

# CHAPTER 3: SERIES OF MARKS

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## **CHAPTER 3: SERIES OF MARKS**

### **3.1 SERIES OF TRADE MARKS**

3.1.1 A series of trademarks refer to a set of marks which resemble each other in their material particulars but differ in non-distinctive elements. This allows the applicant to protect a range of related marks under a single registration.

3.1.2 Section 21 of Trademarks Act 2019 and Regulation 38 of the Trademark Regulations govern the registration of a series of marks.

Section 21(1) of the Trade Marks Act 1976 provides:

(1) A person may make a single application under subsection 17(2) for the registration of a number of trademarks if the trademarks -

- (a) resemble each other in material particulars; and
- (b) differ only in respect of one or more of the following matters:
  - (i) statements or representations as to the goods or services in relation to which the trademarks are used or intended to be used;
  - (ii) statements or representations as to number, price or quality;
  - (iii) standard fonts which do not substantially affect the identity of the trademarks; or the colour of any part of the trademark.

(2) If the application meets all the requirements under subsection (1), the Registrar shall register the trademarks as a

series in one registration.

(3) A trademark which has been registered as part of a series trademark may be used independently.

## **3.2 REQUIREMENTS FOR SERIES OF TRADEMARKS**

3.2.1 To qualify as a series of trade marks, the following requirements must be satisfied:

- (a) Each mark in the series must resemble each of the others in the series in their material particulars, that is, the main features in each of the trade mark must be essentially the same.
- (b) The differences between the marks must comprise only matters which, when considered as a separate element of the mark, be non-distinctive in nature.
- (c) The differences between the trademarks must not comprise matters which, in the context of the trade mark as a whole, substantially affect the identity of the trade marks.
  - (i) This is the over-riding requirement the differences between the marks must not substantially affect their identity. The test is not merely whether the marks in the series would be regarded as confusingly similar to each other if used by unrelated undertakings. Even if the marks are confusingly similar, the marks may still not qualify as a series.
  - (ii) Any variation in the non-distinctive features in the marks must leave the visual, phonetic and conceptual identity of each of the trademarks substantially the same. Even if the marks are conceptually similar, they will not constitute a series if there are substantial differences in the visual or aural identities of the marks.

- (iii) The assessment of whether the identity of the marks is substantially affected is based on the likely reaction to the marks of an average consumer of the goods/services in question.

### 3.3 APPLICATION PROCESS FOR SERIES OF TRADEMARKS

3.3.1 To register a series of trademarks, the applicant must:

- File Fee Code Form TMA2C

Fee Code  
**TMA2A**  
**TMA2B**  
**TMA2C**

**INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA**  
**TRADEMARKS ACT 2019**  
**APPLICATION FOR REGISTRATION OF TRADEMARK**

PAS Reference No. (if any):

Fee applicable for this request is for each class. Please indicate number of classes requested

Application for registration of trademark – by adopting from pre-approved list (Fee Code **TMA2A**)  
 Application for registration of trademark – without adopting from pre-approved list (Fee Code **TMA2B**)  
 Series of trademark (Fee Code **TMA2C**)

<b>1</b>	<b>APPLICANT</b> [If there is more than one applicant mark off this box and fill additional information]: <input type="checkbox"/>	
a	<b>Applicant's Name:</b> (If partnership, please provide names of the partners)	
b	<b>Applicant type</b> (Specify whether Person/individual, body corporate, partnership, LLP, association/body authority or others)	
c	<b>Identity Card No. /Passport No.</b> (for individual) or <b>Company Registration No.</b> (for company or businesses registered in Malaysia only)	
d	<b>Address of applicant:</b> • If the address is not	<input style="width: 90%;" type="text"/>

- Pay an additional fee of RM50.00 for each subsequent trademark in the series

- An application may include up to 6 marks in a series

**7 THE TRADEMARK** The representation of trademark must be firmly attached or affixed in the provided area below. Please mark off which is applicable.

Representation of the trademark is in black & white (please attach a black and white representation of the mark)

Representation of the trademark is in colour. If colour(s) is/are claimed. (please attach a representation of the mark in colour)

.....

.....

.....

If the application is for a series trademark, please indicate number of series in the box provided. For series trademark, the maximum number is 6 only.

### 3.4 EXAMPLES OF ALLOWED SERIES

#### 3.4.1 Uppercase and Lowercase Variations

In order for the marks to be acceptable as a series, differences in uppercase and lowercase letters must not result in the marks being perceived or pronounced differently.

IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• The only difference is capitalization - which is considered a non-distinctive element.</li> </ul>
<p><b>Jaga</b> <b>JAGA</b></p>	<p>Accepted</p> <ul style="list-style-type: none"> <li>• The word is exactly the same in spelling and pronunciation.</li> </ul>
	<p>Accepted</p>

<p style="text-align: center;"><b>COLOUD</b></p> <p style="text-align: center;">coloud</p>	<ul style="list-style-type: none"> <li>Exact same word, only case changes</li> </ul>
<p style="text-align: center;"><b>FRESHMACK</b></p> <p style="text-align: center;">Freshmack</p> <p style="text-align: center;">freshmack</p>	<p>Accepted</p> <ul style="list-style-type: none"> <li>The only difference is capitalization - which is considered a non-distinctive element.</li> </ul>

### 3.4.2 Variations in Stylizations

Variations in stylization should be minimal and non-distinctive in nature, so that the differences do not substantially affect the identity of the marks in the series.

### 3.4.3 Conventional Fonts

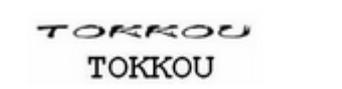
For marks containing textual elements, the use of different scripts or fonts is acceptable as a series, provided that the scripts or fonts are conventional and not fanciful or elaborate in their styling.

IMAGE	DECISION
<p style="text-align: center;"><b>ALL TORQUE</b></p> <p style="text-align: center;"><b><i>ALLTORQUE</i></b></p>	<p>Accepted</p> <ul style="list-style-type: none"> <li>different scripts or fonts</li> </ul>
<p style="text-align: center;"><b>MARRYBROWN</b></p> <p style="text-align: center;"><b><i>Marrybrown</i></b></p> <p style="text-align: center;"><b><i>Marrybrown</i></b></p>	<p>Accepted</p> <ul style="list-style-type: none"> <li>different fonts</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>different fonts</li> </ul>

<b>LIGHT SKY</b> LIGHT SKY	
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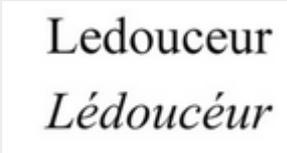
### 3.4.4 Fanciful Stylizations

A word mark which contains stylised letters may be acceptable in a series, provided that the stylization is not overly fanciful and does not render the marks substantially different in identity from the rest of the series.

IMAGE	DECISION
	Accepted <ul style="list-style-type: none"> <li>• stylised letter(s)</li> </ul>
	Accepted <ul style="list-style-type: none"> <li>• stylised letter(s)</li> </ul>
	Accepted <ul style="list-style-type: none"> <li>• stylised letter(s)</li> </ul>

### 3.4.5 Symbols and Special Characters

Where the marks in a series contain symbol(s) or special character(s), the series is acceptable provided that the symbol or special character does not substantially alter the visual, aural, or conceptual identity of the marks.

IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>marks in a series contain symbol(s) or special character(s)</li> </ul>

### 3.4.6 Punctuation

Punctuation is used to provide sense, clarity, and emphasis in sentences. Punctuation marks help structure and organise a phrase or sentence. Where the marks in a series differ in their punctuation, the series is acceptable provided that the punctuation does not substantially alter the visual, aural, or conceptual identities of the marks.

IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>Punctuation is used to create meaning, clarity, and emphasis in sentences.</li> </ul>
<p><b>DR. MCT</b> <b>Dr. MCT</b> <b>dr. MCT</b></p>	<p>Accepted</p> <ul style="list-style-type: none"> <li>Punctuation is used to create meaning, clarity, and emphasis in sentences.</li> </ul>

### 3.4.7 Positioning of Elements

In order to qualify as a series, differences in the positioning of elements within the marks must not substantially affect the overall identity of the series of marks.

IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• differences in the positioning</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• differences in the positioning</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• differences in the positioning</li> </ul>

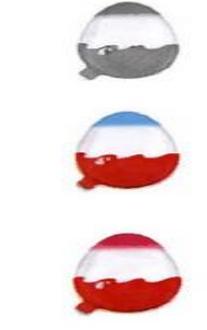
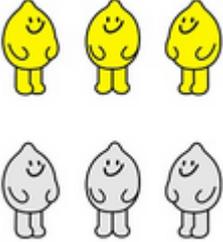
### 3.4.8 Cartoon Characters in Series of Trademarks

When assessing whether marks comprising cartoon characters are acceptable as a series, the following factors are considered:

- Overall appearance of the characters
- Clothing worn by the characters
- Props used or held by the characters
- Names ascribed to the characters
- Positions assumed by the characters
- Activities undertaken by the characters
- The extent to which the props, clothing, names, and/or activities dominate the mark.

For example : The marks below fullfills the factors listed above.

IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p>

	<ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>

### 3.4.9 Colour Variations in Series of Trademarks

Differences in colour in the elements of the marks are acceptable in a series only if the colours do not substantially affect the identities of the marks.

The criterion for marks to be acceptable as a series is not about the size of the element in which the colour difference lies, or whether the marks would be seen as pointing to the same trade source. Even if the colour difference lies within a minor portion of the marks or if it is clear that the marks belong to the same trade source, the marks may still be found to be unacceptable as a series if there are substantial differences in the identities of the marks.

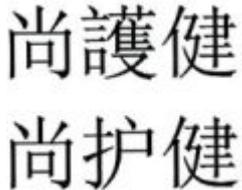
IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks and consisting of device(s)</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks</li> </ul>

	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks and consisting of device(s)</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks and consisting of device(s)</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks and consisting of device(s)</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>• Colour difference in word marks and consisting of device(s)</li> </ul>

### 3.4.10 Chinese Characters in Series of Trademarks - Traditional and Simplified Chinese Characters

Where the marks in a series contain Chinese characters, their acceptability as a series may include both traditional and simplified forms of the same Chinese character(s), provided that the differences do not substantially affect the overall identity of the marks.

This means that a traditional character and its simplified counterpart should retain the same pronunciation, meaning, and general appearance. If there are substantial differences in form or significance, the marks may not be considered a series.

IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The mark is accepted because the meaning of the Chinese Character is the same. The mark is written in simplified Chinese Character and Traditional Chinese Character.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The mark is accepted because the meaning of the Chinese Character is the same. The mark is written in simplified Chinese Character and Traditional Chinese Character.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The mark is accepted because the meaning of the Chinese Character is</li> </ul>

		the same. The mark is written in simplified Chinese Character and Traditional Chinese Character.
	<p>鍾靈 钟灵</p>	<p>Accepted</p> <ul style="list-style-type: none"> <li>The mark is accepted because the meaning of the Chinese Character is the same. The mark is written in simplified Chinese Character and Traditional Chinese Character.</li> </ul>
	<p>天貓 天貓 天貓</p>	<p>Accepted</p> <ul style="list-style-type: none"> <li>The mark is accepted because the meaning of the Chinese Character is the same. The mark is written in simplified Chinese Character and Traditional Chinese Character.</li> </ul>
	<p>天貓魔盒 天貓魔盒 天貓魔盒</p>	<p>Accepted</p> <ul style="list-style-type: none"> <li>The mark is accepted because the meaning of the Chinese Character is the same. The mark is written in simplified Chinese Character and Traditional Chinese Character.</li> </ul>

### 3.4.11 Colour difference in marks consisting of device(s)

The addition of colours to simple shapes will occasionally add distinctiveness to an otherwise non-distinctive mark. In such cases, the marks will not qualify as a series given that a distinctive element of

the mark, that is, the colour, is not the same in all of the marks. This principle is illustrated in the following examples:

IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>

### 3.4.12 Background

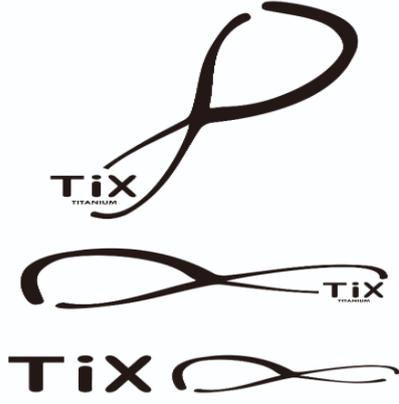
Variations to backgrounds in a series of marks may be permissible if the backgrounds are merely a subordinate and non-distinctive feature of the marks and the difference in backgrounds does not substantially affect the identity of the marks.

IMAGE	DECISION
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>
	<p>Accepted</p> <ul style="list-style-type: none"> <li>The shape of the mark remained the same but varied in colors.</li> </ul>

### 3.5 EXAMPLES OF SERIES NOT ALLOWED

3.5.1 The representation of trademark images cannot be accepted as a series when the differences between the marks vary in their position and meaning.

IMAGE	DECISION
	<p>Not Accepted</p> <ul style="list-style-type: none"> <li>The mark is not acceptable because additional word 'Deterjen'.</li> </ul>

	<p>Not Accepted</p> <ul style="list-style-type: none"> <li>The mark is not acceptable because both marks designs is dissimilar.</li> </ul>
	<p>Not Accepted</p> <ul style="list-style-type: none"> <li>The marks is different in backgrounds</li> </ul>
	<p>Not Accepted</p> <ul style="list-style-type: none"> <li>The mark is not acceptable because the words are not the same</li> </ul>
	<p>Not Accepted</p> <ul style="list-style-type: none"> <li>The mark is not acceptable because the words are not the same</li> </ul>
	<p>Not Accepted</p> <ul style="list-style-type: none"> <li>The mark is not acceptable because additional word 'Titanium'.</li> </ul>