

CHAPTER 13

MALAYSIA – AS A DESIGNATED CONTRACTING PARTY

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13.0 Malaysia as a Designated Contracting Party

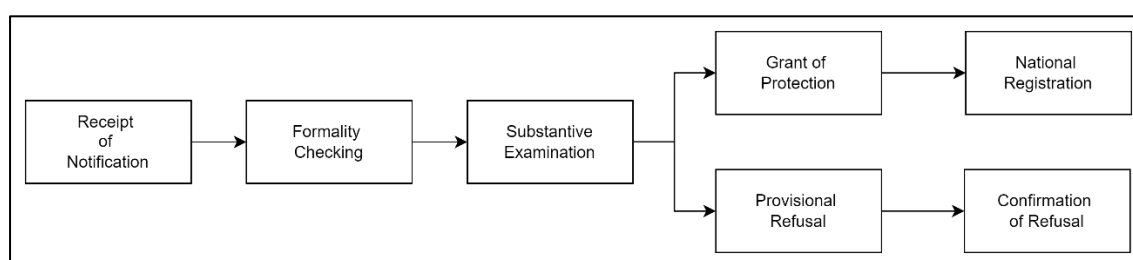
Under the Madrid System, trademark holders from Madrid Protocol member countries can request protection in Malaysia by designating Malaysia in their international application or subsequent designation.

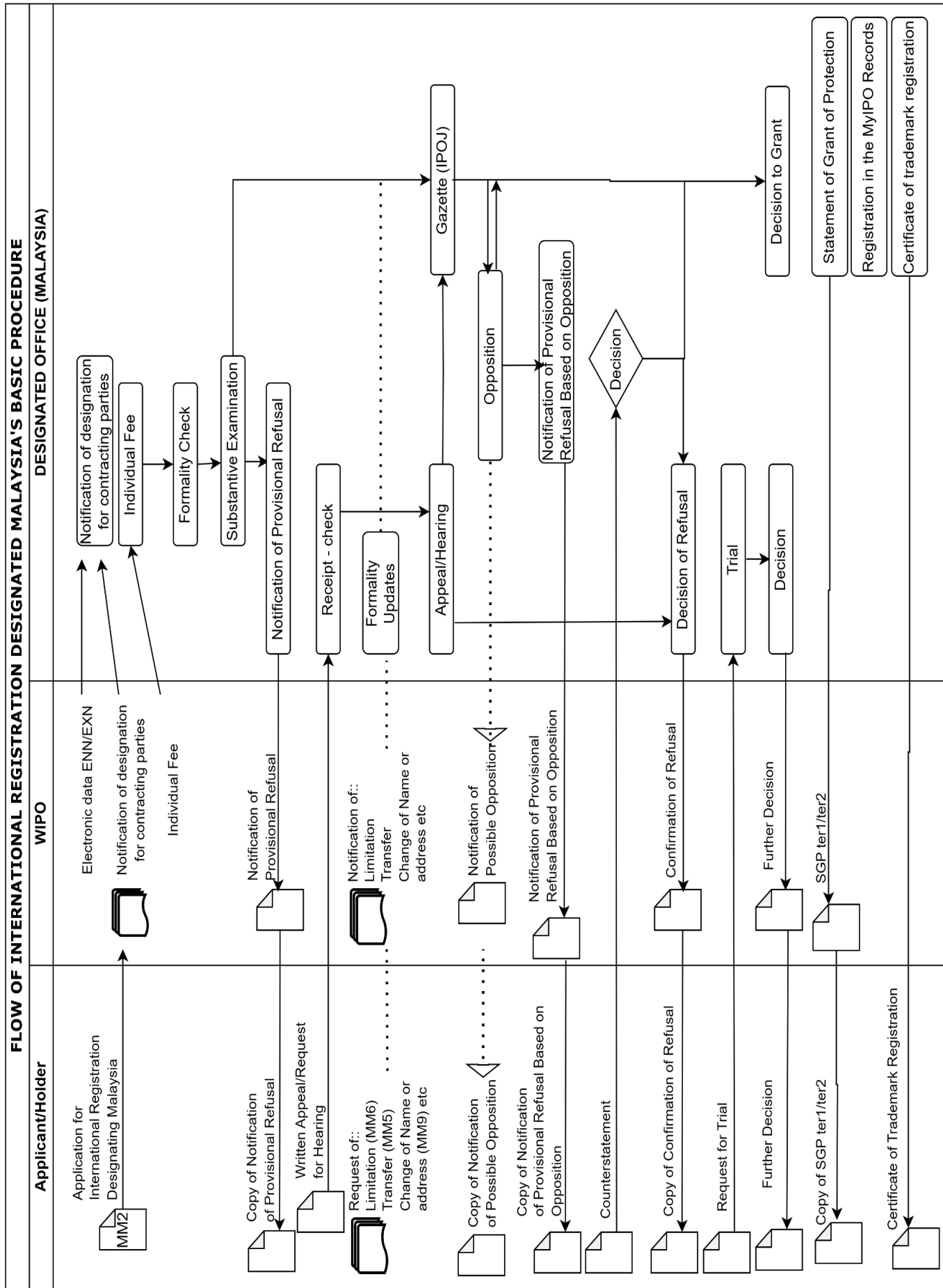
13.1 Role of the Office of a Designated Contracting Party (Malaysia)

When Malaysia is designated, the Intellectual Property Corporation of Malaysia (MyIPO), as the Office of the designated Contracting Party, is responsible for examining whether the mark can be protected under Malaysia trademark law.

This includes a substantive examination to ensure the mark meets national legal requirements. After examination, MyIPO will either:

- Grant protection to the mark,
- Issue a provisional refusal, or
- Partially refuse protection, depending on the examination findings.





13.2 Notification Process from the International Bureau (IB)

When Malaysia is designated, the IB of World Intellectual Property Organization (WIPO) sends weekly electronic notifications to MyIPO. The notification of this designation will be automatically integrated into the SPHI system for processing.

These notifications include details of:

- New international registrations that designate Malaysia;
- Any subsequent designations.

Upon receipt, MyIPO will:

- Record the mark in its system and assign a national trade mark number for examination and tracking purposes;
- Enter the mark information into the national trademarks register, where it is publicly accessible online.

Once MyIPO receives the international application and records it in its system, a formality check will be conducted to ensure compliance with the applicable national requirements.

13.3 Substantive Examination

International registrations and subsequent designations that designate Malaysia are examined in accordance with the procedures applied to national trademark applications filed directly with MyIPO.

These marks are examined for:

- Compliance with the Trade Marks Act 2019 and Trade Marks Regulations 2019, and
- Conflicts with earlier marks already recorded in the Malaysian Trade Marks Register.

Malaysia has the right to grant or refuse protection of a mark in its territory under the Madrid Protocol.

Granting of Protection in Malaysia

If the international registration or subsequent designation meets the substantive requirements under Malaysia trademark law, and no opposition is filed during the publication period, MyIPO will grant protection to the mark in Malaysia.

MyIPO must send a 'Statement of Grant of Protection Where No Notification of Provisional Refusal has Been Communicated [Rule 18ter(1)]' to the IB within the time limit from the date of notification (18 months). This confirms that the mark is protected in Malaysia and is recorded in the International Register.

Provisional Refusal of Protection in Malaysia

If the international registration or subsequent designation does not meet the substantive requirements of the Trademarks Act & Regulations 2019, MyIPO will issue a Provisional Refusal.

- This Provisional Refusal must be notified to the IB within 18 months from the date Malaysia was notified of the designation.
- Once sent, the IB will forward the Provisional Refusal to the holder of the international registration or to the holder's representative.

As a general principle, the Office is no longer entitled to refuse protection where no Provisional Refusal is issued within the applicable time limit.

Partial or Total Refusal

A Provisional Refusal may be issued for either:

- All goods and/or services listed in the international registration or subsequent designation, which results in a Total Refusal, or
- Only certain goods and/or services, which is known as a Partial Refusal.

The Madrid team at MyIPO will submit these notifications electronically via the Madrid Office Portal or in XML format. Notifications are submitted to the IB on a weekly basis.

13.4 Classification of Goods and Services

The classification and description of goods and services in an international application are reviewed by the IB before the application is recorded in the International Register. The IB serves as the final authority on the classification of goods and services listed in an international registration. Once the classification is accepted and recorded in the International Register, it becomes official.

It is important to understand that designated offices, including MyIPO, cannot formally object to the classification assigned by the IB. Therefore, MyIPO cannot issue a Provisional Refusal solely on the grounds of disagreement with the classification of goods and/or services.

Misclassification and Clarification

If MyIPO identifies any goods and/or services that appear to be misclassified, it may:

- Informally contact the IB.
- While waiting for a response or Correction Notice from the IB, MyIPO will temporarily suspend the examination of the application.

Important: The 18-month time limit to issue a Provisional Refusal continues to run during this period, regardless of whether a reply has been received from the IB.

Broad or Vague Terms

If MyIPO finds that any goods and/or services are described in broad or vague terms, it must issue a Provisional Refusal. In this case, MyIPO will:

- Request that the holder replace vague terms with clearer, more specific terms.
- These changes, once accepted, are reflected in the International Register only with respect to Malaysia.

Use of the Madrid Goods and Services (MGS) Tool in the Examination of Indications Goods and Services

The MGS tool, provided by WIPO, is used in the examination of indications of goods and services listed in international applications or subsequent designations under the Madrid Protocol designating Malaysia, unless the terms are selected from the pre-approved list of goods and services available in MyIPO's record system.

The MGS tool supports accurate and consistent assessment of terms, helping examiners identify whether a particular indication would be acceptable under **Malaysian classification standards**. It also helps reduce the number of provisional refusals due to vague or unacceptable terms.

The MGS tool is a multilingual, searchable database developed by WIPO that provides:

- Standardized and pre-approved indications of goods and services based on the Nice Classification;

- Translations of those terms in multiple languages;
- Information about the acceptability of specific terms in the offices of participating Contracting Parties, specifically Malaysia.

It is available online at: <https://www.wipo.int/mgs/>

Malaysia's Participation in MGS

Malaysia is among the Contracting Parties currently sharing information on goods and services acceptance with WIPO. This means:

- The MGS tool reflects official acceptability data provided by MyIPO.
- Examiners and applicants can verify whether a particular term would be accepted in Malaysia.
- It helps applicants avoid including problematic terms in international applications designating Malaysia.

“Check Acceptance by a Designated Contracting Party”

This function allows users to select Malaysia as the designated Contracting Party and check whether an indication of goods or services is acceptable for international registration purposes.

- Accepted by dCP: The term complies with Malaysian classification practice.
- Rejected by dCP: The term may result in a provisional refusal being issued.

Use the MGS to select and verify the appropriate terms before submission.

Step-by-Step Instructions

1. Access MGS

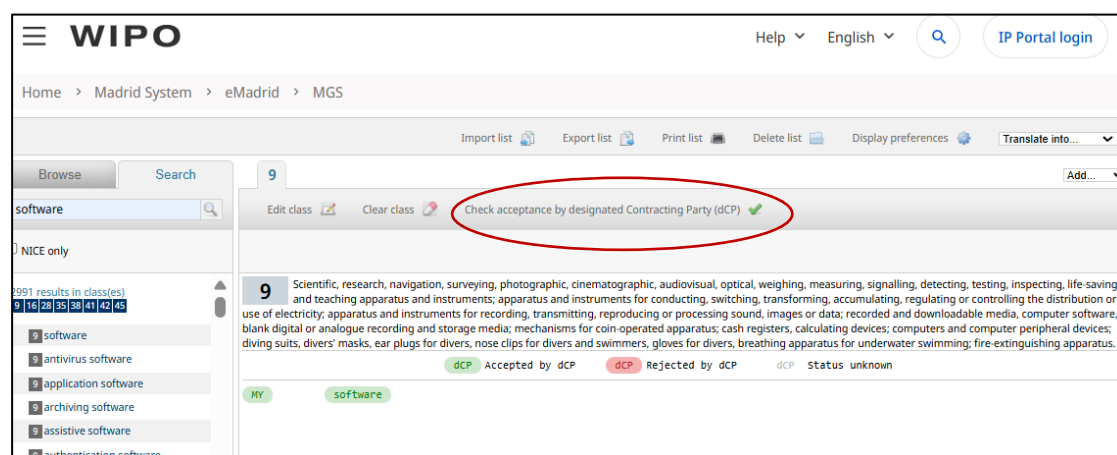
Visit <https://www.wipo.int/mgs/>

2. Search for the Indication

Enter the goods or services keyword in English (e.g., “software”, “cosmetics”).

3. Use “Check Acceptance by Designated Contracting Party”

- Select **Malaysia**.
- Review the term’s acceptance status.



13.5 Responding to a Provisional Refusal – Limitation of Goods and Services

To address a Provisional Refusal based on broad or unclear terms, the holder may:

1. The holder may submit WIPO Form MM6 to IB (with the prescribed fee) -*Request for the Recording of a Limitation* to the IB to limit the

scope of goods and/or services in the international registration specifically for Malaysia.

2. Alternatively, submit national Form TMB2 (with the prescribed fee) to MyIPO, through a registered Malaysian trademark agent, to propose a more specific or limited list of goods/services.

13.6 Acceptance of International Registration / Subsequent Designation Designating Malaysia

If an international registration or subsequent designation designating Malaysia passes substantive examination without any objections, or if any objections raised are later resolved, the mark will be published for opposition in the Intellectual Property Online Journal (IPOJ). At this stage:

- ✓ The notification of acceptance will also be sent to the appointed Malaysian agent, if one has been designated by the holder of the international registration.
- ✓ MyIPO will send a Notification of Possible Opposition -Form 2 to the IB. This notification confirms that the mark is being published, and specifies that a refusal of protection resulting from an opposition may be notified to the IB after the 18-month period, in line with Article 5(2)(c) of the Madrid Protocol.

Note: MyIPO will begin sending Form 1 notifications starting from month 15 after the IB's notification of designation.

13.7 Publication of International Registration

Marks under the Madrid Protocol are listed in a dedicated section of the Intellectual Property Online Journal (IPOJ) titled:

“List of acceptance of International Registration Designating Malaysia”

Once published, the mark is subject to a two-month opposition period, during which third parties may file an opposition. This period may be extended for an additional two months upon request.

This procedure follows the same publication process as national applications in Malaysia.

13.8 Opposition to International Registration in Malaysia

Once an international registration designating Malaysia has been published, it becomes open to challenge by third parties through a formal opposition process. This process allows any party who believes the registration of the mark may conflict with their existing rights to contest its protection in Malaysia.

Third parties who believe that the registration of the mark may affect their rights may file a notice of opposition within the two-month opposition period starting from the date of publication. This period may be extended once, for an additional two months, upon formal request and approval by MyIPO.

The opposition must be filed using Form TMD1 (with the prescribed fee) and ground for opposition, in accordance with the Malaysian Trade Marks Regulations, and must be submitted through a registered Malaysian trademark agent.

For further details on opposition procedures, please refer to **Chapter 9** of the Opposition Section in this manual.

13.9 Final Status of the International Registration

Once all procedures concerning the protection of the mark before MyIPO have been completed, and the mark is considered protected in Malaysia, MyIPO is required to send a final statement to the IB confirming the final status of the mark.

MyIPO does not issue a national registration certificate for international registrations protected in Malaysia to the holder via the IB. Instead, one of the following official statements is sent to the IB to indicate the conclusion of proceedings:

Final Decision	Description
Statement of Grant of Protection (Rule 18ter(1))	Issued when no provisional refusal was made and protection is granted.
Statement of Grant of Protection Following a Provisional Refusal (Rule 18ter(2))	Issued when objections were raised but later resolved in favour of the holder. There is no fixed time limit under the Madrid Protocol for issuing this final decision.
Confirmation of Total Provisional Refusal (Rule 18ter(3))	Issued when protection is totally refused after examination and/or opposition. There is no fixed time limit under the Madrid Protocol for issuing this final decision.

Although a national registration certificate is not automatically issued, the holder may request one. To obtain this, the holder must file Form TMJ4 (with the prescribed fee) through a registered Malaysian trademark agent.

13.10 Correction to International Registrations By WIPO

Under Rule 28 of the Common Regulations, the IB can correct mistakes in the International Register. These corrections may be made by the IB on its own initiative or upon request from the holder or a national Office. The IB generally makes corrections for the following types of errors:

- Mistakes Made by the IB

If the IB makes an error, it will correct it promptly. There are no time limits for requesting or making such corrections.

- Obvious Errors:

If an error is clear and the correct information is obvious, the IB will correct it as soon as it is noticed.

Example:

The list of goods in an international application includes:

Class 29: acai in powdered form; agar-agar for food; poultry soups; prepared stock.

The record appears in the Madrid Monitor as: list of goods appears as:

Class 29: acai in powdered form; agar-agar for food; prepared stock.

There is no time limit for requesting such corrections.

- Incorrect Facts:

If the recorded information is factually incorrect, such as typographical errors, spelling mistakes in names or addresses, or mistakes in dates or numbers, the IB may update the information. There are no time limits for requesting corrections of this type.

Errors Attributed to MyIPO.

If MyIPO made the error, the correction may affect the rights deriving from the international registration. In such cases, the request for correction must be submitted to the IB within nine (9) months from the date the incorrect information was published in the International Register.

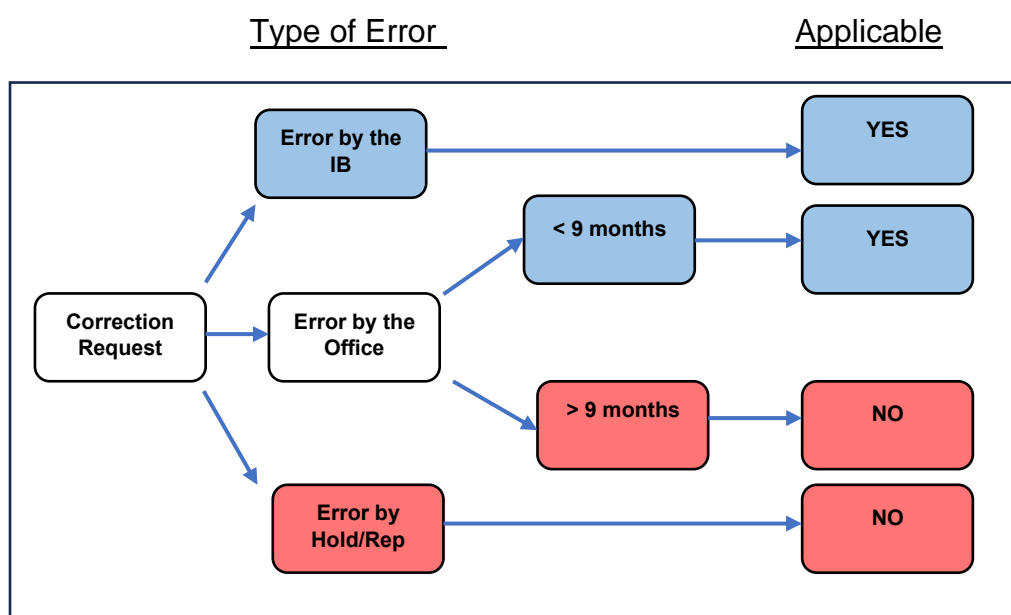
Example:

- Discrepancies between documents received by the IB and those filed with MyIPO, such as incorrect applicant/holder name.
- Errors in the list of designated countries or regions.
- Mistakes in the list of goods and services for which protection is sought.

Errors Attributed to the Holder or Representative.

The IB will not correct errors made by the holder or their representative, apart from minor errors or spelling mistakes that do not affect the rights derived from the international registration. If there is an error that impacts the rights, the holder will need to file a new international application.

Correction Request Summary



Requests for Correction and Review by the IB

A request to correct an entry in the International Register may be submitted by either the holder or an Office. However, if the error arises from a discrepancy between the documents submitted to the IB and the information recorded in a national or regional register, the Office of origin is responsible for submitting the correction request.

There is no fee for requesting a correction. The official WIPO Form MM21 may be used for this purpose. A correction request may also be submitted via WIPO's Contact Madrid service.

The International Bureau examines correction requests carefully. If an entry is corrected in the International Register, the International Bureau notifies the holder and the Offices of the designated Contracting Parties concerned.

Handling of Correction under the Madrid System by MyIPO

When MyIPO receives a notification of correction from the IB prior to the substantive examination stage, it will update the relevant trade mark records accordingly.

If the correction involves a change to the representation of the mark or otherwise affects the scope of protection after the substantive examination stage, MyIPO will conduct a new substantive examination based on that correction. In such cases, the 18-month time limit for examination may restart from the date the correction is received.

- Where the correction is accepted after the incorrect international registration or subsequent designation has already been published for opposition, MyIPO may publish an update in the *List of Acceptance of International Registration Designating Malaysia Based on Correction* section of Intellectual Property Online Journal (IPOJ).
- If the correction raises new grounds for refusal, MyIPO will issue a Provisional Refusal Based on Correction to the IB.
- MyIPO will send a Statement of Grant of Protection (*Rule 18ter(1),(2)*) or Confirmation of Total Provisional Refusal (*Rule 18ter(3)*) to the IB, confirming the final status of the corrected mark in Malaysia once all relevant procedures have been completed.
- The correction will be reflected in MyIPO's records only after all required procedures have been completed and MyIPO confirms that protection has been granted in Malaysia.

Where a notification of correction is received after the publication or protection of the international registration or subsequent designation, and the correction does not materially affect the scope of protection, the relevant trade mark records shall be updated accordingly. The correction

will also be published in the Errata section of the Intellectual Property Online Journal (IPOJ) for reference.

Types of Corrections Handled by MyIPO

MyIPO may act on corrections that involve updates to the following details of an international registration:

- Dates linked to the International Registration or Subsequent Designation, including notification dates.
- The holder's name and/or address.
- The design or visual representation / verbal elements of the mark.
- The classification or type of mark.
- The list of goods and services.
- Priority claim details.
- Additional information such as transliteration, translation, disclaimers, colour claims, mark descriptions, 3D elements or verbal/denomination elements, ceasing of effect.

However, not all corrections from the IB require action from MyIPO. For example, changes that involve designations of other countries or limitations that do not affect Malaysia may not need to be processed.

An international registration can receive more than one correction notice. In some cases, the IB may issue a follow-up correction to clarify or adjust an earlier one. The full correction history, along with the complete registration record, can be accessed online through WIPO's databases, Madrid Monitor.

13.11 Cancellation of an International Registration

Upon receiving notification from the IB that an international registration has been:

- **totally cancelled**, that is, all goods and/or services have been cancelled, or
- **partially cancelled**, that is, only part of the goods and/or services have been cancelled following a request from the Office of Origin,

MyIPO will hold the notification for three months. This period allows the holder to request transformation, under Article 9quinquies of the Madrid Protocol and Regulations 104–106 of the Malaysia Trade Marks Regulations 2019.

Note: Transformation is not permitted if the cancellation was requested voluntarily by the holder, in accordance with Rule 25 of the Common Regulations.

Processing Cancellation Updates

When MyIPO receives a notification of cancellation from the IB, the following actions will be taken:

- **Partial cancellations:** Only the affected goods and/or services listed in the IB's notification will be removed from the international registration record maintained by MyIPO.
- **Total cancellations:** MyIPO will update the status of the international registration as follows:
 - If the mark is still pending, the status will be set to **“Withdrawn.”**
 - If the mark has already been protected, the status will be updated to **“Cancelled.”**

13.12 Transformation

If, within five years of an international registration, the national application or registration it is based on is refused or cancelled, the Office of Origin must ask for the international registration to be cancelled. After receiving this request, the IB will notify all designated Contracting Parties involved of the cancellation.

When an international registration designating Malaysia is cancelled, partially or fully, at the request of the Office of Origin, the holder can keep protection in Malaysia by converting the cancelled part into a national trademark application. This is called transformation and must be done within three months from the date of the recording of the cancellation of the international registration in the International Register.

To transform the cancelled registration into a national application, the following conditions apply:

- (a) The transformation request must be made within three months of the cancellation.
- (b) The new national application must be for the same mark and cover the same goods/services as the cancelled registration (it can't be broader).
- (c) All national requirements - refer to Regulations. 104 to 106 of the Trademarks Regulations 2019.

The national application will keep the original filing date of the international registration or later designation, and any priority rights from the international registration will still apply.

To initiate a transformation under the Madrid System, the holder must submit Form MP4 (with the prescribed fee) directly to MyIPO.

If the transformation is accepted, a new national trademark number will be assigned, and the national register will show it as an "IRD Transformation Child". It will also indicate that the new national trademark came from a cancelled international registration or subsequent designation. This information will also be published in the MyIPO IPOJ.

However, holders should keep in mind the following:

- If MyIPO has already carried out some steps in the substantive examination of the international registration before it was cancelled, the results of those steps can be carried over to the new national application resulting from transformation. The remaining steps in the examination process can then continue as usual, and
- If the international registration had already been granted protection in Malaysia, and all the requirements for a transformation application are fulfilled, then the trademark should be registered in the national register.

13.13 Replacement of National Registration by an International Registration

As provided under the Madrid System, it is possible to replace a national trademark registration with an international registration, provided specific conditions are satisfied. For replacement to occur, the following criteria must be met:

- (a) The international and national registrations must be for the same trademark.
- (b) Both registrations must be owned by the same person.
- (c) The goods/services listed in the national registration must also be covered in the international registration.
- (d) The international registration must have been granted protection in Malaysia after the national registration date.

If the holder of an international registration designating Malaysia already has one or more national trademark registrations in Malaysia, those can be replaced by the international registration, as long as the above conditions are met.

It's important to note that while the goods/services in the national registration must be included in the international registration, they don't have to be identical in every detail, just similar is needed.

Taking Note of Replacement

Once all the conditions are met, the replacement happens automatically, and no formal action is required from the holder. However, to officially record the replacement and make it visible to the public, the holder should submit a formal request to MyIPO. This helps ensure transparency and clarity.

To have the replacement officially noted in the national trademark register, the holder should file **Form MP5 - Application to record replacement of registered trademark with national registration** (with the prescribed fee). Once recorded, the national register will be updated to show:

- The replaced national registration number
- The relevant class number(s)
- The protection date
- The goods/services that have been replaced
- Any priority claims

Notification to the IB

After MyIPO records the replacement in its register, it will notify the IB. The IB will then update the International Register with this information and inform the holder. The update will also be published in the WIPO Gazette.

Citation of a Replaced National Application or Registration

When a national trademark registration is replaced by an international registration, any citation based on the original national registration will still apply. This is because the international registration, which replaces the national registration, keeps the same filing and priority dates. As a result, the international registration continues to support any citations against later trademark applications, with the same legal effect as the original national registration.

13.14 Change of Holder's Name and/or Address

To update the holder's name or address in the International Register, the holder must submit a request using Form MM9(E) (with the prescribed fee), as required by the IB. Holders can submit the request for replacement directly to the IB. MyIPO does not accept or transmit Form MM9(E) on behalf of the applicant.

Once the request is processed, the IB will:

- Update the International Register with the new details.
- Notify all designated Contracting Parties about the change.
- Inform the holder directly.
- Notify the Office that submitted the request, if it wasn't submitted directly by the holder.

After receiving the IB's notification, MyIPO will update the holder's name and/or address in the MyIPO register as well.

13.15 Transfer of Ownership

To register a transfer of ownership for an international registration, the request must be made using Form MM5(E) (with the prescribed fee), issued by the IB.

The request can be submitted directly by the current holder of the registration to the IB. However, MyIPO does not accept or forward Form MM5(E) on behalf of the applicant. The transfer can cover:

- All goods and/or services listed in the international registration, or just some of them.
- All designated Contracting Parties or only specific ones.

This means the transfer can be full or partial, both in terms of the goods/services and the countries covered.

13.16 Renewal of an International Registration

An international registration is valid for 10 years from its registration date. It can be renewed for additional 10 year periods by paying the required renewal fees.

The renewal process is handled directly between the holder and the IB. About six months before the renewal is due, the IB sends an informal reminder to the holder and their representative (if appointed) to notify them of the upcoming expiry.

International registrations can be renewed online through WIPO's electronic services.

Once the renewal is processed, the IB will:

- Record the new 10 year term in the International Register, keeping the original expiry date.
- Notify the relevant designated Contracting Parties.
- Issue a renewal certificate to the holder.
- Publish the renewal details in the WIPO Gazette.

For designated Offices, specifically MyIPO, no further action is needed beyond updating internal records to show the extended protection period.

13.17 Changes That Cannot Be Made in the International Register

Once an international registration is recorded in the International Register, certain changes cannot be made. These include:

- (a) Changes to the trademark itself, even if they are small or cosmetic. If the holder wants to protect a different version of the trademark, they must submit a new international application.
- (b) Expanding the list of goods and/or services beyond what is already included in the international registration. If the holder wants broader protection, they need to file a new application to include the additional goods or services.

These rules are in place to maintain the integrity and consistency of the information in the International Register.

13.18 Essential Tips for International Registrations Designating Malaysia

The table below outlines key practices and recommendations when dealing with international trademark registrations that designate Malaysia:

No.	Request	Recommended Action / Practice
1	Amending goods and/or services due to a Provisional Refusal from MYIPO	Submit the change directly to MYIPO using Form TMB2 (MyIPO form). MyIPO will update the request accordingly. OR Submit the change directly to IB MM6 (IB Official form). The IB will update the International Register and notify all relevant countries, including Malaysia.

2	Amendments to goods/services not related to a Provisional Refusal	Don't file an amendment form with MYIPO. Submit the change directly to the IB using the correct official form. The IB will update the International Register and notify all relevant countries, including Malaysia.
3	Change in holder's name and/or address	Don't file National Form TMB4. Submit the change to the IB using Form MM9(E) (IB Official form). The IB will update the record and notify all designated Contracting Parties. MYIPO will update its records accordingly.
4	Change of ownership	Don't file National Form TMH1 to MyIPO. The transfer of ownership must be done through the IB using Form MM5(E) (IB Official form). The IB will manage the update and notify all relevant parties.
5	Renewal of the international registration	Don't submit National Form TME1 to MYIPO. Renewals must be done through the IB using Form MM11(E). The IB will process the renewal and notify all designated countries, including MYIPO.
6	Changes to particulars (e.g., color claim, 3D mark claim)	Any changes to details of the international registration (like adding/removing a color or 3D mark claim) must be submitted to the IB. If an error is found, the IB will correct it and inform all relevant parties.
7	Issuance of registration certificates	MYIPO does not issue registration certificates for international trademarks designating Malaysia. Protection is considered granted within 18 months from notification. A Statement of Grant of Protection is typically issued as official confirmation.

8	Licenses	Malaysia has made a formal declaration under Rule 20bis(6)(b) that any license recorded in WIPO's International Register has no legal effect in Malaysia. Therefore, to ensure that a license affecting an international registration designating Malaysia is effective within Malaysia, the license must be recorded directly with MyIPO using Form TMH2 (National form).
9	Email addresses	From November 1, 2025, ALL holders AND representatives MUST HAVE on-record email addresses – for each international trademark registration they own or manage – to request changes
