

PART III

Preliminary advice and search

Application for preliminary advice and search

4. (1) Any person may file an application to the Registrar for preliminary advice and search result under section 13 of the Act together with payment of the prescribed fee.
- (2) For the purpose of subparagraph (1), the applicant shall furnish to the Registrar the following information:
- (a) the applicant's name and address;
 - (b) a clear representation of the trademark or the graphic representation of the sign;
 - (c) description of shape of goods or their packaging, if applicable;
 - (d) a statement of the goods or services and the class of goods or services for which it is proposed to register the trademark; and

In filing an application for preliminary advice and search, the applicant shall use the pre-approved list which is based on the following source:

- (i) Nice classification
- (ii) Madrid Goods & Services

The pre-approved list is specified in the First Schedule.

- (e) if the trademark contains or consists of a word which is not in Roman character or the national language or English language—
 - (a) a translation of the word in the national language or English;
 - (ii) a transliteration of any characters; and
 - (iii) the language to which the word belongs.
- (3) An application made under subparagraph (1) shall not be applicable to collective mark, certification mark and signs which are colour, sound, scent, hologram, positioning or sequence of motion.
- (4) For the purpose of paragraph (2)(b), upon filing the application for preliminary advice and search result under subparagraph (1), the applicant shall submit to the Registrar —
 - (a) the maximum number of six series for series of trademarks; or
 - (b) the maximum number of six views for shape of goods or their packaging.
- (5) An application under subparagraph (1) may be made in a single application listing goods and services belonging to several classes of classification and in that case together with payment of the prescribed fee.

Example of computation of fee:

An application for preliminary advice and search is for RM250 for each class. Therefore, if an application for preliminary advice and search is applied for five (5) classes, it will be subject to fee of $RM250 \times 5 = RM1,250$.

- (6) After the Registrar received the request for preliminary advice and search, the Registrar shall examine the application to see if the request fulfill the requirements as specified in subparagraph (1) and if all the requirements are adhered to, the request for preliminary advice and search will be examined based on absolute grounds under section 23, relative grounds under section 24 and other grounds under the Act.
- (3) The Registrar shall issue the result of the application filed in paragraph (1) within one month from the date of the application.
- (4) The results issued by the Registrar under paragraph (7) are either in—
 - (a) affirmative; or
 - (b) not affirmative.

Filing of application for registration following issuance of advice and search result

5. (1) After the applicant had received the result of the Registrar and the result is in affirmative, the applicant may file an application for registration of a trademark according to section 17 of the TMA.

Explanation:

It is advisable to apply as soon as possible after the applicant received the affirmative result from the Registrar so as to avoid any other trademark to apply for registration of an identical or similar trademark within the same

period before the applicant files an application for registration with the Registrar.

- (2) In filing the application for registration under section 17 under paragraph (1), the applicant shall be required to fill in the preliminary advice and search reference number in the space provided in the application for registration of a trademark.

Application for refund of fee of application for registration of a trademark

6. (1) An applicant who files an application for registration of trademark with the Registrar after obtaining an affirmative result of preliminary advice and search by the Registrar and subsequently receives a notification of provisional refusal after the examination of the application for registration of trademark, he may request the Registrar to refund the fee of an application according to section 13(2) of the Act.
- (2) The applicant who wishes to request for the refund of fee of the application for registration of a trademark shall do so by filing the request for refund together with the payment the prescribed fee.
- (3) Before filing the request for refund of fee, the applicant must file a request for withdrawal of his application for a registration of a trademark by filing the withdrawal form and pay the prescribed fee.
- (4) The withdrawal must be made within two months from the date the applicant received the provisional refusal.
- (5) After receiving the request for refund, the Registrar shall consider whether the applicant fulfills the requirement for refund.

(6) There are two situations when refund of fee of application for registration of a trademark can be given as follows:

- (a) if the application for registration of a trademark received provisional refusal based on absolute grounds.

Illustration for (a): Based on provisional refusal on absolute grounds

An applicant had applied for preliminary advice and search. After examination, the Registrar issued an affirmative result to that preliminary advice & search that the trademark can be registered.

Acting on the advice, the applicant proceed to make an application to register his trademark. However, later on, the applicant received a provisional refusal based on absolute grounds. Since the provisional refusal was based on absolute grounds, the applicant is entitled to get refund on the fee paid for his application to register his trademark.

- (b) if the application for registration of a trademark received provisional refusal based on relative grounds due to error

Illustration for (b): Based on provisional refusal on relative grounds because of examiner's error

An applicant had applied for preliminary advice and search on 1 August 2020. After conducting the examination, the Registrar issued an affirmative result on 15 August 2020 that the trademark can be registered.

Acting on the advice, the applicant proceeds to make an application to register his trademark on 16 August 2020. However, later on, the

applicant received a provisional refusal based on relative grounds. The earlier mark was applied on 15 July 2020. Thus, the earlier mark should be on record during the Registrar's examination of the request for preliminary advice and search.

In this situation, the applicant is entitled to get refund on the fee paid for his application to register his trademark.

- (7) Notwithstanding paragraph (6), there are two situations where refund of fee of application for registration of a trademark cannot be given as follows:
- (a) If the application for registration of a trademark received provisional refusal on relative grounds out of control of Registrar;

Illustration for (a): provisional refusal on relative grounds out of control of examiner.

An applicant had applied for preliminary advice and search for a trademark on 1 August 2020. After examination, the Registrar issued an affirmative result of the preliminary advice & search on 15 August 2020 that the trademark can be registered.

Acting on the advice, the applicant proceed to make an application to register his trademark on 20 August 2020. However, another person had applied for the identical or similar trademark on 17 August 2020.

Later on, the applicant received a provisional refusal based on relative grounds. The earlier trademark was entered to the record after the Registrar had given the result of the request of preliminary

advice & search but before the applicant had make an application to register his trademark.

In this case, the existence of the earlier trademark is well beyond the control of the examiner. Thus, the applicant cannot apply for refund of fee under this circumstance.

- (b) If the application for registration of a trademark received provisional refusal on absolute grounds or relative grounds on the classes that was not part of the classes applied for during preliminary advice & search.

Illustration for (b): Provisional refusal on absolute or relative grounds on the classes that was not part of the classes applied for during preliminary advice and search.

Applicant applied for preliminary advice and search for classes 3 and 5 on 1 August 2020. After examination, the examiner issued the preliminary advice and search result that the trademark can be registered on 15 August 2020.

Acting on the advice, the applicant proceed to make an application to register his trademark on 16 August 2020. However, the applicant had not only applied for goods or services in class 3 and 5 but also in class 44.

Later on, the applicant received a provisional refusal based on either absolute or relative grounds but only for goods in class 44. Since services in class 44 is not part of the classes applied for during the

application of preliminary advice and search, an applicant cannot get a refund on the fees paid for application for registering the trademark.