

# Malaysia: Accession to Madrid Protocol; New Trademark Laws

By [Alejandra Camacho Luna](#)

On September 27, 2019, Malaysia acceded to the Madrid Protocol as the 106th member of the Madrid System. Malaysia's accession follows from its obligations under the ASEAN Economic Community and commitment to the ASEAN Blueprint 2025. The Madrid Protocol will enter into force in Malaysia on December 27, [More](#)

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Concurrently, the Malaysian Trademark Act 1972 was extensively modified and will be replaced by the Malaysian Trademark Act 2019 (MTA). The MTA will also enter into force on December 27, 2019. In general, the MTA recognizes new types of trademarks, grants broader protection to trademark holders, and modernizes trademark proceedings with respect to formalities and deadlines. Salient amendments to the MTA are discussed below.

## **New Trademark Concepts and Regulations:**

- The MTA recognizes non-traditional marks such as three-dimensional marks, color, sound, scent, and holograms.
- Collective marks and multi-class applications are now available. Current trademark owners may divide and merge applications and registrations, including consolidating single-class registrations into multi-class ones, which will reduce future maintenance costs.
- The MTA includes new absolute and relative grounds of refusal. For example, registration may be refused on the ground that a mark is generic and/or commonly used.

- Subject to examiner's discretion, consent letters may be accepted to overcome blocking citations.
- The MTA recognizes that trademarks are personal property and, thus, may be the subject of a security interest.

### **Broadened Protection for Trademark Holders:**

- Under the MTA, applicants have the right to make representations, amend the application, or provide additional evidence in response to a refusal. In the past, trademark holders had the right to receive a written refusal, but not a rectification right.
- Trademark owners may presently file infringement actions or assert a well-known mark against the use of an identical/similar mark for identical goods and services. The MTA allows trademark holders to take action against third parties that use an identical/similar mark for related goods and services.
- The MTA provides new infringement remedies, such as damages, accounting of profits, injunctions, and mandatory orders.
- The MTA consolidates trademark offenses, such as counterfeiting and falsely representing a mark, which were regulated under other acts. The MTA confers broader powers on enforcement authorities to investigate counterfeiting, arrest suspects, and search and seize suspected counterfeiting goods. As to penalties, for the first time, Malaysia criminalizes counterfeiting and false applications.

### **Provisions to Challenge a Trademark and/or Trademark Holder:**

- The MTA includes new grounds for cancellation. For instance, a registration may be cancelled if the mark becomes generic or misleading regarding the nature, quality, or geographical origin of the goods/services.
- Under the MTA, a registration becomes vulnerable to a non-use action after its third year of registration. However, the holder may not defend by claiming use of the mark three months prior to the filing of the non-use cancellation action.
- Groundless threats of infringement are now available as a defense against trademark holders.

### **Provisions that Affect Formalities and Deadlines:**

- The filing date is the date when all the formalities of the application are met, instead of the receipt date of the application. Therefore, applicants should make sure that applications comply with all the required formalities, which include filing a certified translation and transliteration of the mark if the mark is not in Roman characters, Malaysian, or English.
- Once the mark is granted, the Registrar will issue notification of the registration bearing the Registrar's seal, and a registration certificate will be issued only upon express request and payment of fees.
- The period to file to renew a registration is reduced from one year to 6 months after the expiration date.
- License agreements should be in writing. However, it is not mandatory to record them before the Register.

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