

CHAPTER 8

APPEAL AND HEARING

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CHAPTER 8 TRADEMARK GUIDELINES 2025 – APPEAL

8.1 APPEAL (WRITTEN SUBMISSION)

8.1.1 WHO CAN APPLY

National

The applicant himself or by using an agent (must file TMR7) may file for written submission once they received the notice of provisional refusal.

IRDM Application

The applicant must appoint a local trademark agent by filling TMR7 for written submission once they received the notice of provisional refusal.

8.1.2 WRITTEN SUBMISSION FILES

Access and Confidentiality of Written Submission Documents

Written submission documents are considered private and confidential and can only be accessed by the parties involved in the written submission namely the applicant or the duly appointed agent.

Access by Third Parties and Agents

Third parties or agents who are not officially recorded as representing a party in the written submission shall not be granted access to written submission documents. Access will only be permitted if the agent has filed Form TMR7 and is officially acting on behalf of the applicant.

8.1.3 WRITTEN SUBMISSION PROCEDURE UNDER SECTION 29(5)(a)

Filing of Application of Written Submission

Within 2 months from the date of the objection letter, the applicant may file for a written submission by submitting related documents. Written appeal submission and EOT applications submitted after the two (2) months will not be processed/considered.

Grounds of Written Submission

Pursuant to the Trademarks Act 2019, a written submission may be filed to overcome objections raised on various statutory grounds. The applicant may rely on the following grounds in support of their application:

- Absolute grounds for refusal under Section 23 of the Act
- Relative grounds for refusal under Section 24 of the Act
- Disagreement with disclaimer
- Limitation of goods or services
- Other grounds under relevant Sections/Regulations

A detailed discussion on the absolute and relative grounds of written submission is provided in Chapter 5 and Chapter 7.

Due Date to Request for Written Submission

If there is no appeal or request for a written submission is filed within the stipulated time, the trademark application will automatically be deemed withdrawn. However, an extension of time may be granted for a maximum period of six (6) months.

8.1.4 EXTENSION OF TIME FOR WRITTEN SUBMISSION

Each stage of written submission proceedings is subject to the possibility of an extension of time. The applicant or their appointed agent may request an extension of time at any stage by submitting a formal request to the Registrar, accompanied by Form TMK1 and Form TMK3 together with the prescribed fee.

Maximum Extension Periods (Reg 17(2))

The applicant is eligible for a maximum extension period of six (6) months during the written submission process.

Registrar's Decision

The Registrar shall consider all the evidences, exhibits and any related documents provided by the applicant or their appointed agent and will subsequently communicate the decision in writing to the applicant or their appointed agent.

In this regard, the Registrar shall decide whether:

- a) to refuse the registration of the trademark;
- b) to register the trademark absolutely; or
- c) to register the trademark subject to conditions, amendments, modifications, disclaimers or limitations as deemed fit. (*Provisional Refusal - Appeal Raise Requirement*)

For IRDM application, once all process is completed, the national office will issue a final decision. This could be a statement of grant of protection, meaning protection is granted for all goods and services, or a confirmation of the total provisional refusal, meaning protection is denied.

Upon issuance of the Notification of Acceptance for IRDM, the notification will be forwarded to the appointed agent and published in the IP Journal. Following the expiration of the two-months opposition period, the final decision, i.e. a Statement of Grant of Protection pursuant to Rule 18ter (2), will be transmitted to International Bureau (IB) for entry into the International Register.

In cases where a Confirmation of Total Provisional Refusal under Rule 18ter (3) is issued, the decision will be communicated to both the agent and International Bureau (IB) for recording in the International Register.

Grounds of Decision

The applicant, upon receiving the total provisional refusal from the Registrar, may request for the grounds of total provisional refusal by filing TMC3 (National application) or TMC4 (IRDM application) with the prescribed fee within two (2) months from the date of notice of total provisional refusal. No extension of time is allowed during this process.

8.1.5 ADMISSIBILITY OF EVIDENCE

Mode of giving evidence [Reg. 58]

Evidence from Malaysia and Foreign Jurisdiction

The applicant must submit evidence in the form of a statutory declaration in accordance with the Statutory Declarations Act 1960.

For evidence originating from outside Malaysia, or if the witness is not within the jurisdiction at the time of making his declaration, it must be sworn before a notary public, commissioner for oaths, or any legally authorized officer in the respective jurisdiction. This includes courts, judges, justices of the peace, or any other officers empowered to administer oaths for legal proceedings.

Genuineness of Statutory Declarations

As provided under Reg. 58(2), the Registrar is not required to verify the genuineness of the signature or seal affixed to the statutory declaration. Once the declaration is duly attested, the declaration shall be accepted on its face.

Limitations on Evidence Submitted

The examination of evidence in written submission proceedings will be strictly limited to evidence that is submitted in accordance with the prescribed methods, such as through statutory declarations or other accepted modes of submission. This ensures that all evidence is provided in a legally recognized form. Any evidence provided without the statutory declaration will not be considered during the written submission process.

8.1.6 EVALUATION OF EVIDENCE

Burden of Proof

In written submission proceedings, the burden of proof falls on the applicant to establish that their mark is eligible for registration despite the objection raised under section 23 and 24 of the Act.

Evidence of Use in the Course of Trade

To substantiate the claim of use of the mark in the course of trade, the following evidence (non-exhaustive) may be submitted:

- **List of Goods with the Mark:** A detailed list of the goods or services on which the mark has been used. The list should specify the precise products or services that carry the mark and correspond with the goods specified in the application.
- **Sales Data:** Provide turnover or sales volume figures for each year, preferably over the last **FIVE YEARS**, demonstrating the scale of trade. If the mark has been in use for less than five years, please provide sales data for the available period. This will help show the commercial activity linked to the mark.
- **Advertising and Promotion:** Provide details of the expenditure on advertising and promotional activities related to the mark. This should include the amount spent each year, to illustrate the efforts made to publicize and establish the mark in the marketplace.
- **Exhibits Showing Actual Use:** Submit clear, dated examples of the mark's use on the goods or services, including product packaging, labels, tags, or point-of-sale materials. Additionally, provide advertisements, brochures, and any marketing materials where the mark is featured.

- **Geographical Use:** Indicate the locations, cities, or regions in Malaysia where the mark has been used, showing the geographic extent of the mark's presence in the local market. The area and extent of the use made of the mark should be carefully assessed. It should be remembered that the applicant is required to prove factual distinctiveness in Malaysia and not in some other country. Allegations that the mark's reputation has 'spilled over' into Malaysia may be considered.
- **Mark's History:** Provide a brief history detailing the adoption and use of the mark in Malaysia, including date of first use, and any relevant milestones that demonstrate its continuity in the marketplace.
- **Commercial Documents:** Submit copies of relevant commercial documents such as invoices, bills of lading, import/export documents, contracts, or purchase orders showing that the mark has been used in relation to actual transactions involving the goods or services.

8.1.7 APPEAL TO COURT

Right to Appeal

If either party is not satisfied with the Registrar's decision, they may appeal to the High Court within 1 month from the date of issuance of the written grounds of decision (Reg.33). An extension of time to appeal may be granted for a maximum period of 2 months.

The date on which the written grounds of decision is issued shall be deemed as the date of the Registrar's decision for the purpose of filing an appeal.

Notification and Compliance by the Registrar

Upon filing an appeal to the Court, the appellant must notify the Registrar by submitting Form TMG1 together with the prescribed fee. Upon receipt of such notification, the Registrar may update or amend the status of the trademark application as deemed appropriate.

Once the Court proceedings have concluded, a copy of the final order or judgment must be filed with the Registrar by submitting Form TMF6 along with the prescribed fee. The Registrar shall comply with and give full effect to the Court's order or judgment. Where appropriate, the outcome of the appeal may be published in the Intellectual Property Official Journal.

For IRDM application, the procedure aligns with that of the National Route. Following the issuance of a court order, MyIPO will communicate the decision to International Bureau (IB) as a further decision under Rule 18ter (4).

8.1.8 DEFERMENT OF WRITTEN SUBMISSION APPLICATION

[Reg 35]

Duration and Extension of Deferment

The applicant may request a deferment of written submission proceedings at any stage of written submission process by submitting a formal request to the Registrar, accompanied by Form TMP2 and the prescribed fee.

The Registrar may grant a maximum deferment period of six (6) months. If further deferment is required, a new request must be submitted for Registrar's consideration.

Deferment application can be applied at any time without the need to exhaust any eligible extension of time for that particular stage. For example, if a party has a remaining four (4) month extension of time, they may still apply for deferment.

Additionally, the deferment period requested does not have to be for the full six (6) months; parties may request deferment for a shorter duration as needed. If the parties wish to conclude the deferment earlier than the granted period, they may notify the Registrar in writing accordingly.

Circumstances for Granting Deferment of Written Submission Proceedings

The Registrar may grant deferment of written submission proceedings under the following circumstances:

- both applicant and the cited mark owner are parties to ongoing Court proceedings in Malaysia.
- any other reasonable circumstances as determined by the Registrar at their discretion such as ongoing settlement discussions, global settlement negotiations, or any other relevant factors.

Where deferment is requested due to settlement discussions, the requesting party must provide supporting documents, such as notice of demand in case of court proceedings or a draft settlement agreement. Any confidential or privileged information in the draft settlement agreement may be redacted before submission.

8.2: EX- PARTE HEARING

8.2.1 WHO CAN APPLY

National

The applicant himself or by using an agent (must file TMR7) may file for an ex-parte hearing application once they received the notice of provisional refusal.

IRDM Application

The applicant must appoint a local trademark agent by filling TMR7 for ex-parte hearing application once they received the notice of provisional refusal.

8.2.2 EX-PARTE HEARING FILES

Access and Confidentiality of Ex-Parte Hearing Documents

Ex-parte hearing documents are considered private and confidential and can only be accessed by the parties involved in the ex-parte hearing namely the applicant or the duly appointed agent.

Access by Third Parties and Agents

Third parties or agents who are not officially recorded as representing a party in the ex-parte hearing shall not be granted access to ex-parte hearing documents. Access will only be permitted if the agent has filed Form TMR7 and is officially acting on behalf of the applicant.

8.2.3 EX-PARTE HEARING PROCEDURE UNDER SECTION 29(5)(a)

Filing of Application of Ex-parte Hearing

Within 2 months from the date of the objection letter, the applicant may file for an ex-parte hearing by submitting Form TMC1, accompanied by the prescribed fee. For multiple class applications, the applicant shall pay for each class which has been objected.

Grounds of Ex-Parte Hearing

Pursuant to the Trademarks Act 2019, an ex-parte hearing application may be filed to overcome objections raised on various statutory grounds. The applicant may rely on the following grounds in support of their application:

- Absolute grounds for refusal under Section 23 of the Act;
- Relative grounds for refusal under Section 24 of the Act;
- Disagreement with disclaimer
- Limitation of goods or services
- Other grounds under relevant Sections/Regulations

A detailed discussion on the absolute and relative grounds of ex-parte hearing is provided in Chapter 5 and Chapter 7.

Due Date to Request for Ex-Parte Hearing

If there is no request for an ex-parte hearing is filed within 2 months from the date of notice of provisional refusal, the trademark application will automatically be deemed withdrawn. However, an extension of time may be granted for a maximum period of six (6) months.

Notice of Ex-Parte Hearing

Upon receiving a request of an ex-parte hearing, the Registrar will issue a hearing notification to the applicant or their appointed agent. The hearing notification will be sent at least one (1) month prior to the scheduled hearing date. The applicant or their appointed agent must comply with the date and time stipulated in the hearing notification. An extension of time may be granted for a maximum period of six (6) months from the date of the hearing.

Filing of Hearing Submissions

Upon receiving the hearing notification, the applicant or their appointed agent shall prepare and submit the ex-parte hearing submission accompanied by evidence of use in form of a Statutory Declaration.

Registrar's Decision

The Registrar shall consider all the evidence, exhibits and any hearing submissions provided by the applicant or their appointed agent and will subsequently communicate the decision in writing to the applicant or their appointed agent.

In this regard, the Registrar shall decide whether:

- a) to refuse the registration of the trademark;
- b) to register the trademark absolutely; or
- c) to register the trademark subject to conditions, amendments, modifications, disclaimers or limitations as deemed fit.

For IRDM application, once all proceedings (including any appeals) are completed, the national office will issue a final decision. This could be a statement of grant of protection, meaning protection is now granted for all goods and services, or a confirmation of total provisional refusal, meaning protection is denied.

Upon issuance of the Notification of Acceptance for IRDM, the notification will be forwarded to the appointed agent and published in the IP Journal. Following the expiration of the two-month opposition period, the final decision, i.e. a Statement of Grant of Protection pursuant to Rule 18ter (2), will be transmitted to International Bureau (IB) for entry into the International Register.

In cases where a Confirmation of Total Provisional Refusal under Rule 18ter(3) is issued, the decision will be communicated to both the agent and International Bureau (IB) for recording in the International Register.

Withdrawal of Ex-Parte Hearing / Application

At any stage of the ex-parte hearing proceeding prior to the issuance of decision by the Registrar, the applicant may withdraw the ex-parte hearing by filing Form TMP1 together with the prescribed fee.

Grounds of Decision

The applicant, upon receiving the total provisional refusal from the Registrar, may request for the grounds of total provisional refusal by filing TMC3 (National application) or TMC4 (IRDM application) with the prescribed fee within two (2) months from the date of notice of total provisional refusal. No extension of time is allowed during this process.

8.2.4 APPEAL TO COURT

Right to Appeal

If the applicant is not satisfied with the Registrar's decision, the applicant or their appointed agent may appeal to the High Court within one (1) month from the date of issuance of the written grounds of decision (Reg.33). An extension of time to appeal may be granted for a maximum period of two (2) months.

The date on which the written grounds of decision is issued shall be deemed as the date of the Registrar's decision for the purpose of filing an appeal.

Notification and Compliance by the Registrar

Upon filing an appeal to the Court, the appellant must notify the Registrar by submitting Form TMG1 together with the prescribed fee. Upon receipt of such notification, the Registrar may update or amend the status of the trademark application as deemed appropriate.

Once the Court proceedings have concluded, a copy of the final order or judgment must be filed with the Registrar by submitting Form TMF6 along with the prescribed fee. The Registrar shall comply with and give full effect to the Court's order or judgment. Where appropriate, the outcome of the appeal may be published in the Intellectual Property Official Journal.

For IRDM application, the procedure aligns with that of the National Route. Following the issuance of a court order, MyIPO will communicate the decision to International Bureau (IB) as a further decision under Rule 18ter(4).

8.2.5 ADMISSIBILITY OF EVIDENCE

A detailed discussion on the admissibility of evidence under the ex-parte hearing procedure is provided in Part 8.1.5.

8.2.6 EVALUATION OF EVIDENCE

A detailed discussion on the evaluation of evidence under the ex-parte hearing procedure is provided in Part 8.1.6.

8.2.7 DEFERMENT OF EX-PARTE HEARING

[Reg 35]

Duration and Extension of Deferment

The applicant may request a deferment of ex-parte hearing proceedings at any stage of ex-parte hearing process by submitting a formal request to the Registrar, accompanied by Form TMP2 and the prescribed fee.

The Registrar may grant a maximum deferment period of six (6) months. If further deferment is required, a new request must be submitted for Registrar's consideration.

Deferment application can be applied at any time without the need to exhaust any eligible extension of time for that particular stage. For example, if a party has a remaining four (4) month extension of time, they may still apply for deferment.

Additionally, the deferment period requested does not have to be for the full six (6) months; parties may request deferment for a shorter duration as needed. If the parties wish to conclude the deferment earlier than the granted period, they may notify the Registrar in writing accordingly.

Circumstances for Granting Deferment of Ex-parte Hearing Proceedings

The Registrar may grant deferment of ex-parte hearing proceedings under the following circumstances:

- both applicant and the cited mark owner are parties to ongoing Court proceedings in Malaysia.
- any other reasonable circumstances as determined by the Registrar at their discretion such as ongoing settlement discussions, global settlement negotiations, or any other relevant factors.

Where deferment is requested due to settlement discussions, the requesting party must provide supporting documents, such as originating summon in case of court proceedings or a draft settlement agreement. Any confidential or privileged information in the draft settlement agreement may be redacted before submission.

8.2.8 EXTENSION OF TIME FOR EX-PARTE HEARING

Each stage of ex-parte hearing proceedings is subject to the possibility of an extension of time (EOT). The applicant or their appointed agent may request an extension of time by submitting a formal request to the Registrar, accompanied by Form TMK1 and Form TMK3 together with the prescribed fee.

There are a few circumstances which the applicant or the agent may apply for the extension of time. The explanation and illustration below will further explain on these circumstances: -

Explanation 1

Upon receiving the hearing notification, if the applicant or agent wishes to reschedule the hearing within the same month, he will need notify the hearing officer by email and get his approval.

Illustration (a)

The applicant or agent received hearing notification stated that the hearing date is fixed on 02nd January 2025. If the applicant or agent wish to postpone the hearing date between 3rd – 31st January 2025, the applicant or agent shall notify the hearing officer by email and get his approval. If the hearing officer approved such request, the applicant or agent need not to file for the EOT.

Explanation 2

If the applicant or agent wishes to reschedule the hearing to the following month, he shall apply for the extension of time with the prescribed fee.

Illustration (a)

The applicant or agent received hearing notification stated that the hearing date is fixed on 27nd January 2025. If the applicant or agent wish to postpone the hearing date to 1st February 2025, the applicant or agent shall apply for the EOT for 1 month and shall notify the hearing officer by email once they have filed for the EOT. Failure to do so might cause the application to be abandoned or deemed withdrawn.

Explanation 3

EOT application must be filed **BEFORE** or **ON** the date of the hearing. If there is no EOT filed, the trademark application will be set to be abandoned or deemed withdrawn.

Illustration (a)

The applicant or agent received hearing notification stated that the hearing date is fixed on 02nd January 2025. On the day of the hearing, the agent received instruction from the applicant or the applicant himself decided to file for the EOT, the applicant or agent may do so provided that the EOT applicant is filed on **the same day**, 02nd January 2025.

Illustration (b)

If the applicant or agent overlook the date and filed EOT on 03rd January 2025, the trademark application shall still be abandoned or deem withdrawn and there is no refund for that EOT filed.

Explanation 4

During hearing session, when the applicant or the agent need more time to tender the SD of use, the SD of use shall be submitted **within 2 weeks (including weekend)** only from the date of the hearing. No need to file for EOT if the SD of use is tendered within the same month.

Illustration (a)

The date of hearing is on 02 January 2025. During hearing, the applicant or agent requests more time to submit the SD of use. The due date to submit is on 16 January 2025 and there is no need to file for EOT.

Explanation 5

If the applicant or the agent need more than 2 weeks to complete the SD of use, the applicant or agent shall apply for the EOT with the prescribe fee. Failure to do so might cause the hearing officer to issue the decision based on the hearing submission only.

Illustration (a)

The date of hearing is on 02 January 2025. During hearing, the applicant or agent requests more time to submit the SD of use. The due date to submit is on 16 January 2025 but later the applicant or agent notify the hearing officer that they will need more time until 01st February 2025 to

submit the SD of use. The applicant or agent shall apply for the EOT with the prescribe fee.

Illustration (b)

The date of hearing is on 27 January 2025. During hearing, the applicant or agent requests more time to submit the SD of use. The due date to submit is on 10 February 2025 and there is no need to file for EOT. If the applicant or agent need more time after that, they shall apply for EOT with the prescribe fee.

Maximum Extension Periods (Reg 17(2))

The applicant is eligible for a maximum extension period of six (6) months during ex-parte hearing process.

8.3 HONEST CONCURRENT USE

8.3.1 PRINCIPLE OF HONEST CONCURRENT USE

Normally, an application to register a mark, which is confusingly similar to one that is already registered in the name of a different proprietor for the same goods or services, or for goods or services of the same description, must be objected under section 24.

Section 25(1), however, provides an exception. It gives the Registrar a discretion to register such a mark “in the case of honest concurrent use or of ... other special circumstances”, if he thinks it proper. The discretion includes the power to make the registration subject to such conditions, amendments, modifications or limitations as he may think right. The

phrasing makes it clear that honest concurrent use is itself a special circumstance. What other circumstances are special in this connection is considered in Part 17. Throughout trade mark legislation, the Registrar is concerned with the public interest, particularly the protection of the public from confusion and deception, and some evidence that the relevant public know both marks is required.

The factors which should be considered in examining evidence supplied to support a claim to the benefit of section 25(1), whether ex-parte or inter partes, were delineated by Lord Tomlin in *Pirie's Application* (1933) 50 R.P.C. 147. These are:

- (a) the extent of use in time and quantity and the area of the trade;
- (b) the degree of confusion likely to ensue from the resemblance of the marks, which is to a large extent indicative of the measure of public inconvenience;
- (c) the honesty of the concurrent use;
- (d) whether any instances of confusion have in fact been proved;
- (e) the relative inconvenience which would be caused if the mark were registered, subject if necessary to any conditions and limitations.

8.3.2 OTHER SPECIAL CIRCUMSTANCES

It would not be prudent to attempt any all-embracing definition of the meaning of this expression. All that is feasible is a note of the more important cases in which circumstances other than use have been held to come within the subsection. Some of them may come to light only in contested proceedings, but they are included here for convenience.

The applicant's use of his mark from a date prior to the date of the conflicting registration (or from the registered proprietor's first use if that is earlier than his registration) is always a special circumstance. This is the effect of section 25(1), which provides that the Registrar shall not refuse the later application if the applicant's use has been continuous. Of course, at the application stage, the Registrar will have no knowledge of the date of the registered proprietor's first use (unless that registration proceeded on evidence of use under section 23(2)). Accordingly, the Registrar cannot normally have regard to section 25(1) in ex-parte proceedings.