



**INTELLECTUAL PROPERTY CORPORATION
OF MALAYSIA (MyIPO)**

**TRADEMARKS ACT 2019
PRACTICE DIRECTION NO. 2/2020
(VA2-2021)**

1st Issued: 16 October 2020

Varied (1): 12 January 2021

Varied (2): 1 June 2021

**TRADEMARKS ACT 2019
PRACTICE DIRECTION NO. 2/2020**

Effective Date Upon Issuance:	16 October 2020
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LIST OF VARIATIONS

Variation Series	Variation Date	Effective Date of Variation	Series Number
1st Variation	12 January 2021	13 January 2021	(VA1-2021)
2nd Variation	1 June 2021	1 June 2021	(VA2-2021)

TRADEMARKS ACT 2019
PRACTICE DIRECTION NO. 2/2020

THIS PRACTICE DIRECTION is issued in the exercise of the power conferred upon the Registrar of Trademarks by sections 160 and 183 of the Trademarks Act 2019 [Act 815] and in view of the global pandemic COVID '19 that is currently taking place in Malaysia.

PART I

Preliminary

Citation, effective date and scope

1. (1) This practice direction may be cited as the Practice Direction No. 2/2020.
- (2) The variation made to the Practice Direction No. 2/2020 shall be effective on 1 June 2021 until further notice by the Registrar of Trademarks.
- (3) This Practice Direction No. 2/2020 sets out the requirements to be complied with:
 - (a) by an applicant for registration, opponent, registered proprietor of trademark or any person recognized under the repealed Act or the Trademarks Act 2019 who is interested to file with the Registrar of Trademarks any forms under the repealed Act, or applications or requests under the Trademarks Act 2019 **except** for the forms, applications or requests which are stated in the First Schedule together with the payment of the prescribed fee; and
 - (b) by an applicant for registration, opponent, registered proprietor or any person recognized under the repealed Act or the Trademarks Act 2019 who wishes to give, file, send, serve or submit any documents or any other matter required or authorized by the

repealed Act or the Trademarks Act 2019 to or with the Registrar of Trademarks by way of email.

- (4) Beginning from the effective date of the Practice Direction No. 2/2020 including the variation made to it—
- (a) all payments of the prescribed fee in relation to the forms under the repealed Act, or fee codes under the Trademarks Act 2019 **except** for the forms or fee codes which are stated in the First Schedule may be made to the Registrar of Trademarks through bank or interbank transfer via instant online transfer; and
 - (b) any documents or any other matter required or authorized by the repealed Act or the Trademarks Act 2019 stated in Part III of this Practice Directions may be given, sent, filed or served to or with the Registrar of Trademarks by way of email.

Notes:

“Instant online transfer” means the mode of transfer is—

- (i) Instant Transfer (IBFT) and not the Interbank GIRO (IBG) if online transfer is made through Maybank’s website;
- (ii) DuitNow and not the Interbank GIRO (IBG) if online transfer is made through Bank Rakyat’s website.

Please note that only instant online transfer is accepted by the Registrar even though the terms used by the banks vary.

- (5) In order to assist with the interpretation of the requirements under this Practice Direction No. 2/2020 and its application, notes and illustrations have been inserted. Any action or conduct which departs from the notes

or illustrations may be taken into account by the Registrar in determining the compliance with this Practice Direction as well as the Trademarks Act 2019, Trademarks Regulations 2019 and Guidelines of Trademarks 2019.

- (6) By complying to this Practice Direction No. 2/2020, the applicant for registration, opponent, registered proprietor of trademark or person recognized under the repealed Act or the Trademarks Act 2019 shall be deemed to have fulfilled the requirement of filing the documents with the Registrar—
- (a) according to regulation 8 of the Trade Marks Regulations 1997;
or
 - (b) in other manner as directed by the Registrar according to paragraph 30 of the Guidelines of Trademarks 2019; and
 - (c) in other manner as determined by the Registrar according to paragraph 31 of the Guidelines of Trademarks 2019.
- (7) This Practice Direction No. 2/2020 does not replace the availability of filing relevant application at the Trademarks Office or through electronic filing system which is made available by the Registrar of Trademarks.

Interpretation

2. (1) Unless otherwise defined, all words or terms used in this Practice Direction shall have the meaning as defined in the Trademarks Act 2019, Trademarks Regulations 2019 and Guidelines of Trademarks 2019.
- (2) In this Practice Direction No. 2/2020, unless the context otherwise requires, “Practice Direction” means the Practice Direction No. 2/2020 including the variations made to it.

PART II

Requirements to be complied in making payment

Requirements to be complied by the applicant or the registered proprietor of trademark

3. (1) For the purpose of filing any of the forms, or applications or requests as stated in paragraph 1(3)(a), the applicant for registration, opponent, the registered proprietor of trademark or any person recognized under the repealed Act or the Trademarks Act 2019 shall—
- (a) check the status of the application for registration or registration of trademark and the required action that needs to be taken by the applicant, opponent, registered proprietor or the person;
 - (b) use the correct form or model form in relation to the action to be taken by the applicant, opponent, registered proprietor or the person and check the amount of the prescribed fee required;
 - (c) fill in the relevant form or model form;

Note:

(1) In order to avoid making mistakes or paying insufficient amount of the prescribed fee, the applicant, opponent, registered proprietor or the person recognized under the repealed Act or the Trademarks Act 2019 is encouraged to call any of the following officers prior to filing any forms under the Trade Marks Act 1976, or applications or request under the Trademarks Act 2019 except for the form, application or request stated in the First Schedule:

- (i) Puan Noraniza Bujai at **03-8740 2669**
- (ii) Puan Zakini Yaman at **03-8958 7596**
- (iii) Puan Nurul Anura Nazam at **03-4162 7557**

(2) For the purpose of filing an international application and form MP1, the applicant is urged to consult with the officer in charge at mymadrid@myipo.gov.my or call any of the following officers for initial advice prior to filing the same:

- (i) Puan Zaiton Haris at **010-8456413**
- (ii) Puan Noryantie Mohamad at **010-8456414**
- (iii) Puan Noorhabibah Baharum at **03-2299 8951**

(3) For the purpose of filing a notice of opposition or counter-statement, the opponent or applicant is urged to consult with the officer in charge at opposition@myipo.gov.my or call any of the following officers for initial advice prior to filing the same:

- (i) Puan Nazirah Abdul Jalil at **03-22998643**
- (ii) Puan Zaitilakhtar Md. Yunus at **03-22998747**
- (iii) Puan Faiza Alip at **03-22998642**
- (iv) Puan Siti Salwa Ghazali at **03-22998659**

(d) make payment through bank or interbank transfer as stated in paragraph 1(4) to—

- (i) **Account no.:** **564016108622**
- (ii) **Name of bank:** **Malayan Banking Berhad**
- (iii) **Swift code:** **MBBEMYKL**
- (iv) **Effective date:** **Today** (the same date the instant online transfer is made to the Registrar)

Notes:

- (1) Please note that the effective date of instant online payment has to be the same date the payment is made

to the Registrar whereby no future date of payment is accepted.

(2) An applicant for registration of trademark, a registered proprietor of trademark or his registered trademark agent may make one payment for—

(a) one form, application or request;

(b) a maximum number of seven types of forms or fee codes having the same application or registration number; or

(c) a maximum number of seven applications or registration numbers for the payment of prescribed fee of the same form or fee code.

Scenario for note (2)(a):

An applicant for registration of trademark wishes to make an amendment of his address. He may make instant online payment of RM 20 for the fee code TMB4 after filling in the model form.

Scenario for note (2)(b):

An applicant for registration of trademark wishes to file rules of collective mark and make an amendment to his address as well as the goods stated in the TMA2 filed with the Registrar earlier. These matters are going to be handled by a registered trademark agent who is authorized and appointed by the applicant. Since these matters are for one application only, the payment for all matters can be made at one time. Therefore, the agent may make instant online payment of RM 440 for the fee codes of TMA3 (RM 300), TMB2 (RM 100), TMB4 (RM 20) and TMR7 (RM 20) after filling in all the model forms.

Scenario for note (2)(c):

A registered trademark agent wishes to renew seven registered trademarks for his client. Since it involves one fee code only, the payment for renewal of all seven registered trademarks can be made at one time. Therefore, the agent may make online payment of RM 7000 for the fee codes of TME1 after filling in the model forms.

- (e) fill in, during the bank or interbank transfer—
- (i) the email address of **efttm@myipo.gov.my** in the **recipient's email column**;
 - (ii) the number of application for the registration or registration of trademark in the **recipient's reference column**; and
 - (iii) the name of the payee either the applicant, opponent, registered proprietor, the person or his registered trademark agent in **other payment details column**;

Notes:

(1) An example of the required information that needs to be filled in during the bank or interbank transfer can be found in the Second Schedule.

(2) The name of the payee filled in according to paragraph 3(1)(e)(iii) shall be included in the receipt of payment to be issued by the Registrar according to paragraph 4 as the “pembayar”. Failure to fill in this detail as required under paragraph 3(1)(e)(iii) shall result in the name of the account holder as the “pembayar”. In the event

that the bank does not allow the applicant, opponent, registered proprietor, the person or his registered trademark agent to fill in this required detail as stated in paragraph 3(e)(iii), the applicant, opponent, registered proprietor, the person or his registered trademark agent shall inform this matter to the Registrar in the email as required under paragraph 3(f).

- (f) after the bank or interbank transfer succeeded, email the required details in the format stated in the Third Schedule together with following documents to **efftm@myipo.gov.my**:
- (i) forms under the repealed Act, or application, request, notice of opposition or counterstatement under the Trademarks Act 2019 in relation to the action taken by the applicant, opponent, registered proprietor or person in pdf format; and
 - (ii) receipt or proof of payment through the bank or interbank transfer in pdf format.

Note:

The format of the email with the required details to be sent to the Registrar after filling in the form or model form and making instant online payment can be found in the Third Schedule.

- (2) In filling in the form or model form under paragraph 3(1)(c), all the requirements stipulated under the repealed Act, Trademarks Act 2019, Trademarks Regulations 2019, Guidelines of Trademarks 2019 and

Guidelines of Trademarks (Transitional Matters) 2019, whichever relevant, shall be applicable.

Note:

The requirements of appointment and authorization of an agent under sections 79 and 80 under the repealed Act and section 95 of the Trademarks Act 2019 shall apply in filing or submitting any documents with the Registrar.

- (3) The Registrar shall process the forms under the repealed Act, or applications or requests under the Trademarks Act 2019 filed by the applicant for registration or the registered proprietor of trademark who has complied with all the requirements under paragraph 3(1) and (2) accordingly.

Issuance of receipt

4. (1) Upon receiving an email under paragraph 3(1)(f) from the applicant, opponent, registered proprietor or the person, the Registrar shall issue a receipt of payment to the email given by the applicant, opponent, registered proprietor or the person—
- (a) on the same day, if the Registrar received the email together with the completed form or model form and receipt or proof of payment through the bank or interbank transfer **from 12.00 am to 4.00 pm on any day from Monday to Friday**; or
- (b) on the next working day, if the Registrar received the email together with the completed form or model form and receipt or proof of payment through the bank or interbank transfer **from 4.01 pm to 11.59 pm on any day from Monday to Friday or on any excluded days.**

- (2) The receipt issued by the Registrar in paragraph 4(1)(b) shall include the actual date of payment made by the applicant for registration or registered proprietor of trademark.
- (3) No receipt shall be issued or the issuance of the receipt shall be delayed by the Registrar if the applicant for registration or registered proprietor of trademark sent the email together with the completed form or model form and receipt or proof of payment which do not fulfill all the requirements under paragraphs 3(1) and 3(2).

Illustration for paragraph 4(2):

The applicant is instructed by the Registrar to restrict goods or services to ensure the trademark application can proceed to registration. He must do so by filing TMB2 by 26 October 2020. The applicant's agent received an instruction to file the said application for restriction of goods or services (fee code: TMB2) at 4.00 pm on 26 October 2020 and sent the email to the Registrar confirming the filing of the application together with proof of payment of the prescribed fee at 8.30 pm on 26 October 2020.

In this case, the Registrar will issue the receipt on 27 October 2020. However, the applicant is considered to have complied with the office action within the time as instructed by the Registrar as the email confirming the filing of the application together with proof of payment of the prescribed fee was sent to the Registrar on 26 October 2020.

Filing of notice of opposition or counterstatement with the Registrar

5. (1) Within the time stipulated under the Act and Regulations, an opponent or applicant for registration of trademark under the repealed Act or the Trademarks Act 2019 may file a notice of opposition and statement of grounds or counterstatement by way of email by complying to the requirements under paragraph 3.

- (2) Notwithstanding the time stipulated under the Act and Regulations, any person may file a notice of opposition to oppose the application for registration of trademarks which was accepted and published in the Intellectual Property Official Journal, if he fulfils the following conditions:
- (a) has filed form D1 with the Registrar from 13 January 2021 to 31 May 2021;
 - (b) make payment of the prescribed fee with the Registrar by 14 June 2021; and
 - (c) fulfil the requirements under 5(2)(b) by complying to the requirements under paragraph 3.

Note:

Based on section 153 of the Trademarks Act 2019, the Registrar of Trademarks has given extension of time to all parties in the opposition proceedings since 13 January 2021 to 31 May 2021. Therefore, following the introduction of the Practice Direction 2/2021 (VA2-2021), all documents in relation to opposition proceedings which was extended before may be filed with the Registrar according to the requirements stated under this Practice Directions.

- (3) In filing the document under paragraph 5(1), all other requirements stipulated under the repealed Act, Trademarks Act 2019, Trademarks Regulations 2019, Guidelines of Trademarks 2019 and Guidelines of Trademarks (Transitional Matters) 2019, whichever relevant, shall be applicable.

PART III

Requirements to be complied with in filing document without payment

Filing of document with Registrar

6. (1) Except for matters stated in paragraphs 3, 5, 7 and 8 of this Practice Direction, where the repealed Act, the Trademarks Act 2019, the Regulations or the Guidelines of Trademarks authorize or require any

document to be given or sent to, filed with or served on the Registrar, the giving, sending, filing or service may be made by way of email according to manner stated in paragraphs 6(2) and 6(3).

- (2) For the purpose of giving, sending, filing or service as stated under paragraph 6(1), the applicant for registration, opponent, registered proprietor or any person recognized under the repealed Act or the Trademarks Act 2019 may do so by emailing the document to **nopaymentcd@myipo.gov.my**.

Note:

(1) This paragraph is applicable to giving, sending, filing or service of documents which are not subject to any payment of the prescribed fee such as:

- (a) a reply to an objection letter issued by the Registrar under regulation 27 of the Trade Marks Regulations 1997; or
- (b) a written representation to a provisional refusal issued by the Registrar under regulation 17 of the Trademarks Regulations 2019.

(2) The maximum capacity of an email together with the attachment to be sent to the Registrar is 10MB. If the applicant or registered proprietor wishes to send an attachment beyond the capacity, the applicant or registered proprietor may do so by sending the email in consequent to the first email sent to the Registrar. If the applicant or registered proprietor is sending more than one emails to the Registrar to respond to the same matter, the title of the email should reflect as follows:

Email 1:

RE: Written Submission for Trademark Application No. 2020123456 (1/3)

Email 2:

RE: Written Submission for Trademark Application No.
2020123456 (2/3)

Email 3:

RE: Written Submission for Trademark Application No.
2020123456 (3/3)

- (3) Upon receiving the document under paragraph 6(2), the Registrar shall issue an email acknowledging the filing made by the applicant, opponent, registered proprietor or person recognized under the repealed Act or the Trademarks Act 2019.
- (4) In giving, sending, filing, submitting or service the document under paragraph 6(1), all other requirements stipulated under the repealed Act, Trademarks Act 2019, Trademarks Regulations 2019, Guidelines of Trademarks 2019 and Guidelines of Trademarks (Transitional Matters) 2019, whichever relevant, shall be applicable.

Filing documents under regulations 40, 41, 42, 43 and 46 of the Trade Marks Regulations 1997 and regulations 25, 26, 27, 28 and 30 under the Trademarks Regulations 2019 with Registrar

7. (1) An opponent or applicant for registration of trademark under the repealed Act or the Trademarks Act 2019 may file the documents under regulations 40, 41, 42, 43 and 46 of the Trade Marks Regulations 1997 or regulations 25, 26, 27, 28 and 30 under the Trademarks Regulations 2019 with the Registrar by way of email by fulfilling the requirements under paragraph 7(2) and 7(3).
- (2) For the purpose of filing the documents as stated under paragraph 7(1), the opponent or applicant of registration of trademark may do so by emailing the document to **nonpaymentoppo@myipo.gov.my**.

Note:

The maximum capacity of an email together with the attachment to be sent to the Registrar is 10MB. If the opponent or applicant wishes to send an attachment beyond the capacity, the applicant or opponent may do so by sending the email in consequent to the first email sent to the Registrar. If the opponent or applicant is sending more than one emails to the Registrar on to the same matter, the title of the email should reflect as follows:

Email 1:

RE: Evidence in Support of Opposition for Trademark Application No. 2020123456 (1/3)

Email 2:

RE: Evidence in Support of Opposition for Trademark Application No. 2020123456 (2/3)

Email 3:

RE: Evidence in Support of Opposition for Trademark Application No. 2020123456 (3/3)

- (3) Upon receiving the document under paragraph 7(2), the Registrar shall issue an email acknowledging the filing made by the opponent or applicant.
- (4) In filing the document under paragraph 7(1), all other requirements stipulated under the repealed Act, Trademarks Act 2019, Trademarks Regulations 2019, Guidelines of Trademarks 2019 and Guidelines of Trademarks (Transitional Matters) 2019, whichever relevant, shall be applicable.

Service of application to Court under regulation 74 of the Trade Marks Regulations or section 140 of the Trademarks Act 2019 on the Registrar

8. (1) Applicant for registration of trademark, registered proprietor or any person recognized under the repealed Act may file or serve the documents under regulation 74 of the Trade Marks Regulations 1997 with the Registrar by way of email by fulfilling the requirements under paragraph 8(2) and 8(3).
- (2) For the purpose of filing as stated under paragraph 8(1), the applicant for registration of trademark, registered proprietor or person may do so by emailing the document to **legaldoc@myipo.gov.my**.
- (3) Upon receiving the filing of the document under paragraph 8(2), an email acknowledging the filing or service made by the applicant for registration of trademark, registered proprietor or person shall be issued.
- (4) For the purpose of filing and serving the documents section 140 of the Trademarks Act 2019 and regulation 51 of the Trademarks Regulations 2019 with the Registrar, the requirements of paragraph 3 of this Practice Direction shall be applicable.

FIRST SCHEDULE

SECOND SCHEDULE

THIRD SCHEDULE

REGISTRAR OF TRADEMARKS

1 June 2021

FIRST SCHEDULE

INSTANT ONLINE PAYMENT IS **NOT APPLICABLE** FOR THIS FORM,
APPLICATION OR REQUEST

(1) NO.	(2) FORM/ APPLICATION/ REQUEST	(3) FORMS/ FEE CODE
Trademarks Act 2019		
1.	Application for preliminary advice and search	TMA1
2.	Application for registration of trademark	TMA2
3.	Filing of request for form or document certified true copy by Registrar	TMJ1
4.	Filing of request for certified and sealed by Registrar printed, written copies or extract of or from the Register	TMJ2

SECOND SCHEDULE

Example of information needed during bank or interbank transfer

The diagram shows a payment form with the following fields and callouts:

- Amount :** 650.00 (Callout: Total Fee)
- From Account :** xxx
- Effective date :** Today (dropdown menu)
- Recipient email :** efttm@myipo.gov.my (Callout: Email)
- Recipient reference :** TM2019001234 @ TM2019001234 & 6 ors. (Callout: No. of application or registration of trademark)
- Other payment details :** NW Sdn Bhd (Callout: Name of the applicant, registered proprietor or agent of the trademark)
- To 3rd Party Account Number :** 564016108622 (Callout: MyIPO's Account No.)
- Continue** (button)

THIRD SCHEDULE

Format of email containing the details required under paragraph 3(1)(f)

To: efftm@myipo.gov.my

Cc:

Bcc:

Subject: No. of application for the registration or registration of trademark

Attachment(s): Forms/ model forms and receipt/proof of payment

Content: As below

No.	Appli- ca- tion/ Regis- tration No.	Name of Payee (to be named in the receipt as "pembayar")	Email address for issuance of receipt	Fee payment		Date of making instant online payment	Trade- mark's Office Official Remark	MyIPO's Finance Official Remark
				Form / Fee Code	Am- ount of Fee			
1.								
2.								
3.								
4.								
5.								
6.								
7.								

**SUMMARY OF VARIATIONS MADE TO THE
PRACTICE DIRECTIONS NO. 2/2020 (VA2-2021)
(Issued: 1 June 2021)**

The summary of key variations made to the Practice Direction No.2/2020 (VA2-2021) issued on 1 June 2021 is provided as follows:

1. General		
(a)	Consequential amendment to the Practice Direction and certain other referencing changes following the variations.	
(b)	Insertion of new notes under: <ul style="list-style-type: none"> i. Paragraph 3(1)(c) relating to filing of notice of opposition and counterstatement; ii. Paragraph 3(2) relating to the requirement of appointment and authorization of an agent; iii. Paragraph 5(2)(c) relating to filing of notice of opposition together with the payment of the prescribed fee; iv. Paragraph 6(2) relating to maximum capacity and manner of submission via email; and v. Paragraph 7(2) relating to maximum capacity and manner of submission via email. 	
(c)	Editorial amendments including rephrasing of certain paragraph without any change in policy.	
2. Specific variation		
No.	Paragraph/Schedule	Variation
(a)	Paragraph 5 on filing of notice of opposition or counterstatement	Paragraph 5 is introduced. This means that any person or applicant for registration of trademark may now file notice of opposition or counterstatement with the Registrar by way of email and make payment through instant online transfer.
(b)	Part III	Part III is introduced. This Part laid down the requirements to be complied with in filing document without payment by way of email.
(c)	Paragraph 6 on filing of document with Registrar	Paragraph 6 is introduced. This means that any person recognized under the repealed Act or the Trademarks Act 2019 may now

		file any reply required under the said Acts or letters to the Registrar by way of email. This is only applicable for matters which are not subject to any payment of the prescribed fee.
(d)	Paragraph 7 on filing of document with Registrar	<p>Paragraph 7 is introduced.</p> <p>This means that any opponent or applicant for registration of trademark may now file evidence in support of opposition or other documents under the opposition proceeding with the Registrar by way of email.</p>
(e)	Paragraph 8 on filing of document with Registrar	<p>Paragraph 8 is introduced.</p> <p>This means that any applicant for registration of trademark or registered proprietor may now file or serve any application to Court on the Registrar by way of email.</p>
(f)	Items 1 to 3 under the repealed Act of the First Schedule	<p>Items 1 to 3 under the repealed Act of the First Schedule are deleted.</p> <p>This means that Forms TM7, TM8 and TM27A as well as payment of the prescribed fee for the said forms may be filed according to the procedures stated under this Practice Direction No.2/2020 subject to the transitions given.</p>
(g)	Items 3 to 5 under the Trademarks Act 2019 of the First Schedule	<p>Items 3 to 5 under the Trademarks Act 2019 of the First Schedule are deleted and replaced with new items.</p> <p>This means that Forms TMD1, TMD2, TMD3, TMD4, TMD5, TMD6, TMK1 and TMK2 as well as payment of the prescribed fee for the said forms may be filed according to the procedures stated under this Practice Direction No.2/2020 subject to the transitions given.</p> <p>At the same time, this means that TMJ1 and TMJ2 cannot be filed according to the procedures stated under this Practice Direction No.2/2020.</p>