

CHAPTER 14

INTERNATIONAL APPLICATIONS WHERE MALAYSIA IS THE OFFICE OF ORIGIN

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CHAPTER 14

INTERNATIONAL APPLICATIONS WHERE MALAYSIA IS THE OFFICE OF ORIGIN

14.1 ROLE OF THE OFFICE OF ORIGIN

An international application must be submitted to the International Bureau through the national trade mark office of a Madrid Protocol member state where local protection of the trade mark has been sought. This office is known as the Office of Origin (MyIPO) for the international application. The Office of Origin (MyIPO) must –

- a. Receive, examine and certify the international applications and transmit those applications to the International Bureau.
- b. Remedy certain irregularities in the international applications.
- c. Monitor the basic mark and notify the International Bureau of any ceasing of effect.

14.2 FILING AN INTERNATIONAL APPLICATION USING THE MADRID SYSTEM

Under the Madrid System, the applicant must meet the following requirements:

- a. Have a connection with a member through nationality, domicile or has a real and effective industrial or commercial establishment.
- b. Have a “basic mark”, either an application or registration.
- c. Submit an international application form (MM2) and form TMMP1 accompanied by the payment of the prescribed fee through the Office of Origin (Malaysia - MyIPO). The MM2 form must be typed and in English.

Entitlement to file for international application - Regulation 61 of Trademarks Regulations 2019.

14.3 CERTIFICATION BY THE OFFICE OF ORIGIN

The international application shall be filed with International Bureau through the Office of Origin (MyIPO). The International Bureau will not accept any international application directly from applicant or their representative. This is because the Office of Origin (MyIPO) must certify —

- a. The filing date of the international application.

When signing the international application, the Office must certify the date on which it was received. This date will become the date of the international registration, provided the certified application is forwarded to the International Bureau within two (2) months of the date it was received by the Office of Origin (MyIPO). If the application reaches the International Bureau more than two months after that date, it will bear the date on which it was actually received by WIPO.

- b. The details on the international application correspond to the particulars of the basic mark.
- c. Mandatory information in the MM2 —
 - Use the official MM2 form prescribed by the International Bureau
 - Indicate the name, address and email address of the applicant
 - Claim entitlement with the Madrid Member
 - Provide basic mark number and date
 - Reproduce the mark
 - Transliteration and translation of the mark if it is in non-Latin characters
 - Indicate the type of mark (which must be the same as the basic mark)

- an indication that the mark consists of a colour or combination of colours as such.
 - an indication that the mark is a three-dimensional mark, a sound mark or a collective or certification mark.
 - the description of the mark by words (if applicable)
- List goods and services are properly classified, must be same or within the scope of the basic mark
 - Designate at least one Contracting Party (except for Malaysia)
 - Where the United States of America is designated, it is compulsory for the applicant to lodge the form MM18 for the declaration of intention to use the mark
 - Where the European Union (EU) is designated, the applicant must indicate a second working language before the Office of the European Union. The four official languages are French, German, Italian and Spanish. This second language will be used for any opposition or cancellation proceedings initiated by third parties before the Office of the European Union. If the applicant wishes to claim seniority, they must attach form MM17 for each Member State for which seniority is claimed.
 - Pay fees to WIPO

If the international application does not fulfil the requirements, the Office shall not submit the application to the International Bureau. The Office shall issue a written notice to the applicant for corrections or amendments. If the applicant failed to make any correction or amendment to the international application, or fail to make payment of the handling fee, the international application shall be deemed withdrawn.

14.4 FEES

The fees to be paid:

- a. Handling fee is payable to the Office of Origin (MyIPO) (Reg. 61(6) of TMR 2019)
- b. International application fees are payable to the WIPO in Swiss francs (CHF) via
 - Debiting the required amount from a Current Account at WIPO; or
 - Bank transfer to the WIPO bank account

The fees payable to the WIPO for filing an international application depend on the number of designated Contracting Parties, their applicable fees and the number of classes of goods and services for which the applicant seeks to protect the mark. International application fees comprise of:

- a. Basic fee
 - 653 Swiss francs if the representation of the mark is in black and white; or
 - 903 Swiss francs if the representation of the mark is in colour.

It does not matter whether the applicant intends to limit the mark to colour or claim colour as a trademark, the higher fee is payable as long as the mark is in colour.
- b. Fees for designated Contracting Parties:
 - Standard fees, which the designated country does not charge an individual fee (complementary fee of 100CHF for each member and supplementary fee of 100CHF for each class of goods and services beyond three classes); or
 - Individual fees, which are opted/declared by each member

The Madrid fee calculator is available to help the applicant estimate the international application fees.

<https://madrid.wipo.int/feecalapp/>

14.5 THE INTERNATIONAL TRADEMARK REGISTRATION PROCESS BY THE INTERNATIONAL BUREAU

International Bureau will conduct the formalities examination only, such as—

- a. The information set out in the MM2 form
- b. Classification of goods and services where the decision of the International Bureau shall be final (Nice Classification)
- c. Classification of figurative elements (Vienna Classification)
- d. Fees

If the application does not comply with the formal requirements, the International Bureau will send the applicant or representative and the Office of Origin (MyIPO) an 'irregularity notice' explaining how to correct the issue within a given time limit (typically three months). Failure to remedy the irregularity may result in the application being considered abandoned.

Irregularities to be remedied by the Office of Origin (MyIPO):

- a. Rule 12 – Irregularities with respect to Classification of Goods and Services
- b. Rule 13 – Irregularities with respect to Indication of Goods and Services
- c. Rule 11(4) – Other irregularities. Example: official form not used, applicant's entitlement and identity, and designation.

Example : Irregularity notice by the International Bureau

<div data-bbox="309 247 349 285" data-label="Image"></div> <div data-bbox="647 245 828 373" data-label="Image"></div> <p data-bbox="683 414 949 544">Intellectual Property Corporation of Malaysia (MyIPO) Unit 1-7, Ground Floor Tower B, Menara UOA Bangsar No. 5, Jalan Bangsar Utama 1 59000 Kuala Lumpur Malaysia</p> <p data-bbox="647 628 866 644">Geneva, 20 January 2023</p> <p data-bbox="488 694 922 710">NOTICE CONCERNING AN INTERNATIONAL APPLICATION</p> <p data-bbox="322 726 421 742">ATTENTION:</p> <p data-bbox="322 758 965 809">The irregularity(ies) indicated in this notice is/are to be remedied by the office of origin. However, the irregularity concerning the fees may be remedied by either the applicant or the Office of origin.</p> <div data-bbox="322 855 952 920" style="border: 1px solid black; padding: 5px;"> <p>The response to this notice should be received by the International Bureau no later than 20 April 2023. Please indicate the WIPO Reference number in all your communications with the International Bureau.</p> </div> <p data-bbox="322 951 692 1018">Re.: International application based on application N° TM2 for the mark in the name</p> <p data-bbox="322 1034 801 1083">Date of receipt of the international application by the Office of origin: 1 November 2022 by the International Bureau: 12 December 2022</p> <p data-bbox="322 1099 698 1197">Our ref.: 1 Office ref.: Applicant ref.: Examiner: Ganna CHABAN Telephone N°: +41 22 338 8686 Contact: www.wipo.int/madrid/en/contact/</p> <p data-bbox="495 1228 790 1241">*****</p> <div data-bbox="495 1326 887 1370"> <p>WORLD INTELLECTUAL PROPERTY ORGANIZATION</p> <p>34, chemin des Colombettes 1211 Geneva 20, Switzerland www.wipo.int</p> </div>	<p data-bbox="1890 247 1984 263">Page : 2</p> <p data-bbox="1243 331 1850 363">We acknowledge receipt of the above-mentioned international application.</p> <p data-bbox="1243 379 1785 411">The examination of this application has revealed the irregularities which are listed hereafter:</p> <p data-bbox="1243 427 1805 459">IRREGULARITY (IES) CONCERNING THE FEES: TO BE REMEDIED BY THE APPLICANT OR THE OFFICE OF ORIGIN</p> <p data-bbox="1243 475 1832 526">1. The amount of the fees received is less than the amount required (Rule 9(3)). Missing amount: (see accounting statement enclosed).</p> <p data-bbox="1243 542 1888 574">In order to remedy this irregularity, the missing amount should be paid to the International Bureau:</p> <ul data-bbox="1243 590 1872 772" style="list-style-type: none"> - either online, by credit card or by debiting a sufficiently credited current account opened with WIPO, at https://webaccess.wipo.int/epayment/ using reference 1660631001 ; - or by transfer to WIPO's bank account: IBAN No. CH51 0483 5048 7080 8100 0, SWIFT code CRESCH 2280A, Crédit Suisse, CH-1211 Geneva 70; - or by transfer to WIPO's postal account: IBAN No. CH03 0900 0000 1200 5000 8, SWIFT/BIC: POFICHBE; - or by authorizing the International Bureau to debit the required amount from a sufficiently credited account opened with WIPO. <p data-bbox="1243 804 1881 920">The correction of the above-mentioned irregularity(ies) should be received by the International Bureau within a three-month time limit from the date of this notification (expiring on 20 April 2023), failing which the international application will be considered abandoned. In that case, any fees paid in respect of the application will be reimbursed, after deduction of an amount corresponding to one-half of the basic fee.</p> <p data-bbox="1243 936 1832 987">For any further information on this notice, please feel free to contact us using Contact Madrid (http://www.wipo.int/madrid/en/contact/).</p> <p data-bbox="1243 1003 1881 1051">2. The International Bureau considers that the following terms of the list of goods and/or services are linguistically incorrect (Rule 13):</p> <p data-bbox="1243 1067 1812 1083">"natural sugar, replacement sugar, coffee and tea" (class 30)</p> <p data-bbox="1243 1115 1785 1131">The International Bureau suggests therefore the following:</p> <p data-bbox="1243 1147 1812 1163">"natural sugar; sugar substitutes; coffee and tea" (class 30)</p> <p data-bbox="1243 1179 1888 1345">A proposal as to different terms may be communicated to the International Bureau. Any such proposal must be communicated THROUGH THE OFFICE OF ORIGIN, within three months from the date of the present notification, that is by 20 April 2023. If no proposal acceptable to the International Bureau is made within this period, the International Bureau will include in the international registration the terms as appearing in the international application, with an indication to the effect that, in the opinion of the International Bureau, the specified terms are linguistically incorrect.</p>
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PERBADANAN HARTA INTELEK MALAYSIA
INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA
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MALAYSIA



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Faks (Fax) : +603 - 2299 8989
Laman Web (Web) : www.myipo.gov.my

Ong Hui Chuen,
No.51-1, Jalan USJ 10/1a,
Taipan Triangle,
47620 Subang Jaya, Selangor,
Malaysia.

Your ref :
Our ref :
WIPO ref :
Date :

Dear Sir/Madam,

NOTIFICATION OF IRREGULARITY IN AN INTERNATIONAL APPLICATION BASED ON THE NATIONAL APPLICATION NO. XXXXXXXXXX BY WIPO IN THE NAME OF XXXXXXXXXX

We refer to the above.

2. WIPO has issued an irregularity notice in respect of your International Application (attached). The dateline to respond is **20 April 2023**.

3. Insufficient fees

Reason:	It advises the International Application fees have not been received in full.
Potential actions:	The outstanding fees must be paid directly to WIPO. If you do not pay your fees by 20 April 2023 your application will be considered abandoned.



4. List of goods and/or services are linguistically incorrect.

Reason:	The International Bureau considers that the following terms of the list of goods and/or services are linguistically incorrect (Rule 13): 1) "natural sugar, replacement sugar, coffee and tea" (Class 30)
Potential actions:	The International Bureau suggests therefore the following: 1) "natural sugar; sugar substitutes; coffee and tea" (Class 30)

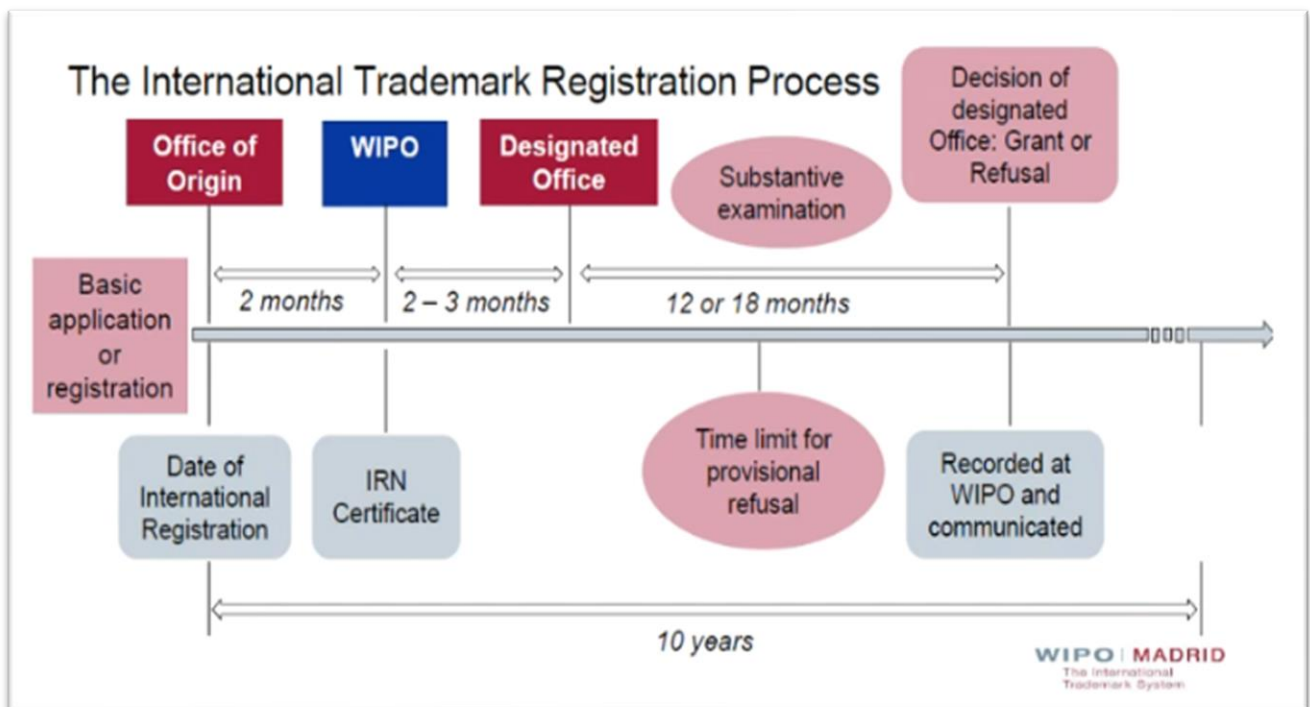
If or once it does comply, the International Bureau will—

- a. Register the mark in the International Register
- b. Publish the mark in the WIPO Gazette
- c. Inform the Office of Origin (MyIPO)
- d. Send a certificate to the applicant/representative
- e. Notify the Offices of the designated Contracting Parties. The scope of protection for the international trademark registration will be determined under the domestic laws of each designated member of the Madrid System.

Example: Notification to the designated Contracting Parties

Registrations	
Office of Origin: Malaysia	
NOTIFICATION ENN/2024/31	
<i>Reproduction of the mark</i>	
	
Registration number	1 812 484
Registration date	July 3, 2024
Date next payment due	July 3, 2034
Name and address of holder	Forest Gang Sdn. Bhd. No. 7, Jalan Ba 13, Kawasan Perusahaan Bukit Angkat, Sungai Chua Kajang, 43000 Selangor (Malaysia)
Legal nature of the holder (legal entity) and place of organization	Private Limited Company, Malaysia, Selangor
Classification of figurative elements	26.1; 26.13; 27.5
Indication relating to the nature or kind of mark	The words contained in the mark have no meaning.
List of goods and services NCL(12-2024)	18 Luggage; backpacks; travelling bags.
Basic registration	Malaysia, February 20, 2020, TM2020003292
Designations under the Madrid Protocol	Brunei Darussalam, China, Indonesia, Philippines, Singapore, Thailand, Viet Nam
Declaration of intention to use the mark	Brunei Darussalam, Singapore
Date of notification	October 3, 2024
Language of the international application	English

Summary International Trademark Registration Process.



14.6 SUBSEQUENT DESIGNATIONS

If the owner of an international registration wishes to extend protection of his trademark to other Contracting Parties, in addition to those already designated, he can subsequently designate more Contracting Parties in the same international registration. Subsequent designations may only be made after the international application has resulted in an international registration.

Subsequent designation is made using the official WIPO form MM4. Unlike international applications, subsequent designations do not need to be filed through the Office of Origin (MyIPO) but may be filed directly with WIPO. Similar to an application for international registration, the International Bureau will conduct formalities check on the subsequent designation filed.

14.7 MODIFICATION OF INTERNATIONAL REGISTRATIONS

During the lifetime of the International Registration, the holder may, at any time, request WIPO to record in the International Register a change of name or address or that of the representative, a voluntary restriction in the protection of the international registration (limitation, renunciation, cancellation), a change in ownership of the mark, or a licence, having effects in all or some of the designated contracting parties. To request the recording of any such modification, the holder must use the relevant official form, available at the WIPO website (refer part 14.9).

The central recording of such modifications in the International Register relieves the holder from the need to request such action from the Office of each designated contracting party, thus resulting in very significant savings.

14.8 DEPENDENCY AND CENTRAL ATTACK

For a period of five years from the date of the international registration, the protection resulting from the international registration remains dependent on the mark applied for or registered in the Office of Origin (MyIPO) (i.e. the basic mark).—The period of five years is known as the “dependency period”, and the consequence of it is the ceasing of the effect of the international registration, which may be partial or full. It is also commonly called “central attack”.

Office of Origin (MyIPO) needs to notify the International Bureau when —

- a. A basic trademark ceases to exist within this period; or
- b. The scope of the basic trademark is restricted during this period; or
- c. The basic trademark ceases to exist or is restricted as a result of an action which commenced within this period.

Office of Origin (MyIPO) must therefore monitor the basic trademark for any of the following changes —

- a. The basic trademark application is refused, withdrawn or treated as withdrawn.
- b. The scope of the basic trademark application or registration is restricted (i.e. some of the goods and/or services are deleted).
- c. The basic trademark registration is cancelled, revoked or invalidated.
- d. The basic trademark registration is not renewed

Once notified, the International Bureau cancels the international registration to the same extent and notifies all designated countries as well as the holder of the International Registration.

After the expiry of the dependency period, the international registration becomes independent of the basic application(s) or the basic registration(s). This means that any challenge or withdrawal of the basic application or basic registration will not affect the international registration. There is no separate

dependency period for subsequent designations. The only dependency period is the one which runs from the date of the international registration. For instance, the date of international registration is 1 February 2010, and the date of subsequent designation is 1 February 2012. The dependency period for both the international registration and subsequent designation is within five years from the date of the international registration.

The international registration may be maintained in force indefinitely by the payment, every 10 years, of the prescribed fees directly to the WIPO.

14.9 MADRID SYSTEM FORMS

Form	Description
MM2	Application for international registration governed by the Madrid Protocol
MM4	Designation subsequent to the international registration
MM5	Request for the Recording of a Change in Ownership
MM6	Request for the Recording of a Limitation of the List of Goods and Services
MM7	Request for the Recording of a Renunciation
MM8	Request for the Recording of a Cancellation of the International Registration
MM9	Request for the Recording of a Change in the Name or Address of the Holder or, where the Holder is a Legal Entity, for the
	Recording to Introduce or Change Indications Concerning its Legal Nature
MM10	Request for the Recording of a Change in Name and/or Address of the Representative
MM11	Renewal of the international registration
MM12	Appointment of a representative

MM13	Request for the Recording of a License
MM14	Request for Amendment of the Recording of a License
MM15	Request for Cancellation of the Recording of a License
MM16	Subsequent Designation resulting from Conversion (European Union)
MM17	Claim of Seniority (European Union)
MM18	Declaration of intention to use the mark (United States of America)
MM19	Request for the recording of a restriction of the holder's right of disposal
MM20	Request for continued processing
MM21	Request for the correction of a recording
MM22	Request for the division of an international registration
MM23	Request for the merger of international registrations resulting from the recording of a partial change in ownership
MM24	Request for the merger of international registrations resulting from the recording of a division

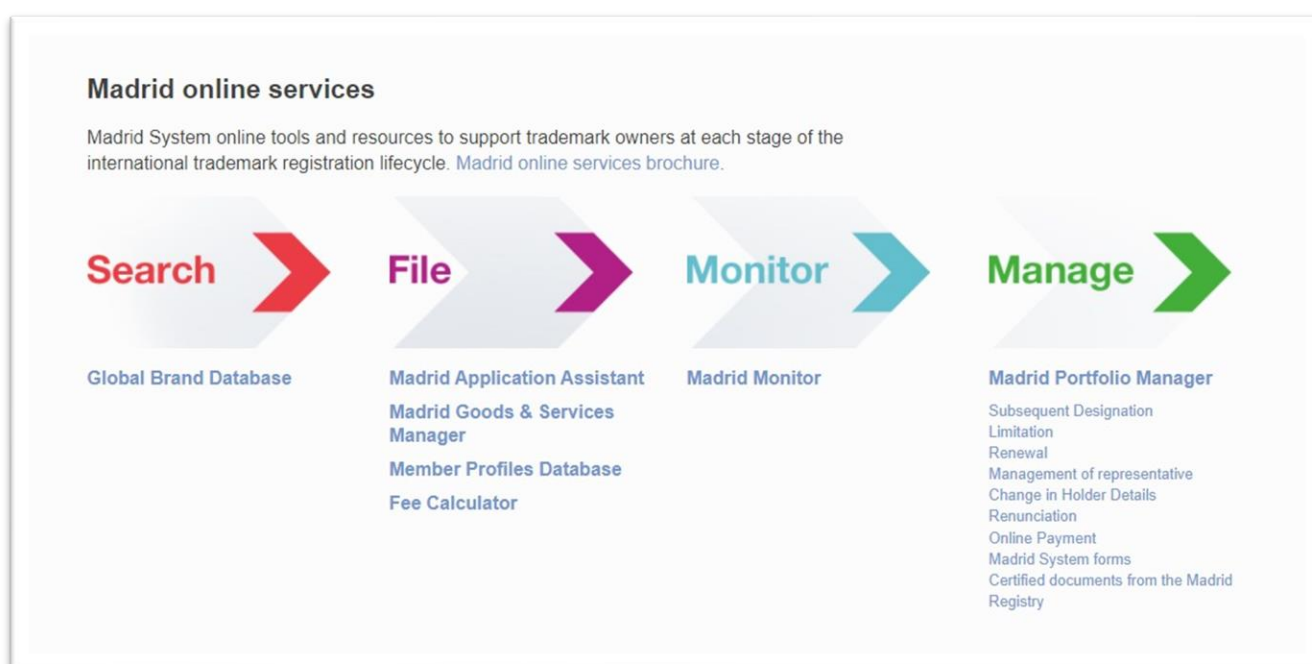
Notes for filing forms <https://www.wipo.int/en/web/madrid-system/forms/>

Remarks : a. All forms except MM2 must be filed directly with WIPO, not through the Office of Origin (MyIPO).

b. Forms MM17 and MM18 must be filed together with form MM2, if applicable.

14.10 MADRID SYSTEM ONLINE SERVICES

The Madrid System's online tools are available to help simplify the international registration process and provide support to all users of the Madrid System throughout each stage of the international registration lifecycle. The following tools, listed below, are available to the public at no charge.



Global Brand Database

Search the Global Brand Database before filing a trademark application, to uncover marks that may be considered similar or identical to the mark of interest and which may prevent protection in specific territories, or to simply browse brands in markets of interest.

<https://www.wipo.int/en/web/global-brand-database>

Madrid Application Assistant

The Madrid Application Assistant (MAA) is an electronic version of the official MM2 form that applicants may use to file an international application under the Madrid System.

<https://efiling.madrid.wipo.int/application-assistant/>

Madrid Goods and Services Manager

The Madrid Goods and Services (MGS) provides access to a database of goods and services. It assists trademark applicants in compiling the list of goods and services that must be submitted when filing an international application. The MGS provides terms from the alphabetical list of the *International Classification of Goods and Services for the Purposes of the Registration of Marks* (Nice Classification) as well as a much wider choice of terms that are pre-accepted by the International Bureau and many Offices that are members of the Madrid System.

<https://webaccess.wipo.int/mgs/>

Member Profiles Database

The Madrid Member Profiles database provides access to information concerning the laws and practices of the IP Offices of members. It helps trademark owners to understand the rules and procedures in effect in each of the markets of interest, including time limits to respond to a refusal or opposition, to request a review, or to file an appeal. It also assists trademark owners understand the procedures for filing an international application through the Office of origin.

<https://www.wipo.int/madrid/memberprofiles/selectmember>

Fee Calculator

The Fee Calculator helps to estimate the cost of registering a mark through the Madrid System, as well as other costs related to managing an international trademark, such as the renewal, the subsequent designation, the second part fee for certain members and all Madrid transactions with fees.

<https://madrid.wipo.int/feecalapp/>

Madrid Monitor

The status of all international registrations in force, including data relating to international applications and subsequent designations under examination by the International Bureau, is published by the International Bureau online on Madrid Monitor. This database contains the bibliographic data of all international registrations in force and the images of marks registered, which consist of or contain special characters or figurative elements. Data in the Madrid Monitor is updated daily.

<https://www3.wipo.int/madrid/monitor/en/>

Madrid Portfolio Manager

The Madrid Portfolio Manager (MPM) allows holders and their representatives to access their international trademark portfolios. Having a user account, allows holders to access the International Register online and view all transactions occurring on their international registrations, in real time. The service also offers the possibility for the holder to manage actions pertaining to the protection of their own international registration(s), such as changes in name and/or address of the holder, presentations of subsequent designation, renewals and payments of fees.

https://www.wipo.int/en/web/madrid-system/how_to/manage

INFORMATION ABOUT THE MADRID SYSTEM

The Official Portal of Intellectual Property Corporation of Malaysia

<https://www.myipo.gov.my/applying-for-a-trademark/>

WIPO Madrid Protocol Homepage

<https://www.wipo.int/en/web/madrid-system/>