



**GUIDELINES OF TRADEMARKS  
(TRANSITIONAL MATTERS) 2019**

**MyIPO/GTM(TM)/1/2019**

TRADEMARKS ACT 2019  
GUIDELINES OF TRADEMARKS (TRANSITIONAL MATTERS) 2019

---

ARRANGEMENT OF PARAGRAPHS

---

PART I

Preliminary

1. Citation, effective date and scope
2. Interpretation

PART II

Matters

3. Filing of any documents
4. Conversion of pending application
5. Amendments of assignment
6. Amendments of registered user
7. Payments of renewal fee
8. Requirements on registered trademark agents
9. Defensive trade marks
10. Forms and fee

## TRADEMARKS ACT 2019

### GUIDELINES OF TRADEMARKS (TRANSITIONAL MATTERS) 2019

THESE GUIDELINES are issued in the exercise of the power conferred upon the Registrar by section 183 of the Trademarks Act 2019 [Act 815].

#### PART 1

##### Preliminary

#### **Citation, effective date and scope**

1. (1) These guidelines may be cited as Guidelines of Trademarks (Transitional Matters) 2019.
- (2) These Guidelines shall be effective on 27 December 2019 until further notice by the Registrar.
- (3) These Guidelines set out requirements for all matters relating to transitional provisions as stipulated in Chapter 2 of Part XIX of the Trademarks Act 2019.
- (4) The provisions of the Trademarks Act 2019, Trademarks Regulations 2019, Guidelines of Trademarks 2019 and these Guidelines form the regulatory framework for the law of trademarks in Malaysia which shall be read together simultaneously.
- (5) In order to assist with the interpretation of the requirements under these Guidelines and their application, explanation, illustration or examples have been inserted, where appropriate. Any action or conduct which departs from explanation, illustration or examples shall be taken into account by the Registrar in determining compliance with these Guidelines as well as the

Trademarks Act 2019, Trademarks Regulations 2019 dan the Guidelines of Trademarks 2019.

(6) These Guidelines shall not apply to—

(a) application for registration of trademarks; and

(b) registered trademarks,

which are not affected by provisions on transitional matters under Part XIX of the Trademarks Act 2019.

## **Interpretation**

2. Unless otherwise defined, all words or terms used in these Guidelines shall have the meaning as defined in the Trademarks Act 2019. In these Guidelines, unless the context otherwise requires—

(a) “the Act” means the Trademarks Act 2019;

(b) “the Registrar” means the Registrar of Trademarks under section 12 of the Trademarks Act 2019;

(c) “the Regulations” means the Trademarks Regulations 2019;

(d) “the Guidelines” means the Guidelines of Trademarks 2019; and

(e) “the repealed Act” means the Trade Marks Act 1976.

PART II  
Matters

**Filing of any documents**

3. The requirements of filing and service under the Act, the Regulations and the Guidelines shall be applicable on the applicant or registered proprietor in filing any documents according to these Guidelines.

**Conversion of pending application**

4. (1) Where an application for registration of trade mark under section 25 of the repealed Act has been filed by an applicant with the Registrar but has not been examined by the Registrar on the commencement of this Act, the Registrar may examine the application of the trademark relating to the registrability of the trademark according to the provisions of the Act.
- (2) Before the Registrar examines the application under subparagraph (1), the applicant may give notice to the Registrar claiming to have the registrability of the trademark to be determined according to the provisions of the Act by filing an application for conversion of pending application under subsection 174(2) of the Act together with the payment of the prescribed fee within two months from the date of the commencement of the Act.
- (3) The applicant may not add or amend any matters on the representation of the trademarks or the specifications of goods or services, except as required under these Guidelines, as follows:
  - (a) description of the trademarks (if the application comprises sign such as shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion);

- (b) voluntary disclaimer; and
  - (c) any other requirements required by the Registrar.
- (4) By giving the notice to the Registrar under subparagraph (2), the applicant shall be deemed to have filed an application for registration of trademark according to section 17 of the Act.
- (5) Upon receiving the application by the applicant within the period as stated in subparagraph (2), the Registrar shall record a date of receipt of an application for registration of trademark according to section 22 of the Act.

**Illustration for paragraph 4(5)**

Z filed an application for registration of trademark under the repealed Act on 15 March 2019 (“the application”). Subsequently, on 30 January 2020, he gives notice to the Registrar claiming to have the registrability of the trademark to be determined according to the provisions of the Act together with the payment of the prescribed fee.

Following the above, the date of filing of the application shall be on 30 January 2020.

- (6) Following paragraphs (4) and (5), the application filed by the applicant shall be examined by the Registrar according to the provisions of the Act where all other relevant provisions relating to an application for registration of trademarks under the Act, Regulations and the Guidelines shall be applicable on the applicant.

### **Illustration for paragraph 4(1)**

Examples of “An application for registration of trade mark under section 25 of the repealed Act has been filed by an applicant with the Registrar but has not been examined by the Registrar” are as follows:

- (i) application which has been filed before the commencement of the Act;
- (ii) the Registrar has conducted formality examination or substantive examination;
- (iii) the Registrar has issued objection to the applicant and the applicant has responded or has not responded;
- (iv) the Registrar has issued “Maintained Objection” and the applicant has or has not filed request for a hearing under subregulation 27(4) or 28(4) of the Trade Marks Regulations 1997;
- (v) the Registrar has fixed the date for hearing but the hearing has or has not been conducted;
- (vi) the Registrar has not issued refusal according to subregulation 29(1) or (2) of the Trade Marks Regulations 1997;
- (vii) the Registrar has not been advertised according to section 27 of the repealed Act.

### **Amendments of assignment**

5. (1) Where an application under section 47 of the repealed Act has been filed by a registered proprietor with the Registrar but the application is:
- (a) pending before the Registrar on the commencement of the Act; or
  - (b) has been determined but has not been finally determined by the Registrar before the commencement of the Act,

the Registrar may proceed determining the application according to section 65 and 67 of the Act.

- (2) Before the Registrar determined the application under paragraph (1), the Registrar may require the registered proprietor to file an amendment of assignment application so as to conform to the requirements under section 65 of the Act and Part V of the Guidelines of Trademarks 2019 within the period as specified in the written notice together with the prescribed fee.
- (3) The registered proprietor shall not add or make any alterations on any matters relating to the assignment except as required by the Registrar, as follows:
  - (a) signature by both assignor and assignee;
  - (b) deed of assignment duly signed by the assignor and assignee; or
  - (c) any proof of title to the satisfaction of the Registrar.
- (4) Upon receiving the application by the registered proprietor under paragraph (2), the Registrar shall determine the application according to section 65 of the Act and Part V of the Guidelines.
- (5) The registered proprietor shall be bound to comply with the Registrar's direction therefrom.
- (6) If an applicant of pending application for registration of trade marks under section 172 has filed an application under section 47 of the repealed Act before the commencement of the Act and the trademark subsequently becomes registered under the Act as an existing registered trademark, the Registrar may

require the registered proprietor of the existing registered trademark to file an amendment of assignment application under subparagraph 5(2) above.

- (7) If the registered proprietor complies with subparagraph 5(6), paragraphs 5(2) to 5(5) shall apply accordingly.

### **Amendments of registered user**

6. (1) Where an application for registration as a registered user has been filed by a registered proprietor with the Registrar but is:

- (a) pending before the Registrar on the commencement of the Act; or
- (b) has been determined but has not been finally determined by the Registrar before the commencement of the Act,

the Registrar may proceed determining the application according to section 65 or 67 of the Act.

- (2) Before the Registrar determined the application under paragraph (1), the Registrar may require the registered proprietor to file an application of amendment of registered user to licensing so as to conform to the requirements under section 65 of the Act and the Part V of the Guidelines within the period as specified in the written notice together with the prescribed fee.

- (3) The registered proprietor shall not add or make any alterations on any matters relating to the registered user except as required by the Registrar, as follows:

- (a) signature by both licensor and licensee;
- (b) types of licensing according to the definition under paragraph 68 (a) or (b) of the Act.

- (4) Upon receiving the application by the registered proprietor under paragraph (2), the Registrar shall determine the application according to section 65 of the Act and the Part V of the Guidelines.
- (5) The registered proprietor shall be bound to comply with the Registrar's direction therefrom.
- (6) If an applicant of pending application for registration of trade marks under section 172 has filed an application under section 48 of the repealed Act before the commencement of the Act and the trademark subsequently becomes registered under the Act as an existing registered trademark, the Registrar may require the registered proprietor of the existing registered trademark to file an amendment registered user application under subparagraph 6(2) above.
- (7) If the registered proprietor complies with subparagraph 6(6), subparagraph 6(2) to 6(5) shall apply accordingly.

#### **Payments of renewal fee**

7. (1) Pursuant to subsection 177(2) of the Act, section 39(2) and 40 of the Act shall be applicable on the registered proprietor if the renewal of existing registered mark under the repealed Act falls due on or after the commencement of the Act.
- (2) For the purposes of the subparagraph (1), the renewal fee as specified under the First Schedule of the Regulations shall be applicable regardless that such fee has been paid before the commencement of the Act.

- (3) If the registered proprietor has paid for the renewal fee of an existing registered trademark where the renewal of the registered trademark falls due on or after the commencement of the Act, the registered proprietor shall pay the difference of the renewal fee with the Registrar by filing the form of insufficient of the renewal fee within the period of the renewal under subsection 39(4) of the Act.
- (4) If the registered proprietor fails to do so, subsections 39(5) to (11) of the Act shall apply accordingly.

**Illustration for subparagraph 7(1)**

If a registered trademark owned by Ahmad Sdn. Bhd. expires on 2 January 2020 and Ahmad Sdn. Bhd. has filed TM12 and paid RM550 (e-filing) or RM600 (manual) on 30 November 2019 before the commencement of the Act, Ahmad Sdn. Bhd. shall pay the difference of RM450 or RM400 by or on 2 January 2020.

If a registered trademark owned by Ahmad Sdn. Bhd. expires on 2 January 2020 and Ahmad Sdn. Bhd. has not filed TM12 before the commencement of the Act, Ahmad Sdn. Bhd. shall pay the difference of RM1000 by or on 2 January 2020.

**Illustration for subparagraph 8(4)**

If Ahmad Sdn. Bhd. fails to pay the difference by or on 2 January 2020 and pay the difference between 3 January 2020 to 2 July 2020, Ahmad Sdn. Bhd. shall pay the difference of RM650 or RM600 for the request for late renewal by 2 July 2020.

If Ahmad Sdn. Bhd. fails to pay the difference for the request for late renewal by or on 2 July 2020, the registered trademark owned by Ahmad Sdn. Bhd. shall be deemed removed and he has until 2 January 2021 to file restoration and pay the fee of RM950 or RM900 for the difference of the request for restoration. Failure to do shall result in the registered trademark being lapse and cease from being registered according to paragraph 41(a) of the Act.

### **Requirements on registered trademark agents**

8. (1) Pursuant to subsection 182(2) of the Act, the requirements for renewal of registration of trademark agents stated in the Guidelines shall be applicable on the registered trademarks agents who has obtained their registration under the repealed Act.
- (2) For the purposes of the subparagraph (1), in filing of application for renewal of registration of trademark agents which shall expire on 31 December 2020, the required courses stated in the Guidelines means sufficient period spent in the advancement of knowledge of the registered trademark agent in industrial property under the repealed Act may be accepted by the Registrar.
- (3) If the registered trademark agent under the repealed Act has paid for the renewal fee of registration of trademark agent which falls due on 31 December 2019 before the commencement of the Act, the registered trademark agent may request for refund by filing the application of request for fee refund (other special circumstances) within one month from 31 December 2019 failing which would result in the fee being non-refundable.

## **Defensive trade marks**

9. (1) Defensive trade mark which has been registered under the repealed Act shall continue to be treated as an existing registered mark under section 166 of the Act.
- (2) Since there is no provision on defensive trade marks in the Act, the registered defensive trademarks are deemed to be registered as trademarks under the Act following the commencements of the Act.
- (3) Under the Act, it is no longer possible to file an application for registration of a defensive trade mark.
- (4) If an applicant has filed an application for registration of a defensive trade mark under section 57 of the repealed Act, the Registrar shall continue to examine such application according to the requirement of the repealed Act and if the application becomes registered, it shall be treated as an existing registered mark according to subsection 172(1) of the Act which shall be subject to revocation for non-use under subsection 178(3) of the Act.

## **Forms and fee**

10. (1) All model forms for the purpose of manual filing pursuant to these Guidelines are attached as **Annex A**.
- (2) The schedule of the prescribed fee applicable for the purpose of filing the forms in subparagraph (1) is attached as **Annex B**.

**ANNEX A**

Fee Code	
TMQ3A	TMQ3B
TMQ4A	TMQ4B
TMQ5A	TMQ5B
<b>TMQ6</b>	
<b>TMQ7</b>	
<b>TMQ8</b>	

**TRADE MARKS REGULATION 2019**  
**Section / Regulation xxx**  
**GENERAL FORM FOR TRANSITIONAL MATTERS**

**Note:**

Please fill up all information require and attached related document if any.  
 Fee applicable for this request is for each class. Please indicate number of classes requested

<b>1</b>	<p><b>Reason for making this request:</b> Please mark off whichever is applicable</p> <table border="1" style="width: 100%; border-collapse: collapse; margin-top: 10px;"> <thead> <tr> <th style="width: 5%;"></th> <th style="width: 45%;">a) Insufficient of—</th> <th style="width: 15%;">Fee Code</th> <th style="width: 15%;">Electronic filing before 27 December 2019 (for each class)</th> <th style="width: 20%;">Manual Filing before 27 December 2019 (for each class)</th> </tr> </thead> <tbody> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>(i) the renewal fee;</td> <td>TMQ3A   TMQ3B</td> <td style="text-align: center;">450</td> <td style="text-align: center;">400</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>(ii) the renewal fee and surcharge;</td> <td>TMQ4A   TMQ4B</td> <td style="text-align: center;">650</td> <td style="text-align: center;">600</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>(iii) the renewal fee and restoration;</td> <td>TMQ5A   TMQ5B</td> <td style="text-align: center;">950</td> <td style="text-align: center;">900</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>b) Conversion of pending application Please proceed to Item no 4 and 5</td> <td style="text-align: center;"><b>TMQ6</b></td> <td colspan="2" style="text-align: center;">600 (for each class)</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>c) Amendment of assignment under repealed Act</td> <td style="text-align: center;"><b>TMQ7</b></td> <td colspan="2" style="text-align: center;">100 (for each application)</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>d) Amendment of Registered User to Licensing</td> <td style="text-align: center;"><b>TMQ8</b></td> <td colspan="2" style="text-align: center;">50 (for each application)</td> </tr> </tbody> </table>		a) Insufficient of—	Fee Code	Electronic filing before 27 December 2019 (for each class)	Manual Filing before 27 December 2019 (for each class)	<input type="checkbox"/>	(i) the renewal fee;	TMQ3A   TMQ3B	450	400	<input type="checkbox"/>	(ii) the renewal fee and surcharge;	TMQ4A   TMQ4B	650	600	<input type="checkbox"/>	(iii) the renewal fee and restoration;	TMQ5A   TMQ5B	950	900	<input type="checkbox"/>	b) Conversion of pending application Please proceed to Item no 4 and 5	<b>TMQ6</b>	600 (for each class)		<input type="checkbox"/>	c) Amendment of assignment under repealed Act	<b>TMQ7</b>	100 (for each application)		<input type="checkbox"/>	d) Amendment of Registered User to Licensing	<b>TMQ8</b>	50 (for each application)	
	a) Insufficient of—	Fee Code	Electronic filing before 27 December 2019 (for each class)	Manual Filing before 27 December 2019 (for each class)																																
<input type="checkbox"/>	(i) the renewal fee;	TMQ3A   TMQ3B	450	400																																
<input type="checkbox"/>	(ii) the renewal fee and surcharge;	TMQ4A   TMQ4B	650	600																																
<input type="checkbox"/>	(iii) the renewal fee and restoration;	TMQ5A   TMQ5B	950	900																																
<input type="checkbox"/>	b) Conversion of pending application Please proceed to Item no 4 and 5	<b>TMQ6</b>	600 (for each class)																																	
<input type="checkbox"/>	c) Amendment of assignment under repealed Act	<b>TMQ7</b>	100 (for each application)																																	
<input type="checkbox"/>	d) Amendment of Registered User to Licensing	<b>TMQ8</b>	50 (for each application)																																	
<b>2</b>	<p><b>Application or Registration No.</b> :</p>																																			
<b>3</b>	<p><b>Class(es)</b> :</p> <table border="1" style="width: 100%; height: 30px; border-collapse: collapse; margin-top: 5px;"> <tr> <td style="width: 12.5%;"></td> </tr> </table>																																			
<b>4</b>	<p><b>Type Of Trademark</b></p> <ul style="list-style-type: none"> <li>i. <input type="checkbox"/> Trademark</li> <li>ii. <input type="checkbox"/> Collective Mark. Please file rule of collective mark (Fee code TMA3 – RM300 each class)</li> <li>iii. <input type="checkbox"/> Certification Mark. Please file rule of certification mark (Fee code TMA3 – RM300 each class)</li> </ul>																																			

5

**Additional Information**

This is required for conversion of pending application if the request is to **convert** existing trademark to the nature of trademark to the following only:

Select	Nature of Trademark	Description of Trademark
<input type="checkbox"/>	i <b>Shape of goods or their packaging</b>	Please indicate the number of views in the box. The maximum number of images per trademark is 6 <input type="text"/>
<input type="checkbox"/>	ii <b>Colour.</b>	Please provide pantone colour here:
<input type="checkbox"/>	iii <b>Hologram</b>	Please provide the description of the trademark here:
<input type="checkbox"/>	iv <b>Positioning</b>	Please provide the description of the trademark here:
<input type="checkbox"/>	v <b>Sequence of Motion</b>	Please provide the description of the trademark here:
<input type="checkbox"/>	vi <b>Any combination of the above (please Mark also the nature of trademark to be combined)</b>	Please provide additional information if any:

6

**Declaration:** **By Person Filing the Form**

I, the undersigned, do hereby declare that the information furnished above is true to the best of my knowledge.

 **By Agent**

I, the undersigned, do hereby declare that:

- i I have been duly authorized to act as an agent on behalf of the person(s) filing this form.
- ii The information furnished above on behalf of the person(s) filing this form is true to the best of the person(s)' knowledge.

Signature: .....

Name of signatory: .....

Official capacity of signatory: .....

(Examples: Authorized person, Director, Partner or Principal Officer of Applicant(s)/ Agent)

	Date: .....  <b>Attention:</b> <b>It is an offence under section 103 of the Trademarks Act 2019 to make or cause to be made a false entry to the Trademarks Office and that person may be liable to a fine not exceeding RM50,000 or to a term of imprisonment not exceeding 5 years or to both.</b>		
7	<b>CONFIDENTIALITY OF DOCUMENT</b> (Please tick off the box if applicable)  <input type="checkbox"/> I want to apply for this document to be treated as confidential (Fee of RM 10 will be added to the application fee)		
8	<b>SCANNING SHEET</b> (Self-calculation of payment for scanning services)		
	No	Name of Document	No of Page(s)
			Amount (RM2 for each page)
	<b>TOTAL PAGES AND AMOUNT TO PAY</b>		
	<input type="checkbox"/> If more space is necessary, tick off this box and use an additional sheet		
9	<b>PAYMENT DETAILS</b> [Note: This will depend on the method of payment accepted.]		
	<input type="checkbox"/> Cash	<input type="checkbox"/> Cheque (Cheque No.)	
	<input type="checkbox"/> FPX	<input type="checkbox"/> Local Order (LO No.)	
	<input type="checkbox"/> Credit Card	<input type="checkbox"/> Other, please specify:	

**ANNEX B**

General form for transitional matters:

<b>Matter</b>	<b>Fee Code</b>		<b>Electronic filing before 27 December 2019 (for each class)</b>	<b>Manual Filing before 27 December 2019 (for each class)</b>
e) Insufficient of—				
(iv) the renewal fee;	TMQ3A	TMQ3B	450	400
(v) the renewal fee and surcharge;	TMQ4A	TMQ4B	650	600
(vi) the renewal fee and restoration.	TMQ5A	TMQ5B	950	900
<b>Matter</b>	<b>Fee Code</b>		<b>Fee</b>	
f) Conversion of pending application Please proceed to Item no 4 and 5	TMQ6		600 (for each class)	
g) Amendment of assignment under repealed Act	TMQ7		100 (for each application)	
h) Amendment of Registered User to Licensing	TMQ8		50 (for each application)	