CHAPTER 12
ASSIGNMENT

Contents

ASSIGNMENT

12.1 Introduction

Assignment of a trademark means to **transfer** the owner's right in a trademark to another person. The transferring party is called the Assignor while the receiving party is known as the Assignee. (**Section 64 of TMA 2019**)

Fundamental aspects of Trademark Assignment Agreement;

Relevant Parties

The Assignor and the Assignee must be clearly identified. It should be emphasized that, both parties have the rights to file the application for assignment.

Description of the Trademark

It is important to have a clear identification of the trademark that is to be assigned i.e. the name / device /, registration / application number, class of goods / services as well as the goods or services it covers.

Commencement Date

The commencement date is the official start date of the Assignment Agreement become legally binding and enforceable.

Terms of Transfer

The conditions of transfer that emphasizes specific requirements or limitations of the transfer.

Signatures

It is of the utmost importance to make sure that both parties (the Assignor and the Assignee) or their authorized representatives sign the agreement.

12.2 Types of Trademark Assignment

There are 2 types of Assignment:

a) Complete Assignments (**Section 64 (2) of TMA 2019**)

The trademark proprietor transfers **ALL** rights in the trademark to another person. In other words, the Assignor relinquish all rights, claims or possessions of the said trademark to the Assignee.

Example:

X is the proprietor (owner) of a brand 'SUY'. X assigns his trademark 'SUY' in a complete assignment through an agreement to Y. Hence, the Assignor transfer the trademark as a whole to the Assignee. Therefore, X will no longer have any rights in respect to the mark 'SUY'.

b) Partial Assignment (**Section 64(2) of TMA 2019**)

The trademark proprietor assigns the trademark to another person with respect to only specifics services or goods. The transfer of ownership in the trademark is restricted to specific services or products. The Assignor may retain certain rights, for instance the right to use of certain categories of goods / services.

Example:

X is the proprietor of a trademark 'SUY' used for clothing and footwear. X assigns the rights in the mark 'SUY' in respect to only footwear to Y and retains the rights in the brand "SUY' in respect to clothing.

It is also essential to note that, assignment is available to **BOTH**, registered and unregistered mark. And that it can be assigned **WITH or WITHOUT** goodwill of the business. (**Section 64 of TMA 2019**)

When a trademark is assigned **WITH GOODWILL**, the Assignee can use the trademark for any class of goods and services, including the goods or services which were already in used by the Assignor. **(Section 64 (1) of TMA 2019)**

Example:

X is the proprietor of 'Sherry' brand relating to hair products. X assigns the brand 'Sherry' to Y with goodwill. Y will be able to use the brand 'Sherry' with respect to food products and any other products they manufacture.

On a contrary, for an assignment **WITHOUT GOODWILL** the transfer includes solely of the trademark, but not the associated goodwill. By way of illustration, the Assignee may be permitted to use the trademark on different products or for a different market place where the existence of the goodwill is irrelevant or nonessential.

12.3 Filing Procedures for Trademark Assignment

An application to record an assignment of a registered trade mark or an application for a registered trade mark (pending application) is documented by a submission of **Form TMH1** together with prescribed fee.

In the event that the application is made through an agent, a **Form TMR7** must also be submitted together with the **Form TMH1**. It is important to

note that, should the agent be acting for both parties, the **Form TMR7** should be filed separately as per the Assignor and the Assignee.

Furthermore, as the **Form TMH1** is regarded as <u>**prima facie**</u> evidence to court, the original Deed of Assignment ("**DOA**") may only be necessary if the appropriate signature(s) of the parties to the assignment are not provided in the **Form TMH1**; i.e. TMH1 is signed by the agent. Also, in a situation where the Registrar believe there is insufficient or lacking of information or documentation provided, the Registrar may request for further documentary evidence as to establish the assignment. **(Para 12(3) Guidelines 2019)**

In furtherance, as for Partial Assignment where the assignment refers to specific services or goods, the Applicant must first file for division of goods and services specifically according to their intended assignment. The request for division must be made by using **Form TMA5** bearing a new application number. The partial assignment can only be filed upon approval of the division.

documentary evidence via written notice to the Applicant. **(Para 12(3) TM Guideline 2019)**

12.4 Entry in Register

For an assignment of a registered trademark or any right to be listed on the Registry, the following particulars shall be entered in the Register –

>   (a) the name and address of the Assignee;

>   (b) the date of the Assignment; and

>   (c) a description of the right assigned

a) Sample Of TMH1

INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA
TRADEMARKS ACT 2019
APPLICATION TO RECORD REGISTRABLE TRANSACTION
(RELATING TO CHANGE OF OWNERSHIP)

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

- Do not use this form to record a partial change to the proprietor's rights. For partial assignment, the proprietor is advice to divide the registration before file an assignment
- This form is not a substitute for the assignment document or other proof of the transaction

1	Application/Registration No. :
2	Class(es) : ☐ All classes ☐ Class(es) as specified below:
3	Type of registrable transaction. Mark off which is applicable. ☐ Assignment ☐ Court Order, please provide proof. ☐ Assent by personal representatives, please provide proof. ☐ Company Merger
4	Date of transfer of ownership
5	Name of registered proprietor currently recorded in the register

6	Details of the new proprietor		
	a	**Full Name**	
	b	**Applicant type (Specify whether Person/individual, body corporate, partnership, LLP, association/body authority or Other)**	
	c	**Company Registration No. (For company or businesses registered in Malaysia only)**	
	d	**Business Address** • If the address is not within Malaysia, you must also complete section 2 below • If you want to use address other than business address, please also complete section 3	**Postcode:** **Town:** **State/Country:**
	e	**Telephone (For Malaysian applicant only)**	
	f	**Email**	☐ (Mark off this box if you would like us to correspond with you using our Electronic Filing System services. You must have a registered ID)
	g	**Registered proprietor's Reference (If any and no agent appointed)**	

7	Agent of new proprietor	
	a	Name:	
	b	Agent Code (if known)	
	c	Reference	

Note: Form TMR7 (RM20.00) must be filed with this form if the agent is newly appointed

8	Address for Services of the of new proprietor
	Postcode: **Town:**
	State/Country:

Note: Form TMR7 (RM20.00) must be filed with this form if the proprietor wants to use this address as correspondence address

9	**Authorization to change register**		

Note: Both parties or their representatives must sign this form. If this cannot be done, then personal representatives may sign on the appropriate box. Supporting documentary evidence must be provided.

	Old Registered Proprietor	New Proprietor
Please mark off appropriate box	☐ Old Proprietor ☐ Old Proprietor 's Recorded Representative	☐ New Proprietor ☐ New Proprietor 's Recorded Representative
Signature		
Name (Block Capital)		

10	**Declaration and Signature**

☐ **By the Applicant/Registered Proprietor Filing the Form**
I, the undersigned, do hereby declare that the information furnished above is true to the best of my knowledge.

☐ **By Agent** (An agent signing this Form on behalf of the applicant shall satisfy himself as to the truth of the declaration)

I, the undersigned, do hereby declare that:
i   I have been duly appointed and authorized to act as an agent on behalf of the applicant/registered proprietor who is filing this form.
ii   the information furnished above on behalf of the applicant/registered proprietor who is filing this form is true to the best of the applicant(s)' knowledge.

Signature: ....

Name of signatory: ....

Official capacity of signatory: _____

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

Date: ....

Attention:

It is an offence under section 103 of the Trademark Act 2019 to make or cause to be made a false entry to the Trademarks Office and that person may be liable to a fine not exceeding RM50,000 or a term of imprisonment not exceeding 5 years or to both.

11	**Confidentiality of Document** (Please mark off the box if applicable)

☐ I want to apply for this document to be treated as confidential (Fee of RM 10 will be added to the application fee)

12	**Scanning Sheet** (Self-calculation for payment of scanning services)			

No	Name of Document	No of Page(s)	Amount (RM2 for each page)

TOTAL PAYMENT FOR SCANNING SERVICES: RM ....

☐ If more space is necessary, mark off this box and use an additional sheet

13	PAYMENT DETAILS [Note: This will depend on the method of payment accepted.]

☐ Cash ☐ Cheque (Cheque No.) [   ]

☐ FPX ☐ Local Order (LO No.) [   ]

☐ Credit Card ☐ Other, please specify: [   ]

b) Sample of a Deed of Assignment

From unit RUANA department

I

DATED THIS   DAY OF
....

BETWEEN

....(assignor)..

AND

....(assignee)..

....
DEED OF ASSIGNMENT
....

DEED OF ASSIGNMENT

THIS DEED OF ASSIGNMENT is made on the ……….. day of ………..

BETWEEN

(assignor) ....

of : (assignor's address) ....

....

(hereinafter called "the Assignor") of the one part

AND

(assignee) ....

of : (assignee'saddress)..

....

(hereinafter called "the Assignee") of the other part.

WHEREAS:-

The Assignor are the applicant for the registration and the proprietor of the trade mark……………………in class………bearing the Application No………….. hereto (hereinafter called the "Trade Mark")

The Assignor has agreed to assign the Trade Mark to the Assignee for consideration and on terms hereinafter contained.

NOW IT IS HEREBY WITNESSES as follows:

In consideration of the sum of……………………… paid by the Assignee to the Assignor as aforesaid (the receipt of which is hereby acknowledged).

The Assignor confirms that this Agreement is made with the goodwill attaching to the Trade Mark and the goodwill of the business in which the Trade Mark has been used by the Assignor.

IN WITNESS WHEREOF the parties have by their representatives hereunto set their hands.

SIGNED BY ....   )
on behalf of (assignor)

) ....
              Name :
              Designation :

in the presence of:-
(witness)

....
Name & IC :
Designation :

SIGNED BY ....   )
for and behalf of (assignee)

) ....
              Name :
              Designation :

in the present of:-
(witness)

....
Name & IC :
Designation :

c) Sample of TMA5

<table>
<tr><td colspan="2" align="right">Fee Code
TMA5</td></tr>
</table>

INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA
TRADEMARKS ACT 2019
REQUEST TO DIVIDE AN APPLICATION FOR REGISTRATION OR REGISTERED TRADEMARK

Note:
- Please fill up all information require and attached related document if any.
- Fee for this request is for one class. Please indicate number of classes requested **2**

1	**Application or Registration No.:**	

2	**Number of Additional Divided Applications or Registrations:**	

3	**Specification of goods or services to be divided out** (Mark off whichever is applicable)

☑ All goods or services in the following class(es) of the original application are to be divided out.

Class No.

16	35										

☐ The following goods or services of the original application are to be divided out.

Class No.	Specification of Goods or Services
16	Paper, cardboard and goods made from these materials, not included in other classes; letterhead paper; printed matter; printed publications; photographs; stationery; plastic materials for packaging (not included in other classes).
35	Advertising; administrative services for the relocation of businesses; advisory services for business management; business inquiries; business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; business management and organization consultancy; business management assistance; business management consultancy; business organization consultancy; professional business consultancy; providing business information; providing business information via a web site; competitive intelligence services; market intelligence services; outsourcing services [business assistance]; personnel recruitment and placement services; marketing; marketing research; negotiation and conclusion of commercial transactions for third parties; updating and maintenance of data in computer databases; organization of trade fairs for commercial or advertising purposes; advisory and consultancy services in relation to the foregoing services.

4	**Specification of goods or services to remain** (Mark off whichever is applicable)

☑ All goods or services in the following class(es) of the original application are to remain.

Class No.

42											

	⊠	The following goods or services of the original application are to remain.

Class No.	Specification of Goods or Services
42	Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; software as a service (SaaS); blockchain as a service (BaaS); platform as a service (PaaS); advisory and consultancy services in relation to the foregoing services.

5 | **Name of Applicant or Registered Proprietor** (Please mark off box which is applicable)

⊠ No change from the existing record
☐ Different from the existing record
[Please fill up the box below. Fee of RM20 (Fee Code TMB4) will be charged to change name of the applicant together with this request. Various changes can be made under one payment]

6 | **Address of Applicant or Registered Proprietor** (Please mark off box which is applicable)

⊠ No change from the existing record
☐ Different from the existing record
[Please fill up the box below. Fee of RM20 (Fee Code TMB4) will be charged to change address of the applicant together with this request. Various changes can be made under one payment]

Postcode: Town:

State/Country:

7 | **Agent**

a	Name:	
b	Agent Code (if known)	
c	Agent's Reference	

Note: Fee of RM20 (Fee Code TMR7) will be charged if the agent is newly appointed

8 | **Address for Service of the Applicant/Registered Proprietor** (Please mark off box which is applicable)

⊠ No change from the existing record
☐ Different from the existing record
[Please fill up the box below. Fee of RM20 (Fee Code TMR7) will be charged for this request]

Postcode: Town:

State/Country:

9	**Declaration and Signature**

☐ **By the Applicant/Registered Proprietor Filing the Form**
I, the undersigned, do hereby declare that the information furnished above is true to the best of my knowledge.

☒ **By Agent** (An agent signing this Form on behalf of the applicant shall satisfy himself as to the truth of the declaration)

I, the undersigned, do hereby declare that:
i   I have been duly appointed and authorized to act as an agent on behalf of the applicant/registered proprietor who is filing this form.
ii   the information furnished above on behalf of the applicant/registered proprietor who is filing this form is true to the best of the applicant(s)' knowledge.

Signature:
Name of signatory
Official capacity of signatory: **Agent**

(Examples: Authorized person, Director, Partner or Principal Officer of Applicant(s)/ Agent)
Date: 28 June 2021

Attention:
It is an offence under section 103 of the Trademark Act 2019 to make or cause to be made a false entry to the Trademarks Office and that person may be liable to a fine not exceeding RM50,000 or a term of imprisonment not exceeding 5 years or to both.

10	**Confidentiality of Document**

(Please mark off the box if applicable)

☐ I want to apply for this document to be treated as confidential (Fee of RM 10 will be added to the application fee)

11	**Scanning Sheet**

(Self-calculation for payment of scanning services)

No	Name of Document	No of Page(s)	Amount (RM2 for each page)
	TOTAL PAGES AND AMOUNT TO PAY		

☐ If more space is necessary, mark off this box and use an additional sheet

12	**PAYMENT DETAILS** [Note: This will depend on the method of payment accepted.]

☐ Cash   ☐ Cheque (Cheque No.)

☐ FPX   ☐ Local Order (LO No.)

☐ Credit Card   ☒ Other, please specify: Interbank transfer

d) Flow Chart for Trademark Assignment.

Flow	Description
⬭ (start)	Received TMH1
▭	Document scanned and data entered by the IP Assistant
▭	Examine document: a. Agent status (in record or not) b. Form is in order c. Signature column fulfilled d. Any other related information
▭ *(Deciding whether to approve or not)*	Decision whether approve or not
◇ YES / NO	
▭ *(Updating data in the SPHI)*	Updating data in the SPHI
◇ YES / NO	
▭ *(The validation and uploading of letter will be processed together if the system SPHI is disrupted)*	Issuance of the Letter of Confirmation (LOC) and upload into the SPHI
◇ YES / NO	
▭	Print the LOC (upon request).
▭	The completed LOC will be ready for posting.
⬭ (end)	End of process