



P.U.(A) 228/2001

Trade Marks (Amendment) Regulations 2001

Preamble

In exercise of the powers conferred by section 83 of the Trade Marks Act 1976 [Act 175], the Minister makes the following regulations:

1. Citation and commencement

(1) These regulations may be cited as the **Trade Marks (Amendment) Regulations 2001**.

(2) These Regulations come into operation on 1 August 2001.

2. Amendment of Regulation 12

The Trade Marks Regulations 1997 [*P. U. (A) 460/97*], which in these Regulations are referred to as the "principal Regulations", are amended in subregulation 12(3) by substituting for the full stop at the end of paragraph (c) the words "; or" and by inserting after paragraph (c) the following paragraphs:

"(d) has had at least seven years of experience in the field of industrial property by virtue of he being an ex-officer of the Office; or

(e) has acted as a trade mark agent to the satisfaction of the Registrar before the Trade Marks Regulations 1997 came into force. "

3. New Regulations 13A and 13B

The principal Regulations are amended by inserting after regulation 13 the following regulations:

"13A. Where registration of mark is not allowed.

The Registrar shall not register a mark or part of a mark where-

(a) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of Malaysia to be well-known in Malaysia, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services;

(b) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known under regulation 13B, which is registered in Malaysia with respect to goods or services whether or not similar to those with respect to which registration is applied for, provided that use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the proprietor of the registered mark, provided further, that the interests of the proprietor of the registered mark are likely to be damaged by such use;

(c) the mark or part of the mark is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

(d) the mark or part of the mark is likely to mislead the public if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

13B. Criteria of well-known mark.

In determining whether a mark is well-known or not, the following criteria may be taken into account:

(a) the degree of knowledge or recognition of the mark in the relevant sector of the public;

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

(c) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the mark applies;

(d) the duration and geographical area of any registrations, or any applications for registration, of the mark to the extent that they reflect use or recognition of the mark;

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

(f) the value associated with the mark. "

4. Amendment of Regulation 17

Subregulation 17(1) of the principal Regulations is amended by deleting the words "adapted to distinguish within the meaning of section 10 or inherently."

5. New Regulation 17A

The principal Regulations are amended by inserting after regulation 17 the following regulation:

"Request for search.

17A. Any person may request the Registrar on Form TM 4A to cause a search to be made in respect of specified goods or services classified in any one class of the Third Schedule to ascertain whether any trade mark is on record at the date of the search which resembles a trade mark of which duplicate representations shall accompany the Form and the Registrar shall cause such a search to be made and the person making the request to be informed of the result of the search. "

6. Substitution of Regulation 59

The principal Regulations are amended by substituting for regulation 59 the following regulation:

"Late renewal.

59. If within one month from the expiration of the last registration of a trade mark the renewal fee has not been paid and if Form TM 13 is filed, accompanied by the late renewal fee, the Registrar shall renew the registration without removing the mark from the Register. "

7. New Part XIVA

The principal Regulations are amended by inserting after Part XIV the following part:

"PART XIVA

BORDER MEASURES

83A. Application to restrict importation of counterfeit trade mark goods.

(1) An application under section 70D to the Registrar to restrict the importation of counterfeit trade mark goods into Malaysia by the proprietor or an agent of the proprietor having the power to submit such application shall be made in Form TM 30 accompanied by the prescribed fee, an affidavit and five copies of the application.

(2) Each application shall be made in respect of a single trade mark and shall state the date, time and place the counterfeit trade mark goods are expected to be imported.

(3) An affidavit made under subregulation (1) shall state that the applicant is the proprietor of the mark or an agent having the power to submit such application, registration number of the said trade mark, the representation of the mark and interest of the applicant in the mark, if any. "

8. Amendment of First Schedule

The First Schedule to the principal Regulations is amended-

(a) in Part I-

(i) by inserting after Form TM 4 and the particulars relating thereto the following:

<i>FormTM</i>	<i>Matters orFee Proceedings</i>	<i>Fee RM</i>
"4A	Request for search	250.00";

and

(ii) by inserting after Form TM 29 and the particulars relating thereto the following:

<i>FormTM</i>	<i>Matters orProceedings</i>	<i>Fee RM</i>
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"30 Application to restrict300.00";and
importation of counterfeit
trade mark goods

(b) in Part II-

(i) by inserting after subitem 1*(c)* the following subitem:

"*(d)* Permitted information upon request100.00 for less than 10 pages and 5.00
(Hit list) for subsequent pages"; and

(ii) by inserting after item 2 the following item:

"3. Request to conduct public search20.00 per hour".
through computerhour".

9. Amendment of Second Schedule

The Second Schedule to the principal Regulations is amended-

(a) by inserting after Form TM 4 and the relevant particulars the following:

"4A Request for search";

(b) by inserting after Form TM 30 and the relevant particulars the following:

"30 Application to restrict importation of counterfeit trade mark goods";

(c) by inserting after Form TM 4 the following form:

"

INTELLECTUAL PROPERTY DIVISION - TRADE MARK



TRADE MARKS REGISTRY

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

REQUEST FOR SEARCH

(Regulation 17A)

<p>1. Representation of mark:</p> <p>If the space provided is insufficient, the representation may be made on a separate sheet which must be firmly annexed to this Form</p> <p>The representation must be clear and durable and comply with regulation 34 of the Trade Marks Regulations 1997.</p>
<p>2. Class:</p>
<p>3. List of goods or services:</p>
<p>4. Full name and address of applicant:</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>.....</p> <p>If the applicant resides abroad, an address for service in Malaysia must be provided.</p>

5. Full name and address of agent (if any):

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.....

.....

If this is the address for service and is not already on record, Form TM 1 must be filed with this Form.

6. Agent's Registration No. (if known):

7. Agent's own reference:

8. The Registrar is requested to search in Class in respect of to ascertain whether the trade mark(s) are on record which resemble the trade mark(s) sent herewith in duplicate and each representation

A4.

(Priority claim search is not included)

Signature:

Name of signatory (in block letters):

Date

INTELLECTUAL PROPERTY DIVISION - TRADE MARK

TRADE MARKS REGISTRY

TM 30

TRADE MARKS ACT 1976

TRADE MARKS REGULATIONS 1997

BORDER MEASURES

APPLICATION TO RESTRICT IMPORTATION OF COUNTERFEIT TRADE MARKS GOODS

(Regulation 83A)

FOR OFFICIAL USE

Application Date:

Fee:

* Cheque/Postal Order/Money Order/Cash/Draft No.:

Registrar's Remark:

Notice remain in force from until

(Not more than 60 days).

Security Deposit:

(as required under section 70E of the Trade Marks Act 1976)

Place of storage of seized goods:

(as directed under section 70F of the Trade Marks Act 1976)

<p>1. Applicant:</p> <p>(Proprietor of a registered mark or agent having the power)</p> <p>Name:</p> <p>Address:</p> <p>Nationality:</p> <p>Permanent residence or principal place of business:</p> <p>Telephone No. :</p>
<p>2. Trade Mark No. :</p>
<p>3. Class:</p>
<p>4. Representation of mark:</p>
<p>5. Specification of goods:</p>
<p>6. Particulars of importers of counterfeit trade mark goods:</p> <p>(i) Name and address of the importer:</p> <p>(ii) Name and registration number of the ship, aircraft, vehicle, etc.:</p> <p>(iii) Name of the place of the counterfeit trade mark goods expected to be imported:</p> <p>(iv) Expected date and time of arrival:</p>

(v) Company of origin:
7. Interest of the applicant in the mark, if any: Signature: Name of signatory (in block letters): Date: :.....

*Delete where inapplicable. "

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