

Developing and Updating Trademark Manuals and Guidelines: Experiences of Different Offices

Intellectual Property Corporation of Malaysia

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History of Trademark Examination Guidelines and Manual in MyIPO

On 27 December 2019, the Trademarks Act 2019 (the TMA 2019) has officially come into force in Malaysia, repealing the previous Trade Marks Act 1976 (the TMA 1976).

On 27 September 2019, the Government of Malaysia deposited its instrument of accession to the Madrid Protocol with WIPO's Director General, making Malaysia the 106th member of the Madrid System.

The Protocol officially entered into force in Malaysia on 27 December 2019, the same day the TMA 2019 came into force. The TMA 2019 is a total revamp and overhaul of the trademark regime in Malaysia.

History of Trademark Examination Guidelines and Manual in MyIPO

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The Trademark Division of Intellectual Property Corporation of Malaysia is making significant, concrete progress in revising the trademark registrar's Trademark Examination Manual, with the aim of bringing Malaysia's trademark examination standards into alignment with international standards for trademark examination.

- Under TMA 1976, we only have Manual of Trademark**
- TMA 2019, we introduce Guidelines of Trademark and Manual of Trademark**

Overview of TMA 2019

Notable key changes under the new Act:

- **Accession to the Madrid Protocol allowing one single application in one language to register a trademark in a total of 128 countries;**
- **Multi-Class Applications to cover goods and services in more than one international class;**
- **Recognition of non-traditional marks such as color, scent and sound;**
- **Recognition of collective marks such as clubs and trade unions;**
- **Recognition of trademark as a form of security interest;**
- **Expansion on the scope of trademark infringement;**
- **Replacement of system of registered user with statutory recognition of licensing;**

Guidelines and Manual of Trademark in MyIPO

In MyIPO we have;

- [Guidelines of Trademarks 2019](#) (have legal effect)
 - i) Section 160, if any person does not comply with the guidelines of trademark, they will be regarded as committing an offence and can be fined not exceeding ten thousand ringgit
 - ii) Guidelines are available on our website
- [Practice Direction \(on electronic filing\)](#)
- Manual Trademark (in progress)
 - i) in conjunction with IP Australia – settled in April 2022

OVERVIEW : NEW GUIDELINES

As there are significant differences involving the use of Non Traditional Trademarks and Madrid application under the new Trademark Act, the need to have new guidelines for applicant in making their application to register their trademark.

The definition of “trademark” has been significantly expanded to include “non-traditional trademarks”.

Under the TMA 2019, a mark is defined as any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

EXPERIENCES IN MAKING GUIDELINES

- i. Refer to other IP Office practices
(Singapore, United Kingdom, New Zealand & Australia) – some of the provision in Malaysia TMA & regulations are similar with those countries**
- ii. Refer to case law in other country**
- iii. Refer to textbook and scholarly articles**
- iv. In choosing trademark examples to be in guidelines, we have to take into account of the fact that Malaysia is a multicultural society and the issues that might arise from this fact**
- v. In line with IT system in MyIPO (our system can access MP3 files) – we accept sound mark representation in MP3**




OVERVIEW : NEW DRAFT MANUAL

- **Even though we have guidelines, we still need manual. The manual is intended to help examiner in the process of making a decision.**
- **The new draft manual seeks to create increased consistency through the establishment of clear and fair criteria to be used in examining trademark applications.**
- **In developing a new trademark manual, MyIPO get assistance from WIPO and IP Australia. Currently, the manual is still in progress.**

EXPERIENCES IN MAKING MANUAL

- 1. Some aspect from the old manual are still applicable under TMA 2019.**
- 2. Refer to MyIPO database to get real life example on registrable or unregistrable trademark**
- 3. Assistance from IP Australia on some of their practices in examining trademark and also Non-Traditional Mark**

EXAMPLE OF REGISTRABLE VS UNREGISTRABLE TM

Inherently capable of distinguishing	Inherently capable of distinguishing to a certain degree	Not capable of distinguishing
		
<p>Class 3: Cleaning preparations</p> <ul style="list-style-type: none"> The word qleen has no dictionary meaning As a whole, the mark is capable of distinguishing. 	<p>Class 3: Cleaning preparations</p> <ul style="list-style-type: none"> The word `kleen` is a misspelling of the word `clean`. However, the letter `v` before the word `kleen` has the capability of distinguishing. The mark may be accepted after submitting the evidence of use. 	<p>Class 3: Cleaning preparations</p> <ul style="list-style-type: none"> The mark is not distinctive on cleaning preparations. To be refused under absolute grounds.


EXAMPLE OF REGISTRABLE SOUND MARK

Sound	Goods/Services
Sound of wolf howling	Beer, wine and spirits
Sound of a child laughing	Taxation consultancy services
Sound of a chain saw	Retailing of books, clothing, foodstuffs
Applicant's name sung in an advertising jingle	Most goods and/or services
Church bells	Clothing; cosmetics; hand tools and cutlery

EXAMPLE OF UNREGISTRABLE SOUND MARK

Trademark	Goods/Services
Sound of a chain saw	Chain saw repair services; tree lopping services; retail of chain saws
Sound of a duck quacking, chicken clucking, roosters crowing	Live poultry, prepared/frozen poultry
Sound of a cash register ringing	Retailing services
Single bell tolling or a solemn hymn	Funeral services; undertaking services
Sound of glass breaking	Windscreen repair services; glass repair services
Sound of vehicle motor starting up and running	Vehicle sales; automotive repair and maintenance; vehicles in class 12
"ping" sound	Microwaves; retailing of microwaves

EXAMPLE OF REGISTRABLE SHAPE MARK

Trademark	Goods/Services	Rationale
 <p>Written description: The trademark consists of the three-dimensional shape of the goods as shown in the representations attached to the application form.</p>	Class 30: <i>Confectionery</i>	The shape was an invented one and was only suggestive of an insect shape. Other traders would have no desire to use the shape or similar shape without improper motive.

EXAMPLE OF UNREGISTRABLE SHAPE MARK

Trademark	Goods/Services	Rationale
 <p>Written description: <i>The trademark consists of a combination of the shape of a wine bottle and the colour green, as shown in the representation attached to the application form.</i></p>	Class 33: <i>Wine</i>	This particular combination of shape and colour does not give the trademark any inherent adaptation to distinguish, as both the shape and colour are commonly used in the course of trade.

ISSUES AND CHALLENGES

- The consistent understanding of the guidelines across the examination community so as to meet the demand of the customer
- Lack of information and training
- New legislation – Non-traditional mark examination
- As a new member signatory to the Madrid Protocol, we are in the process of familiarizing and understanding all the procedures involved

Handwritten signature in red ink, appearing to read "Karlson".