregulation (2); and

(b) if applicable, request the International Bureau to cancel the international registration as regards to those goods or services covered by the international registration in respect of which the basic application or basic registration has ceased to subsist by reason of the events referred to in subregulation (2) .

(2) The events referred to in subregulation (1) relates to the basic application or basic registration being withdrawn, restricted, limited, cancelled, refused, removed, revoked or invalidated, or the basic application or basic registration expiring, or otherwise ceasing to have effect—

(a) within five years after the date of the international registration; or

(b) five years after the date of the international registration, if the withdrawal, restriction, limitation, cancellation, refusal, removal, revocation, invalidation or expiration of the basic application or basic registration began before the end of the five year period.

Division 3 International registrations designating Malaysia

Subdivision 1 Preliminary matters

67. Entitlement to protection

The requirement in subsection 17(1) of the Act on intent to use is met by the declaration made by the holder of the international registration when designating Malaysia.

68. Effects of an international registration or protected international registration of trademark designating Malaysia

(1) An international registration designating Malaysia shall have the same effects, as from the date of the international registration designating Malaysia or subsequent designation, as the case may be, as an application for the registration of trademark filed with the Registrar.

(2) The date of the international registration designating Malaysia or subsequent designation shall be the date of filing under section 22 of the Act.

(3) The holder of a protected international registration designating Malaysia has, subject to this Part, the same rights and remedies conferred to a registered proprietor by or under the Act, subject to the provision relating to acts not amounting to infringement under section 55 of the Act.

(4) For the purposes of the application of section 55 of the Act in subregulation (3), read together with section 54 of the Act, references to goods or services in sections 54 and 55 of the Act shall be construed as references to goods or services of which a protected international registration designating Malaysia is conferred.

(5) Where the holder of an international registration designating Malaysia, following the issuance of a notification of refusal under subregulation 70(4), 75(1), 89(2) or 92(1), applies to the Registrar—

- (a) to disclaim any right to the exclusive use of any specified element of the trademark; or
- (b) to agree for the rights conferred in Malaysia by the

international registration to be subject to certain conditions or limitations,
the Registrar shall enter the disclaimer, condition or limitation in the Register and shall publish the disclaimer, condition or limitation in the Journal.

(6) Where a protected international registration designating Malaysia is subject to a disclaimer, condition or limitation, the rights conferred by or under the Act shall be restricted by such disclaimer, condition or limitation.

(7) The remedy for groundless threats of infringement proceedings as conferred to a registered trademark by or under section 61 of the Act shall apply to a protected international registration designating Malaysia.

(8) For the purpose of subregulation (7)–

(a) references to the registration of trademark in subsection 61(4) of the Act shall be construed as references to the protection of a protected international registration designating Malaysia; and

(b) references to the notification that a trademark is registered, or that an application for registration has been made in subsection 61(5) of the Act, shall be construed as references to the notification that a trademark is a protected international registration designating Malaysia or is the subject of an international application or international registration designating Malaysia.

(9) The holder of an international registration designating Malaysia may request the Registrar to undertake an expedited examination of the application in accordance with subsection 17(5) of the Act and regulation 8.

(10) For the purposes of subregulation (9)–

(a) references to a person who applies for registration of the trademark in subsection 17(5) of the Act shall be construed as references to a holder of an international registration designating Malaysia; and

(b) references to an applicant who files or has filed an application for registration of a trademark in subregulation 8(1) shall be construed as references to a holder of an international registration

designating Malaysia.

69. Priority

(1) Subject to subregulation (2), the provisions of section 26, 27 or 28 of the Act shall apply so as to confer a right of priority in relation to the protection of an international registration designating Malaysia as they apply in relation to the registration of trademark under the Act.

(2) The manner of claiming the priority conferred under section 26, 27 or 28 of the Act shall be determined in accordance with the Madrid Protocol and the Common Regulations.

Subdivision 2 Examination of international registration

70. Examination of international registration

(1) Upon receiving an international registration designating Malaysia from the International Bureau, the Registrar shall examine the international registration designating Malaysia.

(2) The Registrar may carry out a search, to such extent as he considers necessary, of earlier trademarks.

(3) Where the trademark to which the international registration relates contains or consists of a word, which is not in Roman characters, or the national language or English language, the Registrar may require the holder to furnish the Registrar with the following information:

(a) a translation of the word in the national language or English language to the satisfaction of the Registrar; and

(b) the language to which the word belongs.

(4) If it appears to the Registrar that the requirements of regulation 67 are not met, or met only in relation to some of the goods or services in respect of which protection in Malaysia has been requested, the Registrar shall—

(a) refuse to register the international registration, where such refusal shall be a provisional refusal, and give a notification of such provisional refusal to the International Bureau and the holder of the international registration; and

(b) relating to the notification in paragraph (a) to the holder of the international registration, specify in the notification the period within which such holder may respond.

(5) The holder may apply, accompanied by payment of the prescribed fee, for an extension of time to extend the time specified under paragraph (3)(b) for a period not exceeding six months, subject to regulation 59.

(6) In responding to the provisional refusal of the Registrar or applying for an extension of time to respond, the holder shall file with the Registrar an address for service in Malaysia by appointing and authorizing an agent.

(7) For the purpose of making a response, the holder—

- (a) may make representations, either in writing, or by applying to the Registrar for a hearing accompanied by payment of the prescribed fee;
- (b) may amend the international registration designating Malaysia so as to meet the conditions, amendments, modifications or limitations relating to goods or services by filing an application to amend the international registration designating Malaysia accompanied by payment of the prescribed fee; or
- (c) may furnish additional or any other information or evidence by way of statutory declaration or, viva voce in lieu of or in addition to the statutory declaration.

(8) Upon receiving the application for a hearing, the Registrar shall give a notice to the holder of the date fixed for the Registrar to hear the holder's representation.

(9) After considering the response made by the holder, the Registrar shall accept or refuse the international registration designating Malaysia.

(10) If the Registrar refuses the international registration designating Malaysia, the Registrar shall state the grounds of the refusal which shall be communicated to the holder in writing.

(11) Where the holder intends to have the Registrar's written grounds of decision of the refusal—

- (a) the holder shall, within two months after the date of the issuance of the grounds of the refusal, file a request, accompanied by payment of the prescribed fee, for the Registrar's written grounds of decision of the refusal; and
- (b) the Registrar may, within two months after the date of the request, send the written grounds of decision of the refusal to the holder.

(12) The Registrar shall not allow an extension of time for the period specified in paragraph (11) (a).

(13) The date on which the Registrar's written grounds of decision of the refusal are issued to the holder shall be deemed the date of the Registrar's decision for the purpose of an appeal to Court.

(14) Any appeal to Court against the Registrar's decision shall be made within one month from the date specified in subregulation (13).

(15) A holder may apply, accompanied by payment of the prescribed fee, for an extension of time for a period not exceeding two months to file an appeal to Court.

71. Publication

If the Registrar is satisfied that the requirements of regulation 67 are met in relation to some or all of the goods or services specified in the international registration designating Malaysia, the Registrar shall publish the particulars of the international registration designating Malaysia in the Journal.

Subdivision 3 Opposition proceedings of international registration

72. Notice of opposition

(1) Any person may file with the Registrar, accompanied by payment of the prescribed fee, a notice of opposition to oppose the conferment of protection to an international registration designating Malaysia within two months from the date of publication in the Journal.

(2) The person who intends to file the notice of opposition may apply for an extension of time, accompanied by payment of the prescribed fee, to extend the time specified in subregulation (1) for a period not exceeding two months, subject to regulation 59.

(3) Regulation 23 shall apply in relation, to the contents of the notice of opposition and the statement of the grounds of opposition, and to the requirement of filing an affidavit of service.

(4) For the purpose of applying regulation 23—

(a) references to the date of publication of the application for registration shall be construed as references to the date of publication of the international registration designating Malaysia in regulation 71; and

(b) references to the applicant shall be construed as references to the holder.

(5) For the purpose of filing a notice of opposition, if the opponent does not fulfill the requirement under section 151 of the Act, the opponent shall file with the Registrar an address for service in Malaysia by appointing and authorizing an agent.

(6) If a notice of opposition is filed, the Registrar shall notify the International Bureau of the opposition and the grounds of opposition.

73. Time for sending counterstatement

(1) Within the period of two months after being notified by the International Bureau of the notice of opposition, the holder shall file a counterstatement with the Registrar, accompanied by payment of the prescribed fee, and at the same time shall send a copy of the counterstatement to the opponent.

(2) The date the opponent receives the counterstatement shall be the date of receipt of the counterstatement, and subregulation 24(2) shall apply.

(3) The holder may apply, accompanied by payment of the prescribed fee, for an extension of time to extend the time specified in subregulation (1) for a period not exceeding six months, subject to regulation 59.

(4) If the holder fails to file the counterstatement within the period specified in subregulation (1) or the extended period in subregulation (2), in so far as it relates to the goods or services in respect of which the opposition is directed, the holder's designation or subsequent designation in respect of those goods or services shall be deemed withdrawn, and the opposition shall subsist in respect of those goods or services.

(5) If the holder has not appointed an agent and has not filed an address for service in Malaysia, the holder shall file with the Registrar an address for service in Malaysia by appointing and authorizing an agent.

74. Further proceedings of opposition

(1) Upon the filing of a notice of opposition and a counterstatement, regulations 25 to 34 shall apply to further proceedings relating to such opposition or counterstatement.

(2) As soon as may be after the expiration of the period notified in accordance with regulation 30, the Registrar shall consider the evidence, exhibit and any written submissions and, in accordance with subsection 35(8) of the Act, may within two months communicate his decision and the grounds of his decision in writing to the parties of the opposition proceedings.

(3) The date on which the Registrar's written grounds of decision are issued to the parties shall be deemed to be the date of the Registrar's decision for the purpose of an appeal to Court.

(4) Any appeal to Court shall be made within one month from the date specified in subregulation (2).

(5) Any of the parties to the proceedings may apply, accompanied by payment of the prescribed fee, for an extension of time to file an appeal in Court for a period not exceeding two months.

(6) For the purposes of applying regulations 23 to 33-

(a) references to the applicant in those regulations shall be construed as references to the holder; and

(b) references to the application in those regulations shall be construed as references to the international registration designating Malaysia.

75. Notification of refusal

(1) Except where refusal is based on an opposition, a notification of refusal shall not be given after the expiry of eighteen months after the date on which the notification of an international registration designating Malaysia was sent to the Registrar.

(2) Where there is a possibility that an opposition may be filed after the expiry of the period of eighteen months, the Registrar shall inform the International Bureau, in accordance with Article 5(2)(c) of the Madrid Protocol, of the possible notification of provisional refusal based on the possibility of the filing of such opposition.

(3) The notification of provisional refusal shall set out the matters required by Article 5 of the Madrid Protocol and rule 17 of the Common Regulations.

(4) The Registrar shall notify the International Bureau after the final decision is made-

(a) that the holder has responded within the period specified in paragraph 70(4)(b) or any extended period allowed under subregulation 70(5); or

(b) that the holder has filed a counterstatement within the period specified in subregulation 73(1) or any extended period under subregulation 73(2).

(5) For the purpose of this regulation, a final decision shall be regarded as having been made where-

(a) the Registrar, or the Court on appeal from the Registrar,

decides whether the refusal shall be upheld in whole or in relation to only some of the goods or services in relation to which protection in Malaysia is requested, and any right of appeal against that decision expires or is exhausted;

(b) any representation or counterstatement is withdrawn; or

(c) the proceedings relating to the refusal are discontinued or deemed withdrawn.

Subdivision 4 Protection

76. Protection applies to trademark of international registration designating Malaysia

(1) The protection set out in regulation 78 shall apply to a trademark that is the subject of an international registration designating Malaysia if—

(a) the period of eighteen months after the designation or subsequent designation has expired and notification of refusal has not been given and the International Bureau has not been informed that any notice of opposition may be filed after the expiry of that period; or

(b) after the Registrar has examined the international registration designating Malaysia and published its particulars in the Journal, one of the following events occurs:

(i) the period of eighteen months after the designation or subsequent designation has not expired, but the period after the date of publication for filing a notice of opposition has expired without a notification based on opposition or otherwise having been given;

(ii) the period of eighteen months after the designation or subsequent designation expires and the period for giving a notice of opposition specified in subregulation 93(2) including any extended period expires without a notice of opposition having been given;

(iii) notification of refusal has been given in respect of some of the goods or services, and the holder—

(A) has not responded within the period specified by the Registrar under subregulation 70(4) including any extended period; or

(B) has not filed a counterstatement within the period specified in regulation 73 including any extended period; or

(C) has informed the Registrar that the holder does not intend to respond or file a counterstatement; and

(c) notification of refusal has been given in respect of all or some of the goods or services and the Registrar notifies the International Bureau that a final decision has been made to the effect that refusal is withdrawn, or withdrawn in respect of some of the goods or services.

(2) As soon as possible after the time when the protection set out in regulation 78 first applies to an international registration designating Malaysia, the Registrar shall notify the International

Bureau that the international registration designating Malaysia is granted protection in Malaysia.

(3) In this regulation, goods or services means goods or services in respect of which protection in Malaysia has been extended.

77. Protection extends to protected international registration designating Malaysia as corrected

(1) The protection set out in regulation 78 extends to a protected international registration designating Malaysia, as corrected, if—
(a) the period of eighteen months after the date of notification has expired and notification of refusal has not been given and the International Bureau has not been informed that any notice of opposition may be filed after the expiry of that period; or

(b) after the Registrar has examined the international registration, as corrected, and published the relevant particulars in the Journal, one of the following events occurs:

(i) the period of eighteen months after the date of notification has not expired, but the period after the date for filing a notice of opposition has expired without a notification of provisional refusal based on opposition or otherwise having been given;

(ii) the period of eighteen months after the date of notification expires and the period for filing a notice of opposition specified in regulation 91 including any extended period expires without a notice of opposition having been filed;

(iii) notification of refusal has been given in respect of some of the goods or services and the holder—

(A) has not responded within the period specified by the Registrar under subregulation 89(2), including any extended period;

(B) has not filed a counterstatement within the period specified in subregulation 91(2), including any extended period; or

(C) has informed the Registrar that the holder does not intend to respond or file a counterstatement; and

(iv) notification of refusal has been given in respect of all or some of the goods or services and the Registrar notifies the International Bureau that a final decision has been made to the effect that the refusal is withdrawn, or withdrawn in respect of some of the goods or services.

(2) As soon as possible after the time when the protection set out in regulation 78 first extends to a protected international

registration designating Malaysia, as corrected, the Registrar shall notify the International Bureau that the protection has been extended.

(3) In this regulation—

(a) "date of notification" means the date on which the Registrar receives from the International Bureau a notification of a correction to an international registration; and

(b) "goods or services" means goods or services in respect of which protection in Malaysia would be extended under the international registration, as corrected.

78. Protection

(1) Subject to regulations 76 and 77—

(a) an international registration designating Malaysia shall be entitled to become a protected international registration designating Malaysia; and

(b) where the Registrar issues a refusal in respect of some of the goods or services in an application for international registration, the protection shall be extended only to the remaining goods or services.

(2) A trademark that is protected shall be treated as being registered under the Act on and from—

(a) the date of the international registration, where the request for extension of protection to Malaysia is mentioned in the international application; or

(b) the date on which a request for extension of protection to Malaysia is recorded in the International Register, where the request is made subsequent to the international registration.

(3) A protected trademark that is corrected shall be treated as being registered, as corrected, under the Act—

(a) on and from the date that is two months after the date of publication in the Journal; or

(b) if a notice of opposition is filed in relation to the correction, on and from the date on which the event described in subparagraph 77(1)(b)(iii) or (iv) occurs.

(4) Subregulation (2) shall be read together with regulation 107.

Subdivision 5 Division and merger of international registration designating Malaysia or protected international registration designating Malaysia

79. Division of international registration designating Malaysia

A holder of an international registration designating Malaysia may apply to the Registrar for division from the registration of classes within the registration or specific goods or services within the registration.

80. Division of protected international trademark designating Malaysia

A holder of a protected international registration designating Malaysia may apply to the Registrar for division from the trademark of classes within the trademark or specific goods or services within the trademark.

81. Requirements for application for division

An application for division shall be requested in Form MM22(E) as prescribed by the International Bureau and Form MP2, accompanied by payment of the prescribed fee, and contain the following information:

- (a) the holder's name and address for service;
- (b) if the applicant has an agent, the agent's name;
- (c) the number of the international registration or protected international registration designating Malaysia or the national application number or registration number;
- (d) in the case of a division of classes of goods or services, a list of the classes sought to be divided out;
- (e) in the case of a division of goods or services, a list of the goods or services sought to be divided out;
- (f) if the protected international registration designating Malaysia is subject to proceedings filed in Court, a statement that the other party, or parties, to the proceedings has or have consented to the application for division; and
- (g) if the holder has not appointed or authorized an agent and has not filed an address of service in Malaysia, the holder shall file with the Registrar an address for service in Malaysia by appointing and authorizing an agent.

82. Registrar shall submit application for division to International Bureau

If the Registrar is satisfied that an application for division is made in accordance with regulations 79 to 81, as relevant, the Registrar shall submit an application to the International Bureau.

83. Effect of division of international registration designating Malaysia

If the International Bureau gives notice that the division of an international registration designating Malaysia has been recorded-

(a) the Registrar shall reflect the division in the record; and
(b) the part that is divided out shall be independent of the original international registration designating Malaysia and retains the filing date of-

(i) the original international registration; or
(ii) the date on which a request for extension of protection to Malaysia is recorded in the International Register.

84. Effect of division of protected international registration designating Malaysia

If the International Bureau gives notice that the division of a protected international registration designating Malaysia has been recorded-

(a) the Registrar shall reflect the division in the Register; and
(b) the part that is divided out shall be independent of the original trademark and retains the filing date of-

(i) the original international registration; or
(ii) the date on which a request for extension of protection to Malaysia is recorded in the International Register.

85. Merger of international registration designating Malaysia or protected international trademark designating Malaysia

(1) A holder of two or more international registrations designating Malaysia may apply to the Registrar for the merger of two or more of those registrations provided those registration have previously been divided out from their international registration designating Malaysia in accordance with regulation 79.

(2) A holder of two or more protected international registration designating Malaysia may apply to the Registrar for the merger of two or more of those trademarks provided those trademark have

previously been divided out from their protected international registration designating Malaysia in accordance with regulation 80.

86. Requirements for application for merger

An application for a merger shall be requested on MM24(E) as prescribed by the International Bureau and Form MP 3 accompanied by payment of the prescribed fee and contain the following information:

- (i) the applicant's name and address for service;
- (ii) if the applicant has an agent, the agent's name; and
- (iii) the number of each international registration designating Malaysia or protected international registration designating Malaysia sought to be merged.

87. Registrar shall submit application for merger to International Bureau

(1) If the Registrar is satisfied that an application is made in accordance with regulations 85 and 86, the Registrar shall submit the application to the International Bureau.

(2) If the International Bureau gives notice that the merger has been recorded, the Registrar shall reflect the merger in the record or Register.

Subdivision 6 Correction

88. Registrar may examine correction to international registration

(1) This regulation shall apply if the Registrar receives from the International Bureau a notification of a correction to either of the following:

(a) an international registration designating Malaysia that the Registrar has examined but to which the protection in regulation 78 does not apply; or

(b) an international registration in respect of a protected international registration designating Malaysia.

(2) The Registrar may examine whether the international registration, as corrected, continues to satisfy the requirements of regulation 78.

(3) Subregulation 80(2) shall apply, with necessary modifications, in relation to the international registration, as corrected.

89. Where Registrar considers requirements of regulation 67 no longer met

(1) This regulation shall apply if the Registrar considers that, in relation to an international registration, as corrected, the requirements of regulation 67 are no longer met.

(2) If the requirements of regulation 67 are no longer met, the Registrar shall—

(a) give notification of refusal of the correction to the International Bureau; and

(b) specify in the notification in paragraph (a) the period within which the holder may respond.

(3) Subregulations 70(4) to (15) shall apply to the holder's response.

90. Where Registrar considers requirements of regulation 67 are met

Where the Registrar is satisfied that the requirements of regulation 67 are met in relation to some or all of the goods or services specified in the international registration, as corrected, the Registrar shall publish the particulars of the international registration, as corrected, in the Journal.

91. Notice of opposition for correction

(1) Any person may oppose a correction to a protected international registration designating Malaysia by filing with the Registrar, accompanied by payment of the prescribed fee, a notice of opposition within two months after publication in the Journal.

(2) The person in subregulation (1) may apply, accompanied by payment of the prescribed fee, for an extension of time to extend the period specified in subregulation (1) for a period not exceeding two months, subject to regulation 59.

(3) Regulations 72 to 74 shall apply to the opponent and the holder.

92. Notification of refusal for correction

(1) Except where refusal is based on an opposition, a notification of refusal of a correction shall not be given after the expiry of eighteen months from the date of notification.

(2) If there is any possibility that a notice of opposition may be filed after the expiry of eighteen months, the Registrar shall inform the International Bureau, in accordance with Article 5(2)(c) of the Madrid Protocol, of the possible notification of provisional refusal based on the possibility of the filing of the opposition.

(3) A notification of refusal shall set out the matters required by Article 5 of the Madrid Protocol and rule 17 of the Common Regulations.

(4) The Registrar shall notify the International Bureau after any final decision is made if—

(a) the holder has responded within the period specified in subregulation 89(2) or any extended period allowed under subregulation 89(3); or

(b) the holder has filed a counterstatement within the period specified in subregulation 73(1) or any extended period allowed under subregulation 73(2).

(5) In this regulation—

(a) "date of notification" has the meaning given in subregulation 83(3);

(b) "final decision" means a final decision within the meaning of

regulation 75 as if the notification of correction were a request for protection in Malaysia.

Subdivision 7 Revocation and invalidation

93. Revocation and invalidation

(1) The provisions of sections 45, 46 and 47 of the Act shall, with necessary modifications, apply so as to enable the protection of a protected international registration designating Malaysia to be revoked or declared invalid.

(2) For the purposes of applying sections 45, 46 and 47 of the Act—
(a) references to the registered proprietor in sections 45 and 46 of the Act shall be construed as references to the holder of the protected international registration designating Malaysia;

(b) references to the date of issuance of the notification of registration in subsection 46(1) of the Act shall be construed as references to the date of the protected international registration designating Malaysia became protected;

(c) references to goods or services for which the trademark is registered in subsections 46(4) and 47(7) of the Act shall be construed as references to those in respect of which it is protected;

(d) references to the registration of a trademark being revoked in sections 45 and 46 of the Act shall be construed as references to the protection of a protected international registration designating Malaysia being revoked; and

(e) references to the registration of a trademark being declared invalid in section 47 of the Act shall be construed as references to the protection of a protected international registration designating Malaysia being declared invalid.

(3) The provisions of section 140 of the Act and regulation 51 shall, with necessary modifications, apply to the procedure for an application for revocation or a declaration of invalidity of protection of a protected international registration designating Malaysia.

(4) Where the protection of a protected international registration designating Malaysia is revoked or declared invalid to any extent, the Registrar shall notify the International Bureau and—

(a) where in the case of a revocation under section 45 of the Act, the protection of the protected international registration designating Malaysia shall be deemed to have never been extended and

the protected international registration designating Malaysia which has been revoked shall be subject to further examination or proceedings as determined by the Registrar;

(b) where in the case of a revocation under section 46 of the Act, the rights of the holder shall be deemed to have ceased to that extent as from the date of the application for revocation, or if the Court is satisfied that the grounds of revocation exists at an earlier date, that date;

(c) where in the case of a declaration of invalidity under section 47 of the Act, the trademark shall to that extent be deemed never to have been a protected international registration designating Malaysia, but this shall not affect transactions past and closed.

94. Protection conclusive

(1) Section 53 of the Act shall apply to a protected international registration designating Malaysia.

(2) For the purpose of applying section 53 of the Act, references in that section to registration shall be construed as references to protection of a protected international registration designating Malaysia.

95. Certificate of validity

The provisions of section 143 of the Act shall, with necessary modifications, apply in relation to proceedings before the Court in which the validity of the protection of a protected international registration designating Malaysia is contested.

Subdivision 8 Importation of infringing trademark goods

96. Restriction on importation of infringing goods

(1) Part XIII of the Act shall apply to a protected international registration designating Malaysia.

(2) In subregulation (1), references to a registered trademark in Part XIII of the Act shall be construed as references to a protected international registration designating Malaysia.

Subdivision 9 Offences

97. Offences

(1) Parts XV and XVI of the Act and regulation 116 shall apply to a protected international registration designating Malaysia.

(2) In subregulation (1), references to a registered trademark shall be construed as references to a protected international registration designating Malaysia.

Subdivision 10 Other matters

98. Renewal of international registration designating Malaysia

International registration designating Malaysia which has been renewed in accordance with Article 7 of the Madrid Protocol shall continue to have effect in Malaysia.

99. Protected international registration designating Malaysia and international registration designating Malaysia as objects of property

(1) Sections 64, 65 and 67 of the Act shall apply, with necessary modifications, in relation to a protected international registration designating Malaysia or an international registration designating Malaysia as they apply in relation to a registered trademark or an application for the registration of a trademark, as the case may be.

(2) Sections 65 and 67 and guidelines or practice directions issued under section 160 of the Act shall apply to the registration of particulars of registrable transaction affecting a protected international registration designating Malaysia.

(3) Sections 65 and 67 and guidelines or practice directions issued under section 160 of the Act shall apply to the registration of particulars of registrable transaction affecting an international registration designating Malaysia in which case the Registrar shall, subject to regulation 90 or 102, be notified of the particulars of the registrable transaction affecting such international registration designating Malaysia.

100. Licensing

(1) Sections 68 to 71 of the Act shall, with necessary modifications, apply in relation to licences to use a protected international registration designating Malaysia as those sections apply in relation to licences to use a registered trademark.

(2) References to goods or services for which the trademark is registered in accordance with paragraph 69(2)(a) of the Act shall be construed as references to goods or services in respect of which the trademark is protected in Malaysia.

101 Recordings in the International Register

(1) Any recording made in the International Register concerning an international registration designating Malaysia shall have the same effect as if it had been recorded by the Registrar in the Register.

(2) Where the Registrar considers that the recording referred to in subregulation (1) has no effect in Malaysia, the Registrar shall, where so provided for in the Common Regulations under the Madrid Protocol, send a communication to the International Bureau to that effect in accordance with the relevant provisions of those Common Regulations and regulation 102.

102. Declaration that a change of ownership in international registration designating Malaysia or protected international registration designating Malaysia has no effect in Malaysia

(1) Where Malaysia is notified by the International Bureau of a change in ownership of an international registration designating Malaysia or a protected international registration designating Malaysia and the Registrar considers that the recording referred to in subregulation 101(1) has no effect in Malaysia and the international registration designating Malaysia shall remain in the name of the holder.

(2) The Registrar shall, where so provided for in the Common Regulations, send a communication to the International Bureau that the change of ownership of an international registration designating Malaysia or a protected international registration designating Malaysia in subregulation (1) has no effect in Malaysia.

(3) The declaration of no effect shall indicate the reasons for which the change of ownership has no effect in Malaysia in view that the recordal would be contrary to section 64, 65 or 67 of the Act.

(4) The declaration of no effect shall be sent to the International Bureau before the expiry of eighteen months from the date on which the notification referred to in subregulation (1) was sent to Malaysia.

(5) The holder of the international registration designating Malaysia may make representation in writing to the Registrar against the Registrar's decision within two months from being notified by

the International Bureau.

(6) If the holder fails to make any written representation, the notification of the change of ownership shall continue to have no effect in Malaysia.

(7) After considering the written representation made by the holder, the Registrar shall declare that the change in ownership has or has no effect in Malaysia and state in writing the grounds of the decision and inform the holder.

(8) The date on which the Registrar issues the written grounds of decision to the holder shall be deemed to be the date of the Registrar's decision for the purpose of an appeal in Court.

(9) Any appeal to Court shall be made within one month from the date referred to in subregulation (8).

(10) The holder may apply, accompanied by payment of the prescribed fee, for an extension of time to file an appeal in Court for a period not exceeding two months.

(11) Any final decision relating to the declaration under this regulation shall be notified to the International Bureau.

(12) In making any representation to the Registrar, the holder shall file with the Registrar an address for service in Malaysia by appointing and authorizing an agent.

(13) For the purpose of this regulation, a final decision shall be regarded as being made where—

- (a) the Registrar, or the Court on appeal from the Registrar, decides whether the decision of the Registrar under subregulation (7) shall be upheld, and any right of appeal against that decision expires or is exhausted;
- (b) any representation is withdrawn; or
- (c) the proceedings relating to the notification of change of ownership are discontinued or deemed withdrawn.

103. Declaration that a limitation of goods or services in international registration designating Malaysia or protected international registration designating Malaysia has no effect in Malaysia

(1) Where Malaysia is notified by the International Bureau of a limitation of the list of goods or services in an international registration designating Malaysia or a protected international registration designating Malaysia and the Registrar considers that the recording referred to in subregulation 101(1) has no effect in Malaysia, the Registrar shall, where so provided for in the Common Regulations, send a communication to the International Bureau to that effect that the limitation shall not apply to the goods or services affected by the declaration.

(2) The declaration of no effect shall indicate the reasons for which the limitation has no effect in Malaysia in view that the recordal would be contrary to section 32, 33, paragraph 43(1)(b) or section 44 of the Act.

(3) The declaration of no effect shall be sent to the International Bureau before the expiry of the eighteen months from the date on which the notification referred to in subregulation (1) was sent to Malaysia.

(4) The holder of the international registration designating Malaysia may make representation in writing to the Registrar against the declaration in subregulation (2) within two months from being notified by the International Bureau.

(5) If the holder fails to make any written representation under subregulation (4), the notification of the limitation of the list of goods or services shall continue to have no effect in Malaysia.

(6) After considering the written representation made by the holder under subregulation (4), the Registrar shall declare that the limitation of the list of goods or services has or has no effect in Malaysia and state in writing the grounds of the decision and inform the holder.

(7) The date on which the Registrar issues the written grounds of decision to the holder shall be deemed to be the date of the

Registrar's decision for the purpose of an appeal in Court.

(8) Any appeal to Court shall be made within one month from the date referred to in subregulation (7).

(9) The holder may apply, accompanied by payment of the prescribed fee, for an extension of time to file an appeal in Court for a period not exceeding two months.

(10) Any final decision relating to the declaration under this regulation shall be notified to the International Bureau.

(11) In making representation to the Registrar, the holder shall file with the Registrar an address for service in Malaysia by appointing and authorizing an agent.

(12) For the purpose of this regulation, a final decision shall be regarded as being made where—

(a) the Registrar, or the Court on appeal from the Registrar, decides whether the decision of the Registrar shall be upheld, and any right of appeal against that decision expires or is exhausted;

(b) any representation is withdrawn; or

(c) the proceedings relating to the notification of limitation of the list of goods or services are discontinued or deemed withdrawn.

Division 4 Transformation of international registration designating Malaysia into national application

104. Transformation application

(1) Where an international registration designating Malaysia is cancelled at the request of the Office of origin under Article 6(4) of the Madrid Protocol, for all or some of the goods or services listed in the international registration, the holder of the international registration may file an application with the Registrar for registration of the same trademark in respect of the goods or services covered by the list of goods or services contained in the international registration within three months from the date the international registration was cancelled.

(2) An application under subregulation (1) shall be made on Form MP4 accompanied by payment of the prescribed fee and shall include the following:

- (a) the international registration number of the international registration which has been cancelled;
- (b) the date of the said international registration or the date of the subsequent designation, where applicable;
- (c) the date on which the cancellation of the international registration was recorded; and
- (d) the date of any priority claimed in the international application and recorded in the International Register, where applicable.

(3) If the application filed under subregulation (1) is approved by the Registrar, the Registrar shall publish that fact in the Journal.

(4) In filing the application under subregulation (1), the holder shall file with the Registrar an address for service in Malaysia by appointing and authorizing an agent.

(5) The holder under this regulation shall be the person who was the holder of the international registration at the date of its cancellation.

105. Date of registration of trademark registered pursuant to transformation application

A trademark registered pursuant to a transformation application

shall be treated as if it were registered—

(a) on the date of the international registration in accordance with Article 3(4) of the Madrid Protocol; or

(b) where the request for extension to Malaysia was made subsequent to the international registration, on the date of recordal of the request in accordance with Article 3ter (2) of the Madrid Protocol.

106. Procedure on transformation application

(1) If a protected international registration designating Malaysia becomes protected on or before the transformation date, the trademark shall be registered under the Act.

(2) If an international registration designating Malaysia has not become protected by the transformation date and its particulars have been published, the Registrar shall treat—

(a) the publication of its particulars as the publication of the transformation application under section 31 of the Act;

(b) any opposition to its protection under regulation 72 as an opposition to its registration under section 35 of the Act.

(3) If the particulars of the international registration designating Malaysia have not been published by the transformation date and the Registrar has given a notification of refusal, the Registrar shall for the purposes of the transformation application treat the notification of refusal as a written notice issued by the Registrar to the application under subsection 29(5) of the Act.

Division 5 Replacement of registration by international registration

107. Effects of international registration where trademark is also registered under the Act

(1) This regulation shall apply where—

- (a) a registered trademark is also a protected international registration designating Malaysia;
- (b) the registered proprietor is the holder of the protected international registration designating Malaysia;
- (c) all the goods or services in respect of which the registered trademark is registered are protected under the protected international registration designating Malaysia; and
- (d) the date of registration of the registered trademark is earlier than—
 - (i) the date specified in subregulation 78(2) or (3) in relation to the protected trademark; or
 - (ii) the date the international registration is registered in the International Register.

(2) The protected international registration designating Malaysia shall, notwithstanding subregulation 78(2) or (3), be treated as being registered under the Act as of the date of registration of the registered trademark in relation to all goods or services in respect of which the registered trademark was registered.

(3) For the purpose of determining whether the protected international registration designating Malaysia is an earlier trademark, it shall be treated as having the date of application of the registered trademark in relation to all the goods or services in respect of which the registered trademark was registered, taking into account, where appropriate, the priorities claimed in respect of the registered trademark.

(4) Where the conditions specified in subregulation (1) are satisfied in relation to a trademark, subregulations (2) and (3) shall continue to apply in respect of the relevant protected international registration designating Malaysia notwithstanding that the relevant registered trademark ceased from registration under subsection 39(10) of the Act or is voluntarily cancelled but ceases to apply if it is, to any extent, revoked by the Registrar or Court or declared invalid.

(5) On the application of the holder of the protected international registration designating Malaysia in Form MP 5, accompanied by payment of the prescribed fee, the Registrar shall note in the Register that the international registration designating Malaysia replaces the registered trademark in relation to the goods or services in respect of which the registered trademark was registered.

(6) Where the Registrar has taken note of an international registration, the Registrar shall notify the International Bureau.

(7) The application referred to in subregulation (5) shall indicate the following:

(a) the number of the international registration designating Malaysia or protected international registration designating Malaysia;

(b) where only some of the goods or services listed in the international registration are concerned, those goods or services;

(c) the filing date of the national application for registration of the trademark number;

(d) the registration date and national trademark registration number;

(e) the priority date, if any, of the national trademark registration;

(f) information relating to other rights acquired by virtue of the national trademark registration.

(8) The application of this regulation is without prejudice to any right or remedy conferred on any person in respect of the registered trademark.

Division 6 Miscellaneous provisions

108. Communication of information to International Bureau

The Registrar may communicate to the International Bureau any information that Malaysia is required to communicate under these Regulations or pursuant to the Madrid Protocol or the Common Regulations.

PART XI AGENT

109. Register of Trademark Agents

(1) The Register of Trademark Agents shall contain the details of an agent as follows:

- (a) the name of the agent or the name of the partnership or bodies corporate accompanied by the name of each person who is entitled to be registered under regulation 111;
- (b) the address for service of the agent;
- (c) the contact details of the agent; and
- (d) the date of his registration as an agent.

110 Registration of agents

(1) An application to be registered as an agent shall be made to the Registrar accompanied by payment of the prescribed fee.

(2) The Registrar shall register a person as an agent and enter his name in the Register of Trademark Agents if the agent satisfies the following requirements:

- (a) the agent is either a citizen, domiciled in or permanent resident of Malaysia;
- (b) the agent will be practising as an agent in a business registered in Malaysia;
- (c) the agent is not an undischarged bankrupt;
- (d) the agent has not been convicted of an offence involving fraud, dishonesty or any other offences under this Act;
- (e) the agent has attended all the required courses; and
- (f) the agent has passed the examination conducted by the Registrar.

(3) In addition to the requirements under subregulation (2), the person applying to be registered as an agent shall satisfy the Registrar that—

- (a) he is on the Register of Patents Agents maintained in pursuance of regulations made under the Patents Act 1983;
- (b) he is an advocate and solicitor of the High Court in Malaya or an advocate and solicitor of the High Court in Sabah and Sarawak who is practicing solely in Malaysia;
- (c) he holds a recognised degree in any field of studies and has had at least two years' experience in the field of industrial property; or
- (d) he has had at least three years of experience in the field of

industrial property by virtue of him being an ex-officer of the Corporation.

(4) For the purposes of paragraphs 3(b) and (c), the applicant shall submit the required proof at the time of filing an application under subregulation (1).

(5) In approving the applicant's application under subregulation (1), the Registrar may require further proof of the matters specified in paragraphs 3(b) and (c) through the issuance of a written notice by the Registrar and the applicant shall respond within the period specified in the written notice.

(6) If the applicant fails to respond to the written notice under subregulation (5), the application in subregulation (1) shall be deemed withdrawn.

(7) The Registrar shall not allow an extension of time to extend the period specified in the written notice under subregulation (5).

(8) Notwithstanding the requirement of passing the examination as specified under paragraph (2)(f), the Registrar may waive such requirement if the applicant has passed the examination for patent agents under regulation 45D of the Patents Regulations 1986.

(9) The Registrar, upon being satisfied that the applicant qualifies to be registered in the Register of Trademark Agents, shall register the applicant for a term expiring on 31 December of that year.

(10) Any person who is aggrieved by the decision of the Registrar under this regulation may appeal to Court within one month from the date of the issuance of the decision.

111. Partnership and bodies corporate may be registered as agent

(1)(1) An application by a partnership or bodies corporate to be registered as an agent shall be made to the Registrar accompanied by payment of the prescribed fee.

(2) The Registrar shall register a partnership or bodies corporate as an agent and enter the name of the partnership or bodies corporate in the Register of Trademark Agents if it comprises one or

more registered agent.

(3) Upon being registered as an agent, the address of the partnership or bodies corporate shall be the address for service.

112. Cancellation of registration for failure to renew the registration of agent

(1) If an agent fails to file the application for renewal on or before the date specified under subregulation 12(1) or (2), the Registrar may cancel the name of the agent and remove it from the Register of Trademark Agents and enter that fact into a record.

(2) The Registrar may restore the name of the agent in the Register of Trademark Agents upon the application for the renewal of registration as an agent, accompanied by payment of the prescribed fee, and the payment of the prescribed fee for extension of time.

(3) When the agent is removed from the Register of Trademark Agents, all the applications for registration or registrations of trademarks handled by the agent shall be published by the Registrar in the Journal.

(4) When the removal of an agent and all the applications for registration or registrations of trademarks handled by the agent have been published by the Registrar in the Journal, the applicants of the applications for registration or the registered proprietors shall appoint and authorize a new agent to act for the applicants or the registered proprietors, as the case may be.

113. Cancellation of registration of agent

(1) The Registrar may cancel the registration of any person who—
(a) has been struck off the Register of Patent Agents or suspended from the Roll of Advocates and Solicitors, wherever applicable;
(b) has been convicted of an offence involving fraud or dishonesty or any other offences under the Act;
(c) is no longer a citizen, domiciled or resident in Malaysia or no longer carrying a business principally in Malaysia;
(d) is an undischarged bankrupt; or
(e) fail to renew the registration of agent.

(2) Where the registration of any agent is cancelled, the agent is

removed from the Register of the Trademark Agents and all the applications for registration or registrations of trademarks handled by the agent shall be published by the Registrar in the Journal.

(3) Where the removal of an agent and all the applications for registration or registrations of trademarks handled by the agent have been published by the Registrar in the Journal, the applicants of the applications for registration or the registered proprietors of the registrations of trademark shall appoint and authorize a new agent to act for the applicants or the registered proprietors, as the case may be.

114. Registrar may refuse to recognize agent

The Registrar may refuse to recognize the following person as an agent for the purposes of any proceedings under the Act:

- (a) a person who has been convicted of an offence involving fraud, dishonesty or any other offences under the Act;
- (b) an agent whose name has been cancelled, removed from and not restored to the Register of Trademark Agents; and
- (c) a partnership or bodies corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognize by virtue of paragraph (a) or (b).

PART XII MISCELLANEOUS

115. Certificate by Registrar

(1) Subject to subregulation (3), any person may file a request for a certificate by the Registrar accompanied by payment of the prescribed fee.

(2) The request for a certificate by the Registrar shall be for the Registrar to make in the certificate any entry of any matter or thing which the Registrar is authorized to perform under the Act but which the Registrar has or has not performed.

(3) Before giving a certificate under subregulation (1), the Registrar may, if the Registrar thinks fit, require the person making the request to show to the satisfaction of the Registrar an interest in the entry, matter or thing in question and if the Registrar is not so satisfied the Registrar may decline to furnish the certificate.

(4) The Registrar shall not be obliged to include in any certificate issued under this regulation a copy of the trademark unless the person making the request has filed a copy suitable for the purpose.

(5) The certificate by the Registrar shall not be a notification of registration or certificate of registration issued under subsection 36(2) of the Act.

116. Registrar's verification

(1) For the purpose of subsection 112(3) of the Act, any registered proprietor, holder of a protected international registration designating Malaysia or licensee shall file a request, accompanied by payment of the prescribed fee, with the Registrar for the Registrar's verification.

(2) The request for the Registrar's verification shall be supported by a statutory declaration exhibiting the evidence of the use of the trademark which is not identical with the registered trademark on the goods or services.

(3) The Registrar upon receiving the request for the Registrar's verification, shall examine the evidence of use and issue the

Registrar's verification declaring that—

- (a) the trademark is confusingly similar or likely to be mistaken with the registered trademark; or
- (b) the trademark is not confusingly similar or likely to be mistaken with the registered trademark.

(4) The Registrar may, in examining the evidence of use for the Registrar's verification, request for further evidence as the Registrar thinks fit within the period specified in a written notice.

(5) The registered proprietor, holder of a protected international registration designating Malaysia or licensee may apply for an extension of time to extend the period specified in the written notice in subregulation (4) for a period not exceeding one month.

(6) The registered proprietor, holder of a protected international registration designating Malaysia or licensee to whom the Registrar's verification is issued shall submit the Registrar's verification to the Assistant Controller.

(7) The Registrar's verification shall not be used for purposes other than for investigation by the Assistant Controller under section 112 of the Act.

(8) The Registrar's verification shall expire at the end of one year from the date of the issuance.

117. Confidential document

(1) Where a document, other than an application form required by the Registrar and published, is filed at the Trademarks Office and the person filing it requests, accompanied by payment of the prescribed fee, at the time of filing that such document be treated as confidential, giving reasons for the request, the Registrar may direct that such document be treated as confidential and such document shall not be open to public inspection.

(2) Where such direction that any document shall be treated as confidential has been given and not revoked, nothing in this regulation shall be taken to authorize or require any person to be allowed to inspect the document to which the direction relates except with the consent of the proprietor of the document.

(3) The Registrar shall not revoke any direction for any document to be treated as confidential without prior consultation with the person at whose request the direction was given unless the Registrar is satisfied that such prior consultation is not reasonably practical.

(4) The Registrar may, where the Registrar considers that any document issued by the Trademarks Office should be treated as confidential so direct, and upon such direction that document shall not be open to public inspection except by leave of the Registrar.

(5) Where a direction is given under subregulations (1) and (4) for a document to be treated as confidential, a record of that fact shall be filed with the document or in the form as determined by the Registrar.

PART XIII REVOCATION, SAVINGS AND TRANSITIONAL PROVISIONS

118. Interpretation

In this Part, "revoked Regulations" means the Trade Marks Regulations 1997.

119. Revocation

The Trade Marks Regulations 1997 are hereby revoked.

120. Savings and transitional

(1) These Regulations shall not apply to any application made or filed prior to the coming into operation of these Regulations and for the purpose of such applications, the Trade Marks Regulations 1997 shall apply and shall be deemed to have not been revoked.

(2) The Registrar may give directions as the Registrar thinks fit to ensure that the application made or filed prior to the coming into operation of these Regulations referred to in subregulation (1) complies with these Regulations in so far as to give effect to sections 173, 174, 176, 178, 179 and 180 of the Act.

(3) Any matter in respect of any application made or filed prior to the coming into operation of these Regulations which is required under the revoked Regulations to be advertised in the Gazette shall, on the coming into operation of these Regulations, be published in the Journal.

FIRST SCHEDULE: (Regulation 3) FEES

(1) No.	(2) Matter	(3) Corresponding provision under the Trademarks Act 2019	(4) Corresponding provision under the Trademarks Regulations 2019	(5) Fees (RM)
1.	Application for preliminary advice and search	13(2)		250 (for each class)
2.	Application for registration of trademark: (a) ordinary trademark (b) shape of goods or their packaging (c) other types of trademark: sound, scent, hologram, positioning, sequence of motion, colour (d) collective marks (e) certification marks	17(2)	7(1)	950 (for each class - by adopting from the pre-approved list) 1100 (for each class - without adopting from pre-approved list)

	Series of trademark for the second and each subsequent trademark (maximum of 6)		38(2)	50 (for each trademark)
3.	Filing of rules of collective marks or certification marks	5(1) or (3) of the First Schedule and Second Schedule	53(2)	300 (for each class)
4.	Request for expedited examination of a trademark application	17(5)	8(1)	1000 (for each class)
5.	Request for division of an application for registration of trademark or a registered trademark	37(2)	39(1) 41(1)	300 (for each request)
6.	Request for merger of applications or registered trademarks	38(2)	43(3)	100 (for each request)
7.	Request for— (a) amendment of application of trademark on the representation of the trademark	33(2)	9(3) 22(1)	140 (for each application)

(b) alteration of registered trademark on the representation of the trademark	42 (2)	48 (1)	
Application for –			100 (for each application)
(a) restriction of goods or services or other matters	32 (1)	20 (2)	
(b) amendment of goods or services or other matters	33 (2)	22 (1)	
(c) correction of goods or services or other matters	43 (1)	49 (1)	
Application for amendment of rules of collective trademark or certification trademark	6 (5) of the First Schedule and Second Schedule	54 (2) 56 (1)	140 (for each application)
Application for–	33 (2)		20 (for each application)
(a) amendment of name or address of applicant			
(b) correction of name or address of registered	43 (1) (a)	49 (1)	
	43 (2)	49 (1)	

	proprietor (c) correction of name, address or description of licensee			
8.	Request to amend document	152(1)		20 (for each class)
9.	Application to the Registrar for hearing	29(5) (a) 45(7)	17(1) (a) 19(2) (a) 70(7) (a)	150 (for each class)
10.	Request for— (a) grounds of decision refusal to register trademark		15(2)	250
	(b) grounds of decision of total provisional refusal		17(6)	1000
	(c) grounds of decision of revocation by Registrar		70(11) (a)	250 (for each class)
11.	Notice of opposition against— (a) the registration of a trade mark, collective marks or certification marks	35(1) 6(8) and 8(3) of the First Schedule and Second Schedule	23(1)	950 (for each class)

(b) an amendment of an application for registration of a trade mark which has been published, where the amendment affects the representation of the trade mark or the restriction affects the goods or services covered by the application for registration	32 33	21(2) 22(2)	600 (for each class)
(c) an application to amend the regulations governing the use of a registered collective marks or certification marks	8(3) of the First Schedule and Second Schedule		600 (for each class)
(d) change of classification by Registrar	157(4)		600 (for each class)
(e) correction of protected international	75(1)	91(1)	600 (for each class)

	registration designating Malaysia			
12.	Filing of a counterstatement	35(4)	24(1) 73(1)	350 (for each class)
13.	Renewal of registration	39(4)		1000 (for each class)
	Request for late renewal	39(5)		1200 (for each class)
	Request for restoration of removed registration	39(9)		1500 (for each class)
14.	Application to voluntarily cancellation of registered trademark or registration in relation to certain goods or services	44(1)	50(1)	20 (for each class)
15.	Application for: (a) Correction of Register by Court Order	43(5)	52(2)	300 (for each class)
	(b) Revocation of registration by Court Order	46		300 (for each class)
	(c) Invalidation of registration by Court	47		300 (for each class)

	(d) Certificate of validity	143	95	300 (for each class)
	(e) Any other Court Order	140(3)	-	100 (for each class)
16.	Notification of any application or appeal to Court	140(1)	51(1)	20 (for each class)
17.	Filing of complaint to Assistant Controller of Trade Descriptions	112(1)		10 (for each application)
18.	Application for Registrar's Verification	112(3)		500 (for each class)
19.	Application to register or notify the Registrar the particulars of assignment or transmission	65 67		300 (for each application)
20.	Application to register or notify the Registrar the particulars of license or sub-license	65 67		100 (for each class)
21.	Application to register or notify the Registrar the particulars of security interest or	65 67		300 (for each application)

	charge			
22.	Application for amendment or termination of a license, sub-license, security interest or charge	65 67		50 (for each application)
23.	Filing of request for form or document certified true copy by Registrar	144		10 (for each page)
24.	Filing of request for certified and sealed by Registrar printed, written copies or extracts of or from the Register	15(2) 145(1)		10 (for each page)
25.	Filing of request for certificate purporting to be under the hand of the Registrar	145(3)	115(1)	140 (for each class)
26.	Application for certificate of registration	36(4)	36 48(4)	50 (for each application)

27.	Request for extension of time	153(1)	59(1)	50 (for each application)
	For opposition proceedings		31(1)	200 (per month)
	For other than opposition proceedings		59(2)	100 (per month)
28.	Application to treat document as confidential	156	117	10 (for each application)
29.	Application to revoke confidentiality of document treated as confidential	156	117	10 (for each application)
30.	Request for refund of fee of filing the application for registration of trademark	13(4)	16(2)	20 (for each class)
31.	Application of adaptation of entries in the Register to new classification	157(3) (a)		20 (for each class)
32.	Filing of document manually	162(2) (a)		2 (for each page)
	(This fee shall not apply where the Registrar imposes suspension of			

	the electronic filing system.)			
33.	Withdrawal of application	32 (1) 32 (2)	20 (2)	20 (for each application)
34.	Application for deferment of examination of an application or opposition proceedings	29 (7) 35 (9)	35 (1)	300 (for each application)
35.	Application to restrict on importation of infringing goods	82 (2)		330 (for each application)
36.	Request for reinstatement of application, rights or thing	153 (1)		300 (for each application)
37.	Request to deposit security for cost for opposition or border measures	35 (13) 83		20 (for each application)
	(a) Conversion of pending application	174 (2)		600 (for each class)
	(b) Amendment of assignment under the repealed Act	171 (4)		100 (for each application)
	(c) Amendment of Registered User to	172 (4)		50 (for each application)

	Licensing			
38.	Application for the Trademark Agent Examination	97 (1)		500
39.	Application to be registered as a trademark agent	97 (1)	110 (1) 111 (1)	1350
40.	Application for renewal of registration as a trademark agent	97 (1) 162 (2) (g)		300
41.	Application for voluntary cancellation of registration of trademark agent	97 (2) (b) 162 (2) (g)		20
42.	Application for deferment of renewal of registration of trademark agent	162 (2) (g)		500
43.	Application for change of name or address of service of registered trademark agent	97 (2) (c)		20

44.	Application for— (a) to add an address for service of any person (b) appointment of agent's authority (c) termination of registered trademark agent's authority	95 (1) 95 (3)		20 (for each application)
45.	Notice of intention to cease to act on behalf of an applicant, registered proprietor or any person	95 (4)		10 (for each application)
46.	Notification of death of a registered trademark agent to the Registrar	97 (2) (d)		NIL
47.	Appeal for re-scrutiny of result of examination of trademarks agent	162 (1) (g)		100 (For each paper)
48.	Request to conduct public inspection	15 (1)		20 (for each hour)

49.	Application for request of information Permitted information upon request (Hit List)	146		100 (for up to 10 pages) and 5 (for each subsequent page)	
50.	General form for transitional matters: (a) Insufficient of-	177(2)		Electronic filing before 27 December 2019 (for each class)	Manual Filing before 27 December 2019 (for each class)
	(i) the renewal fee			450	400
	(ii) the renewal fee and surcharge			650	600
	(iii) the renewal fee and restoration			950	900
	(b) Conversion of pending application;	174(2)		600 (for each class)	
	(c) Amendment of assignment under the repealed Act	171(4)		100 (for each application)	
	(d) Amendment of Registered User to Licensing	172(4)		50 (for each application)	

SECOND SCHEDULE: (Regulation 3) FEES FOR INTERNATIONAL REGISTRATION

(1) Form No.	(2) Matter	(3) Corresponding provision under Trademarks Regulations 2019	(4) Fee (RM)
MP1	Handling fee for filing of an international application	61(4)	200 (for each application)
MP2	Request for processing of the divisional request	81(a)	300 (for each application)
MP3	Request for processing of the request for merger	86(a)	100 (for each application)
MP4	Request to transform an international registration into national application(s)	104(2)	950 (for each application)
MP5	Application to record replacement of registered trademark with national registration	107(5)	100 (for each application)

THIRD SCHEDULE: (Regulation 11) CLASSIFICATION OF GOODS AND SERVICES

1. International Classification of Goods and Services for the Purposes of the Registration of Marks established pursuant to the Nice Agreement of 15 June 1957 including any amendments made to it from time to time.

2. International Classification of the Figurative Elements of Marks established pursuant to the Vienna Agreement of 12 June 1973 including any amendments made to it from time to time.

3. Any classification of goods or services recognized by Malaysia.