

CHAPTER 9

OPPOSITION PROCEEDING & GROUNDS OF OPPOSITION

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9.1 Who May Oppose

Who May Oppose

9.1.1 Any person may file an opposition. It is not necessary for the opponent to be a trademark owner. Opposition may also be initiated by entities such as trade organizations or consumer associations. The predecessor-in-title can also continue the opposition proceedings that were originally initiated by its predecessor.

Multiple Opponents

9.1.2 More than one opponent may file an opposition against the same trademark application. Each opposition will be assessed independently based on its respective grounds. If any opposition succeeds, the trademark application will not proceed to registration.

Joint Opponents

9.1.3 An opposition may also be filed jointly, typically by a parent company and its subsidiary. In such cases, either party may submit evidence of use to support the opposition.

- Example: McDonald's International Property Ltd (USA) may file a joint opposition with its Malaysian subsidiary. Evidence of use by the Malaysian subsidiary can be submitted to demonstrate use in Malaysia.

9.2 Opposition Files

Access and Confidentiality of Opposition Documents

9.2.1 Opposition documents are considered private and confidential and can only be accessed by the parties involved in the opposition. The parties may request copies of certain key documents, including the notice of opposition, counterstatement, statutory declarations, and written submissions. However, any other documents that are not directly related to the opposition will not be accessible to the parties.

Confidentiality in Cases of Multiple Opponents

9.2.2 If multiple opponents have filed opposition against the same trademark application, access to documents will be restricted. One opponent shall not have access to the documents or details of another opponent's opposition, ensuring the confidentiality of each case.

Access by Third Parties and Agents

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

9.3 Opposition Procedure

Filing of Notice of Opposition [Reg. 23]

9.3.1 Within 2 months from the publication date, any person may initiate opposition proceedings by filing a Notice of Opposition using Form TMD1, accompanied by the prescribed fee and a statement of grounds for opposition. Each class shall be filed with separate notice and statement of grounds as each class will be evaluated separately.

Content Requirement

9.3.2 The statement of grounds must contain grounds on which the opposition is based. If the opponent alleged that the applicant's mark resembles any of its registered marks or pending applications, the following details must be stated in the notice:

- ✓ Trademark application number(s)
- ✓ Specification of goods and/or services

9.3.3 If the opponents rely on an unregistered mark (common law ownership), the notice must include:

- ✓ A clear representation of the mark
- ✓ The specification of goods and/or services

Example of a completed Form TMD1 (for reference only)

INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA TRADEMARKS ACT 2019 NOTICE OF OPPOSITION		Fee Code TMD1-D5																	
Note: <ul style="list-style-type: none"> • 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 1 																			
1	Notice is hereby given to oppose the application for registration of: (Please tick whichever is applicable) <ul style="list-style-type: none"> <input checked="" type="checkbox"/> The Registration of A Trade Mark, Collective Mark or Certification Mark – Fee Code TMD1 <input type="checkbox"/> An Amendment of An Application for Registration of a Trademark Which Has Been Published Where the Amendment Affects the Representation of the Trade Mark or the Restriction Affec the Goods or Services Covered by the Application For Registration - Fee Code TMD2 <input type="checkbox"/> An Application to Amend the Regulations Governing the Use of a Registered Collective Mark or Certification Mark - Fee Code TMD3 <input type="checkbox"/> Change of classification by Registrar - Fee Code TMD4 <input type="checkbox"/> Correction of Protected International Registration Designating Malaysia - Fee CodTMD5 																		
2	Application or Registration No. : XXXXXXXXXX																		
3	Details of Opposition <table border="1" style="width: 100%; border-collapse: collapse; margin-top: 10px;"> <thead> <tr> <th rowspan="2" style="width: 40%;">Class(es) to be opposed</th> <th colspan="2" style="text-align: center;">Intellectual Property Official Journal in which the opposed mark was advertised</th> </tr> <tr> <th style="text-align: center;">Date</th> <th style="text-align: center;">Jilid/Batch</th> </tr> </thead> <tbody> <tr> <td style="text-align: center;">28</td> <td style="text-align: center;">16-Jun-22</td> <td style="text-align: center;">23_2022</td> </tr> <tr> <td> </td> <td> </td> <td> </td> </tr> <tr> <td> </td> <td> </td> <td> </td> </tr> <tr> <td> </td> <td> </td> <td> </td> </tr> </tbody> </table>		Class(es) to be opposed	Intellectual Property Official Journal in which the opposed mark was advertised		Date	Jilid/Batch	28	16-Jun-22	23_2022									
Class(es) to be opposed	Intellectual Property Official Journal in which the opposed mark was advertised																		
	Date	Jilid/Batch																	
28	16-Jun-22	23_2022																	
4	Grounds of opposition: (Statement of the grounds of opposition shall be attached to this form). <div style="border: 1px solid black; padding: 10px; margin-top: 10px; min-height: 100px;"> SEE ATTACHED NOTICE OF OPPOSITION. </div> <p style="font-size: small; margin-top: 10px;">If the space provided is in sufficient, please continue on a separate sheet which must be firmly annexed to this For Grounds of opposition with written Application ot Registration No at the top right corner of each additional page and paginated.</p>																		

5 OPPONENT

a	Name:	[REDACTED]
b	Address (If the address is not within Malaysia, you must also complete section 6 below)	[REDACTED] [REDACTED] Postcode: 14000 Town: BUKIT MERTAJAM State/Country: PENANG/MALAYSIA
c	Telephone	
d	Email	<input type="checkbox"/> (Complete this section and tick off this box if you have no representative and would like us to correspond with you using our Online services.)
e	Reference (If no agent appointed)	

6 AGENT

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

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

7 ADDRESS FOR SERVICES OF THE OPPONENT (if no agent is appointed and the opponent wanted to have supplementary address other the stated in item 1(b))

a	Address	
		Postcode: Town:
		State/Country:
b	Telephone	

Note: Fee of RM20 (Fee Code TMR7) will be charged

8 **DECLARATION AND SIGNATURE**

By Person 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 person(s) filing this form.
- ii the information furnished above on behalf of the person(s) filing this form is true to the best of the applicant(s)' knowledge.

Signature: 

Name of signatory: 

Official capacity of signatory: TRADEMARK AGENT

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

Date: 15 August 2022

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

Example of Notice of Opposition (for reference only)

TRADEMARKS ACT 2019 (ACT 815)
TRADEMARKS REGULATIONS 2019

NOTICE OF OPPOSITION TO APPLICATION
FOR REGISTRATION OF A TRADE MARK
(Regulation 23)

IN THE MATTER OF Malaysia Trade
Mark Application No [REDACTED]

for [REDACTED] in Class 39 in the
name of [REDACTED],
Ltd.

AND

IN THE MATTER OF an Opposition
thereto by [REDACTED]

GROUNDS OF OPPOSITION

We [REDACTED]

[REDACTED] (the "Opponent"), hereby give notice of our intention to
oppose the registration of Trade Mark Application [REDACTED]

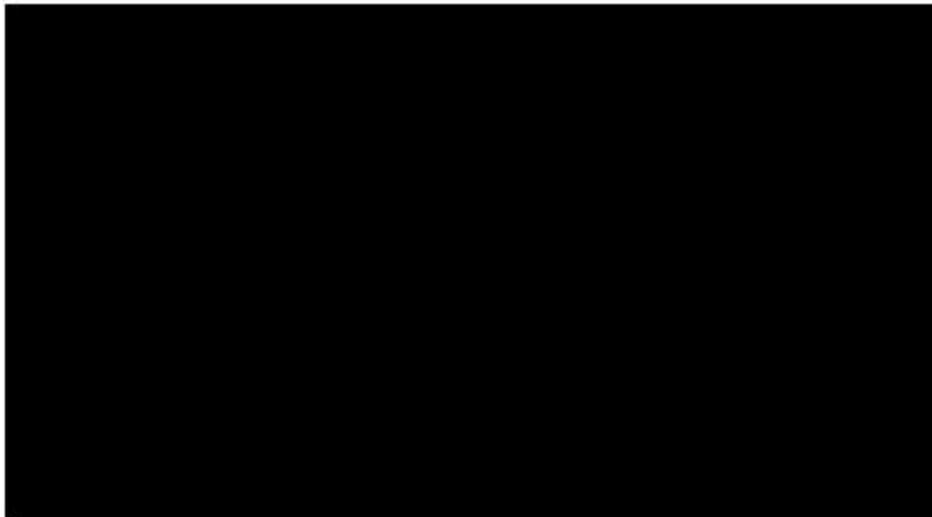
[REDACTED] in Class 39, which was applied for on 13 September 2024 (the
"Application Date") and advertised in the Malaysia Intellectual Property Official
Journal, Batch 4/2025 at pp 195 to 196 on 23 January 2025.

The Grounds of Opposition are as follows.



The Opponent's Marks

1.



2. The Opponent owns, inter alia, the following trade mark registrations in Malaysia (hereinafter referred to as the [REDACTED])

Trade Mark No.	Mark	Class	Specification of Services ("Opponent's Services")	Filing Date
[REDACTED]	[REDACTED]	39	TRANSPORT, IN PARTICULAR TRANSPORT OF GOODS AND WARES VIA MOTOR VEHICLES, AUTOMOBILES, TRUCKS, RAILWAYS, SHIPS, PLANES, PACKAGING AND STORAGE OF GOODS; TRANSPORTATION INFORMATION; SERVICES OF A FREIGHT BROKERAGE; UNLOADING CARGO; STORAGE INFORMATION; COURIER SERVICES; LOGISTIC SERVICES IN THE FIELD OF TRANSPORT; COLLECTING, TRANSPORT AND DELIVERING OF GOODS, IN PARTICULAR DOCUMENTS, PARCELS, PACKETS, LETTERS AND PALLETS, FREIGHTING OF SHIPS, PLANES, RAILWAYS, AUTOMOBILES, MOTOR VEHICLES, TRUCKS; FOLLOW-UP SERVICES; INVOLVING THE ELECTRONIC TRACKING OF GOODS AND ITEMS, IN PARTICULAR DOCUMENTS, PARCELS, PACKETS, LETTERS AND PALLETS (TRACK AND TRACING); WAREHOUSE	5 November 2007

3. The Opponent has extensively and continuously used (or licensed) and promoted the [REDACTED] Marks in Malaysia with the Opponent's Services for many years prior to the Application Date.
4. By virtue of the extensive use and promotion of the [REDACTED] Marks in Malaysia, the Opponent has acquired substantial reputation and goodwill in its business under the [REDACTED] Marks in Malaysia.
5. As the filing dates of the DHL Marks predate the Application Date, [REDACTED] Marks are each and individually, an earlier trade mark within the definition of section 5 of the Trademarks Act 2019 (the "TMA").

The Applicant's Mark

6. [REDACTED]

"Application Mark") in relation to the following services:

Class 39: Car transport; Packaging of goods; Freight brokerage; Cargo unloading; Warehousing services; Temporary safekeeping of personal belongings; Temporary storage of deliveries; Gas supplying [distribution]; Electricity distribution; Water supplying [distribution]; Heat supplying [distribution]; Rental of warehouse space; Provision of parking spaces;

Parking lot services; Parking services; Rental of mechanical parking systems (the "Application Services").

6. The element [REDACTED] in the Application Mark is highly similar to the dominant and distinctive element, [REDACTED] in the [REDACTED] Marks. This renders the Application Mark and the [REDACTED] Marks visually, aurally and conceptually highly similar. Neither the device in the Application Mark nor the applied colour limitation is sufficient to diminish the strong similarities between the Application Mark and the [REDACTED] Marks.

7. The Application Services are identical or highly similar to the Opponent's Services.

8. [REDACTED] and the identity of or high degree of similarity between the Application Services and the Opponent's Services, the registration and use of the Application Mark would lead to a likelihood of confusion on the part of the public. As such, registration of the Application Mark would be contrary to s 24(2)(b) read with s 34(2)(a) of the TMA.

9. Further and/or in the alternative, by virtue of the similarity of the Application Mark and the [REDACTED] Marks, and the identical nature and/or close proximity of the Application Services and the Opponent's Services, the use of the Application Mark will lead or is likely to lead the public to believe that the services offered by the Applicant under the Application Mark are the

services of the Opponent, and/or that the Applicant's business is somehow connected to the business of the Opponent when in fact no such connection exists. By reason of such misrepresentation, the Opponent is likely to suffer damage to its substantial goodwill. Such use of the Application Mark is liable to be prevented by the law of passing off. Therefore, the registration of the Application Mark would be contrary to section 24(4)(a) read with section 34(2)(a) of the TMA.

10. By reason of all the matters above and by virtue of the law and in the exercise of the learned Registrar's discretion, the Opponent prays that the opposition be allowed and that the Application Mark be refused registration with costs against the Applicant.

Service Requirement

9.3.4 Upon filing of the notice of opposition, the opponent shall serve a copy of the said notice and grounds of opposition to the applicant at the same time. Within 14 days of the filing date, the Opponent have to file affidavit of service with the registrar by exhibiting the proof of delivery by the applicant.

9.3.5 If no notice of opposition and/or affidavit of service is filed in time, the opposition is deemed withdrawn, and the application will proceed to registration.

9.3.6 Details on the mode of successful delivery are provided in Part 9.9.2

Issue: The Opponent is required to first file the Form TMD1 and the grounds of opposition with the Registrar along with the payment of the prescribed fee before serving the Form TMD1 and the grounds of opposition to the Applicant. If the Opponent files the Form TMD1 and the grounds of opposition to the Applicant without first filing the documents with the Registrar, the filing of the documents will be considered invalid.

Filing of Counterstatement [Reg. 24]

9.3.7 Upon receipt of the Notice of Opposition, the applicant shall file a Counterstatement in Form TMD6 with the prescribed fee within 2 months from the date of receipt of the opponent's notice of opposition. An extension of time may be granted for a maximum period of 6 months.

Content Requirement

9.3.8 The counterstatement must outline the grounds on which he relies in support of his application, as well as admit or deny any facts stated in the notice of opposition, which he admits.

Example of a completed Form TMD6 (for reference only)

<div style="border: 1px solid black; padding: 2px; display: inline-block;"> Fee Code TMD6 </div>										
INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA TRADEMARKS ACT 2019 COUNTERSTATEMENT										
Note: <ul style="list-style-type: none"> 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 										
1	Application No: XXXXXXXXXX									
2	Counter-statement for class(es), please specified : 35 Grounds in support of application : (Statement of the grounds in support of application shall be attached to this form).									
3	Name of Applicant (Please mark off box which is applicable) <input checked="" type="checkbox"/> No change from the existing record <input type="checkbox"/> 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] <div style="border: 1px solid black; height: 20px; width: 100%;"></div>									
4	Address of Applicant (Please mark off box which is applicable) <input checked="" type="checkbox"/> No change from the existing record <input type="checkbox"/> 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] <div style="border: 1px solid black; height: 20px; width: 100%;"></div>									
5	Agent <table border="1" style="width: 100%; border-collapse: collapse; margin-top: 5px;"> <tr> <td style="width: 5%; text-align: center;">a</td> <td style="width: 30%;">Name:</td> <td style="width: 65%;">XXXXXXXXXX</td> </tr> <tr> <td style="text-align: center;">b</td> <td>Agent Code (if known)</td> <td>XXXXXXXXXX</td> </tr> <tr> <td style="text-align: center;">c</td> <td>Agent's Reference</td> <td>-</td> </tr> </table> <p style="font-size: small; margin-top: 5px;">Note: Fee of RM20 (Fee Code TMR7) will be charged if the agent is newly appointed</p>	a	Name:	XXXXXXXXXX	b	Agent Code (if known)	XXXXXXXXXX	c	Agent's Reference	-
a	Name:	XXXXXXXXXX								
b	Agent Code (if known)	XXXXXXXXXX								
c	Agent's Reference	-								

6	<p>Address for Service of the Applicant/Registered Proprietor (Please mark off box which is applicable)</p> <p><input checked="" type="checkbox"/> No change from the existing record/register <input type="checkbox"/> Different from the existing record/register [Please fill up the box below. Fee of RM20 (Fee Code TMR7) will be charged for this request]</p> <div style="border: 1px solid black; height: 20px; width: 100%;"></div>
7	<p>Declaration and Signature</p> <p><input type="checkbox"/> 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.</p> <p><input checked="" type="checkbox"/> By Agent (An agent signing this Form on behalf of the applicant shall satisfy himself as to the truth of the declaration)</p> <p>I, the undersigned, do hereby declare that:</p> <p>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.</p> <p>Signature: [REDACTED].....</p> <p>Name of signatory: [REDACTED].....</p> <p>Official capacity of signatory: <u>Agent</u>.....</p> <p>(Examples: Authorized person, Director, Partner or Principal Officer of Applicant(s)/ Agent)</p> <p>Date: <u>29 November 2024</u>.....</p> <p>Attention:</p> <p>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.</p>
8	<p>Confidentiality of Document</p> <p>(Please mark off the box if applicable)</p> <p><input type="checkbox"/> I want to apply for this document to be treated as confidential (Fee of RM 10 will be added to the application fee)</p>
9	<p>Scanning Sheet</p> <p>(Self-calculation for payment of scanning services)</p>

Example of Counterstatement (for reference only)

**THE TRADEMARKS ACT 2019
TRADEMARKS REGULATIONS 2019
COUNTERSTATEMENT TO A NOTICE OF OPPOSITION**

IN THE MATTER OF Trade Mark
Application No. [REDACTED]

[REDACTED]
" in Class 25
in Malaysia in the name of

[REDACTED]

AND

IN THE MATTER of an
Opposition thereto by [REDACTED]

[REDACTED]

**COUNTERSTATEMENT TO A NOTICE OF OPPOSITION AND GROUNDS OF
OPPOSITION**

We, [REDACTED]

[REDACTED]

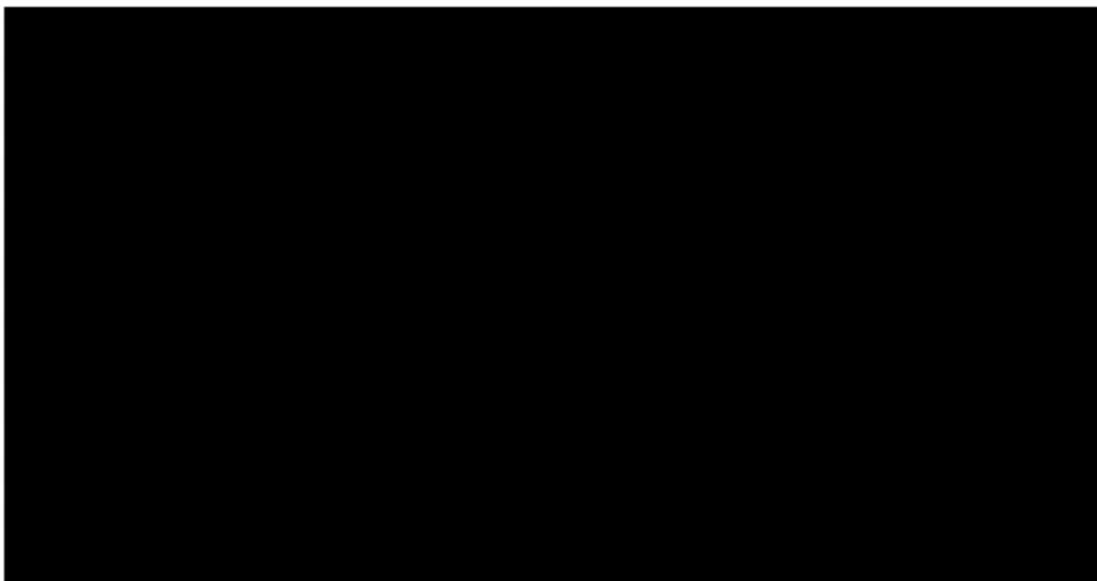
HEREBY GIVE NOTICE that the following are the grounds on which we intend to rely as supporting our application to register Trademark Application No. [REDACTED]

[REDACTED] (hereinafter referred to as the "Applicant's trademark") in Class 25 pursuant to Section 34 of the Trademarks Act 2019 and Regulations 2019 and hereby contest and file the Counter Statement in reply to the Opponents' Notice of Opposition.

hiking shoes; headgear for children; headgear for men; hosiery; insoles for shoes and boots; leather shoes; leisure shoes; rubber shoes; sandals; shoe straps; slippers; socks; soles for footwear; sportswear; stockings; waterproof footwear; wooden shoes; boots for sport; boots and shoes; sports shoes.

The Applicant has submitted its Trademark Application No. [REDACTED] for the Applicant's trademark to be processed, examined, tested and scrutinized following the due process of the law by the Registrar of Trade Marks under the relevant Trademarks Act 2019.

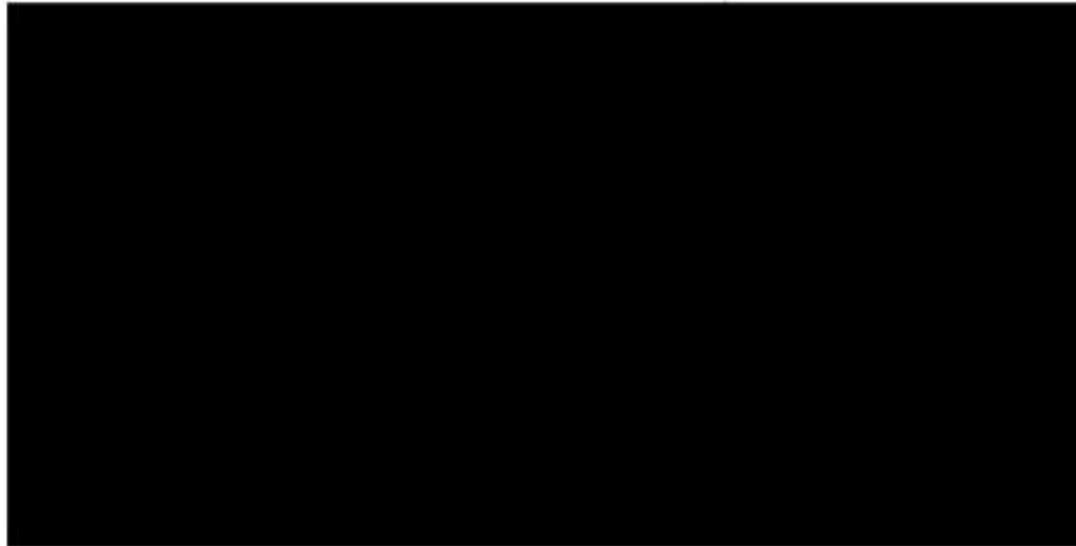
At the time of filing of the Applicant's trademark in Class 25 in 05th December 2022, the Applicant is the only user and rightful owner of the trademark "[REDACTED]" in Malaysia in relation to the goods designated in class 25.



by the Registrar of Trade Marks then proceeded to advertisement in the Malaysian Intellectual Property Official Journal.

The Registrar of Trade Marks then advertised the Applicant's Trademark Application No. [REDACTED] (Applicant's trademark) in the Malaysian Intellectual Property Official Journal Batch 22/2023 on the 06th July 2023 at page 204.

The Applicant is the originator, author, first user, prior user and the only user of the Applicant's trademark in Malaysia in relation to the Class 25 goods which it has applied for. By the said reason, the Applicant is the common law owner of the Applicant's trademark in Malaysia when



It is not illegal and wrongful for the Applicant to use its own invented device and trademark. In fact, the Applicant is fully entitled in law and has been granted the statutory exclusive rights to use its own device mark and trademark and to authorise other person to use its device mark and trademark on its products, under the Trademarks Act 2019 and the common law.

The Applicant denies paragraph 9 of the Grounds of Opposition and vehemently avers that regardless of any overlap or close relation between the goods offered in connection with the Opponents' ████████ Marks and the Applicant's trademark (which is denied), the Applicant submits that this is irrelevant since the Applicant has established without question that the respective marks are visually, aurally and conceptually distinguishable as largely described pursuant to the above paragraphs so as to eliminate any likelihood of confusion.

The Opponents' assertion of the identicalness or similarities is based on the Opponents' wrongful stretching of the test of confusing similarities. Consumers these days are educated and has basic knowledge of branding, they would not be foolish to buy the Applicant's goods thinking that it is the Opponents' goods.

By reasons of the abovementioned visual, aural and conceptual differences, the Applicant denies paragraphs 10 and 11 of the Grounds of Opposition and firmly avers that regardless of any overlap or close relation between the goods offered in connection with the Opponents' adidas Marks and the Applicant's trademark (which is denied), there is no likelihood of confusion or deception to consumers pursuant to Section 24(2)(b) and 34(2)(a) of the Trademarks Act 2019.

25. Paragraph 12 of the Grounds of Opposition is denied. The Applicant's trademark is created by the Applicant. The Applicant has through its own independent effort and continuous use of the Application trademark built up its own reputation and goodwill in the Malaysian market in relation to the Applicant's goods. The Applicant's trademark has in fact become known to the public and identified with the Applicant so much that it is distinctive of the Applicant and no one else. As a result, thereof, registration of the Applicant's trademark does not contravene to the relevant sections of the said Trademarks Act 2019 and accordingly should be allowed to proceed to registration.

26. By reasons of the above, the Applicant humbly prayed the Opponents' Opposition be dismissed with cost and the Applicant's trademark Application no. TM2022032734 proceed for registration.

Dated this 30 October 2023.

Service Requirement

9.3.9 Upon filing of the counterstatement, the applicant shall serve a copy of the counterstatement to the opponent at the same time. Within 14 days of the filing date (cs), the applicant has to file affidavit of service with the registrar by exhibiting the proof of delivery by the opponent.

(Refer to Chapter 9.9.2 for evidence of successful service of documents)

9.3.10 If no counterstatement and/or affidavit of service is filed in time, the application is deemed withdrawn to the extent of the contested classes.

Issue: If the applicant has multiple classes under a single application (e.g., 3 classes – class 29, class 30, and class 35), and the opponent opposes only one class (e.g., class 35), but the applicant fails to file the counterstatement or affidavit of service, that particular class (class 35) will be deemed withdrawn. The remaining classes (class 29 and class 30) will proceed to registration.

Issue: The Applicant is required to first file the Form TMD6 and the grounds of counterstatement with the Registrar along with the payment of the prescribed fee before serving the Form TMD6 and the grounds of counterstatement to the Opponent. If the Applicant files the Form TMD6 and the grounds of counterstatement to the Opponent without first filing the documents with the Registrar, the filing of the documents will be considered invalid.

Filing of Evidence in Support of Opposition [Reg. 25]

9.3.11 The opponent shall then file evidence in support of opposition within 2 months from the date of receipt of counterstatement from the applicant. An extension of time may be granted for a maximum period of 6 months.

Content Requirement

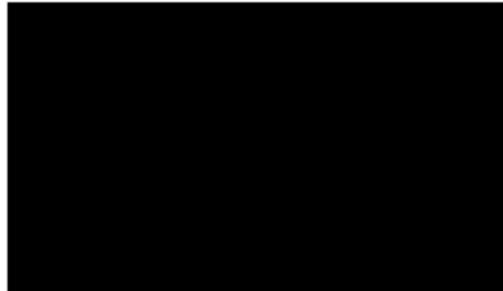
9.3.12 The evidence shall be submitted by way of a statutory declaration, certifying that the facts and evidence in the statutory declaration are true (Sec. 64).

Example of Statutory declaration (for reference only)

TRADEMARK ACT 2019

TRADEMARKS REGULATIONS 2019

IN THE MATTER OF Application No.



the 'Applicant').

AND

IN THE MATTER of an Opposition
thereto by [REDACTED] hereinafter
referred to as 'the Opponent').

STATUTORY DECLARATION
(Evidence In Support of Opposition)

I, [REDACTED]
[REDACTED]

Geneve, Switzerland do hereby solemnly and sincerely declare as follows:-

1. I am the CEO of the Opponent. I am duly authorised by the Opponent to affirm this Statutory Declaration on their behalf by virtue of my aforesaid position. Save as otherwise stated, the facts deposed herein are to the best of my knowledge or derived from the records of the Opponent to which I have full and unrestricted access.
2. I have read the Notice and Grounds of Opposition filed by the Opponent ("**Grounds of Opposition**") and adopt in total the contentions set out therein.

33. Further in response to paragraph 17 of the Counterstatement, I do not agree with the contentions of the Applicant. I aver that the Opponent has prior registration of the Opponent's [REDACTED] trademark and that the Applicant's opposed trademarks are confusingly similar to the Opponent's [REDACTED] trademark. Thus, the Applicant's contentions have no bearing on this opposition proceeding.

34. Unless otherwise admitted herein, every allegation in the said Counterstatement is denied.

35. Finally, I have been advised by the Opponent's trademark agents that the burden of showing that the trademark is registrable falls squarely on the Applicant. The Opponent merely has to present the case and facts in support of the Opposition. In this case, the Opponent has gone beyond that to show that distinctiveness of their trademark and the close similarity between their trademark and that of the Applicant in this case. It is thus clear that the Opposition has merits and I pray that the Learned Registrar allow this Opposition with cost.

AND I MAKE this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declaration Act 1960.

SUBSCRIBED AND SOLEMNLY DECLARED

By the aforesaid [REDACTED]

This 4th day of April 2024

[REDACTED]
Before me,

NOTARY PUBLIC

Service Requirement

9.3.13 Upon filing of the statutory declaration in support of opposition, the opponent shall serve a copy of the same to the applicant at the same time. Within 14 days of the filing date, the Opponent have to file affidavit of service with the registrar by exhibiting the proof of delivery by the applicant. (Refer to Chapter 9.9.2 for evidence of successful service of documents)

9.3.14 If no statutory declaration and/or affidavit of service is filed in time, the opposition is deemed withdrawn, and the application will proceed to registration.

Filing of Evidence in Support of Application [Reg. 26]

9.3.15 The applicant shall then file evidence in support of application within 2 months from the date of receipt of c statutory declaration in support of opposition from the opponent. An extension of time may be granted for a maximum period of 6 months.

Content Requirement

9.3.16 Such evidence shall be submitted by way of a statutory declaration, certifying that the facts and evidence in the statutory declaration are true (Sec. 64).

Service Requirement

9.3.17 Upon filing of the statutory declaration in support of application, the applicant shall serve a copy of the same to the opponent at the same time. Within 14 days of the filing date, the applicant has to file affidavit of service with the registrar by exhibiting the proof of delivery by the opponent. (Refer to Part 9.9.2 for evidence of successful service of documents)

9.3.18 If no statutory declaration and/or affidavit of service is filed in time, the application is deemed withdrawn to the extent of the contested classes.

Filing of Evidence in reply by Opponent [Reg. 27]

9.3.19 The opponent may file evidence in reply (EVIR) within 2 months from the date of receipt of evidence in support of application, submitted via statutory declaration. An extension of time may be granted for a maximum period of 6 months.

Content Requirement

9.3.20 The opponent's evidence in reply must be strictly limited to the matters raised in the applicant's statutory declaration. Any new grounds or evidence introduced in the opponent's reply will not be considered by the Registrar during the examination of the case.

Service Requirement

9.3.21 Upon filing of the evidence in reply, the opponent shall serve a copy of the same to the applicant at the same time. (Refer to Chapter 9.9.2 for evidence of successful service of documents)

9.3.22 Optional Filing: Filing evidence in reply is optional, and there is no requirement under the TMA 2019 to submit an affidavit of service. However, it is advisable for the Opponent to file the affidavit of service as proof of delivery of the evidence in reply, in case an EVIR is filed. If the opponent chooses not to file evidence in reply, they may notify the Registrar of their decision and request the Registrar to issue a letter requesting both parties to file their respective written submissions.

Filing of Further of Evidence [Reg. 28]

9.3.23 No further evidence may be filed by the opponent or applicant unless with the leave of the Registrar.

9.3.24 A party seeking leave must outline the nature of the evidence, its availability, the issue it addresses, and the reasons for the delay in filing. When deciding whether to grant leave, the Registrar will consider whether the additional evidence is necessary for a fair determination of the case.

9.3.25 Where leave is granted, the Registrar may impose a time limit and determine the right of reply. The filing of further evidence reopens the case, allowing the other party an opportunity to respond to the new evidence.

Filing of Written submissions [Reg. 30]

9.3.26 Once the exchange of evidence is complete, the Registrar shall issue a notice to both the opponent and the applicant, requiring them to submit their written submissions within 2 months from the date of the notice. An extension of time may be granted for a maximum period of 6 months. This is not compulsory, and there is no requirement to submit an affidavit of service. This is subject to extension of time.

Registrar's Decision [Reg. 33]

9.3.27 The Registrar shall consider all the evidence, exhibits and any written submissions from both parties and then communicate the grounds of decision in writing to the parties of the opposition proceedings.

Costs awarded by Registrar [Sec. 158]

9.3.28 The Registrar's grounds of decision will include an award of costs as specified in the Sixth Schedule of the Guidelines of Trademark. The awarded costs are not intended to fully compensate either party for all expenses incurred but are instead assessed based on the prescribed scale.

9.3.29 If a party fails to pay the costs awarded by the Registrar, the amount may be recovered as a debt through a court of competent jurisdiction.

Withdrawal of Opposition

9.3.30 At any stage of the opposition proceeding prior to the issuance of grounds of decision by the Registrar, the opponent may withdraw the opposition submitting a written notice to the Registrar.

9.3.31 For the procedures to withdraw a trademark application, please refer to Chapter 17 Others Topics - Withdrawal and Deferment.

9.4 Appeal to Court

Right to Appeal

9.4.1 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.

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

Further Material and Grounds During Appeal

9.4.3 The parties may present further material during the appeal, for the Court's consideration either in the prescribed manner or with the special leave of the Court. However, no new grounds of opposition may be raised by the opponent beyond those stated in the original opposition, unless leave of the Court is obtained.

Role of the Registrar in Appeal Proceedings

9.4.4 It is also important to note that the Registrar is not required to be named as a party to the appeal, but retains the right to appear and be heard in the proceedings (Reg 140(1)). However, the Registrar may be named as an interested party, depending on the circumstances of the case.

Notification and Compliance by the Registrar

9.4.5 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 amend the status of the trademark application as deemed appropriate.

9.4.6 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 may be published in the Intellectual Property Official Journal.

9.5 Admissibility of Evidence

Evidence from Malaysia and Foreign Jurisdiction

9.5.1 Parties to an opposition must submit evidence by way of statutory declarations in accordance with the Statutory Declarations Act 1960.

9.5.2 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 officer empowered to administer oaths for legal proceedings.

Genuineness of Statutory Declarations

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

Limitations on Evidence Submitted

9.5.4 The examination of evidence in opposition 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.

9.5.5 This ensures that all evidence provided is in a legally recognized form. Any evidence provided within the notice of opposition, counterstatement, or written submissions, regardless of its content, will not be considered during the examination process.

Unsworn Evidence

9.5.6 If a party fails to submit evidence via sworn statutory declaration within the stipulated time and all available extensions of time have been exhausted, the Registrar may, at their discretion:

- (a) require the party to file a statutory declaration explaining the delay; and
- (b) grant a final 1-month EOT, to allow submission of the sworn statutory declaration; and
- (c) require the party to first submit an un-sworn statutory declaration, with the sworn version to be filed within the final EOT period.

9.5.7 Failure to file the sworn evidence (SD) within the final EOT period will result in the application or opposition being deemed withdrawn.

Evidence in Languages Other Than English or Bahasa Malaysia

9.5.8 If a declaration is made in English by a person whose native language is not English, the declarant should include a statement confirming that they have a reasonable understanding of English.

9.5.9 If a declaration is made in a language other than English or Bahasa Malaysia, the party filing the evidence must submit a certified translation, with a copy of the original declaration attached to the certification.

Amendment of Documents (Sec.152)

9.5.10 The Registrar has the discretion to allow amendments to documents filed during opposition proceedings, such as the notice of opposition (TMB5B), counterstatement (TMB5C), statutory declarations, written submissions, or any other documents deemed appropriate (TMB5D).

9.5.11 A request must be submitted in the prescribed form together with the applicable fee. The application must also be accompanied by a copy of the amended document with the proposed changes clearly marked in red (Paragraph 60 of the Guidelines of Trademarks).

9.5.12 The Registrar may impose terms, including costs, and will not permit amendments that substantially affect the substance of documents already filed. If the amendment is allowed, the party must serve the amended copy on the other side. The other party will then have 2 months from the date of service of the amended document to respond.

9.6 Evaluation of Evidence

Burden of Proof

9.6.1 In opposition proceedings, the burden of proof primarily falls on the applicant to establish that their mark is eligible for registration. If the opponent claims that the applicant's mark bears a deceptive resemblance to their own, they do not need to prove actual public confusion or deception. Instead, the applicant must show that confusion or deception is unlikely.

9.6.2 Additionally, the opponent must substantiate their objections with relevant evidence, such as prior use, reputation, or similarities that could mislead consumers. However, once a prima facie case is established, the onus shifts to the applicant to rebut the claims and justify the registrability of their mark.

Evidence of Use in the Course of Trade

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

- (i) List of Goods with Mark: A detailed list of the goods or services on which the mark has been used. This should specify the precise products or services that carry the mark and align with the goods specified in the application.
- (ii) 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.

- (iii) 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, highlighting the efforts made to make the mark known in the market.
- (iv) Exhibits Showing Actual Use: Submit clear, dated examples of the mark's use on the goods themselves, including product packaging, labels, tags, or point-of-sale materials. Additionally, provide advertisements, brochures, and any marketing materials where the mark is featured.
- (v) 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 market.
- (vi) Mark's History: Provide a brief history of the mark, including when it was first adopted, when it was first used in Malaysia, and any relevant milestones that demonstrate its continuity in the marketplace.
- (vii) 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.

Examination of Evidence

9.6.4 The examination of evidence in opposition proceedings will be based on the evidence submitted in the statutory declaration or any other accepted form. The following considerations will guide the evaluation:

(i) Consistency with Application:

- The goods and services listed in the application must align with the evidence provided.

(ii) Mark Comparison

- The mark applied for should be compared with the mark shown in the submitted evidence. If the mark in the evidence differs in any essential aspect from the applied mark, the evidence may be disregarded.

(iii) Use Prior to Application

- Only use that occurred prior to the application date will be considered as establishing evidence. Any use after the application date may be considered as persuasive evidence, but it will not carry the same weight as prior use.

(iv) Volume of Sales, Advertising, and Market Area

- The volume of sales, advertising expenditure, and the geographical reach of these activities are key factors in assessing the mark's strength. The more extensive and consistent the use, the stronger the case for the mark's recognition in the marketplace.

(v) Market Share and Growth

- Evidence demonstrating the maintenance or growth of market share over a period of time (typically five years) is important. This shows the mark's ongoing presence and reputation in the market, strengthening the evidence of use.

9.6.5 The Registrar will assess whether the evidence establishes the mark's distinctiveness and reputation in relation to the goods or services claimed. Any evidence not meeting the required standards or failing to support the claims will be disregarded.

Example - The mark has been used on bread, cakes and biscuits, a specification of 'flour confectionery' would be perfectly acceptable.

9.7 IRDM Opposition – procedure

Submission of the Notice of Opposition

9.7.1 The opposition period for IRDM is 2 months from the date of publication, similar to the opposition period for a national trademark application. The Opponent must submit the notice of opposition (NOP) together with the grounds of opposition and the prescribed fee using Form TMD1.

9.7.2 Once the Registrar receives the NOP together with the grounds of opposition, the Registrar will submit the documents to the International Bureau (IB). When IB received the documents, IB will send the documents to the holder.

Time limit for sending Counterstatement

9.7.3 Once the holder receives the documents, the holder has 2 months to submit the counterstatement to MyIPO together with the Form TMD6. The counterstatement must set out the grounds on which the holder relies in support of his application, and also any facts in the notice of opposition, which the holder admits. If the counterstatement is not filed within the prescribed period, the application shall be deemed withdrawn in accordance with Section 35(4) of the Trade Marks Act 2019.

9.7.4 The date when the holder received the documents will be the starting date of the calculation of the two months' time. The holder is also required to appoint a registered trademark agent to submit the counterstatement on their behalf.

IRDM Opposition Procedures After Counterstatement

9.7.5 When the holder, through a registered trademark agent in Malaysia, has submitted the counterstatement, the holder must also file an affidavit of service. At this stage, the opposition proceedings will proceed in the same manner as an opposition to a national trademark application. Refer to the opposition procedure outlined in Part 9.3.

IRDM Opposition – Decision of the opposition

9.7.6 Once the Registrar had made the decision in the opposition proceeding, the aggrieved parties may file an appeal to the Court within 1 month from the date of the opposition decision. An extension of time to appeal may be granted for a maximum period of 2 months.

9.7.7 If the parties did not file any appeal to the Court, the Registrar will notify the IB as follows:

- (a) Confirmation of Total Provisional Refusal – if the opposition decision is in favour of the opponent.
- (b) Statement of Grant of Protection - if the opposition decision is in favour of the holder.

9.7.8 For further details on the procedure to appeal to the Court, please refer to Part 9.4.

IRDM Opposition - Withdrawal of Opposition

9.7.9 If the Opponent wishes to withdraw the opposition for an IRDM files, a formal letter stating the intention to withdraw must be submitted to the Registrar.

9.7.10 Once the Registrar has updated the status of the IRDM file accordingly, the Registrar will issue a Statement of Grant of Protection Following a Provisional Refusal to the International Bureau - (Rule 18ter (2) of The Common Regulations).

9.8 Amendment of Application for files ‘Under Opposition’

Amendment of Goods/Services for National Trademark Applications

9.8.1 If the national TM application is already under the status of ‘Under Opposition’, the applicant must do the following actions before the Formality Officer can process the amendment request:

(a) Obtain a consent from the Opposition Section:

- The proposed amendment of the goods is approved by the Opposition Officer

(b) The applicant is required to email the Opposition Officer a letter from the Opponent stating that the Opponent agrees not to proceed with the opposition proceeding if the amendment to the goods is made.

Amendment of Goods/Services for IRDM

9.8.2 The holder is required to submit the limitation of goods to the International Bureau (IB) in order to update the list of goods for Malaysia. Once the IB has recorded the amendment of the goods, the IB will notify Malaysia of the changes. Thereafter, upon receipt of a formal letter from the Opponent withdrawing the opposition proceedings, a notification of registration for the trademark will be issued.

9.9 Filing & Serving of Opposition Documents

9.9.1 When the Opponent or the Applicant files any opposition documents with the Registrar, they are also required to serve a copy of the documents to the other party in the opposition proceeding. The person who sends the document must obtain some evidence to show that the documents have been successfully served to the other party.

Evidence of Successful Service of Documents

9.9.2 The following are acceptable forms of evidence to prove that the documents were successfully served to the intended party:

- (a) An acknowledgement signature and/company stamp (chop) of the intended party;
- (b) A delivery receipt from a courier company
- (c) An acknowledgement email from the intended party, if the documents were served via email

9.9.3 Please refer to Part 9.10.1 for an example of acknowledgement from the other party.

Problem in Serving the Documents

9.9.4 in some cases, the Applicant or Opponent may refuse to accept the opposition documents, or there was no person available at the recorded address to receive the opposition documents. In such situations, the party attempting service must make at least 2 attempts to deliver the documents.

If the problem still persists, the applicant/opponent must inform the Registrar and submit a statutory declaration explaining the situation. The declaration must include supporting evidence demonstrating the unsuccessful attempts to serve the documents.

9.9.5 Upon receiving the statutory declaration, the Registrar will evaluate the contents and evidence stated in the statutory declaration. If the Registrar is satisfied that reasonable efforts have been made to serve the documents, the documents will be deemed as properly served by the party.

9.10 Service of Documents (Affidavit for Service)

9.10.1 Affidavit for Service (AOS) is a mandatory document that must be filed with the Registrar. The AOS must be submitted in the form of a statutory declaration, and it must include evidence showing that the documents were received and acknowledged by the other party. Example of Affidavit for Service are as shown as follows:

Example of Affidavit for Service (for reference only)

TRADEMARKS ACT 2019
TRADEMARK REGULATIONS 2019

IN THE MATTER of Trademark Application,

No. TM: [REDACTED] for "[REDACTED]" in Class

03 in the name of [REDACTED]

whose address for service is at [REDACTED]

[REDACTED]

(Hereinafter referred to as "the Applicant").

AFFIDAVIT OF SERVICE

I, [REDACTED] (NRIC [REDACTED]), a citizen of Malaysia, of full age, addressed at

[REDACTED]

SELANGOR, MALAYSIA hereby solemnly and sincerely declare as follows: -

1. I am authorized to swear to this Affidavit of Service for the Statutory Declaration filed on **7th January 2025** on behalf of the Applicant for the trademark Application No. [REDACTED] TM "[REDACTED]" (hereinafter referred to as "the Applicant's mark"). The facts deposed to herein are within my personal knowledge and/or from the relevant records and documents of the Opponent to which I have been provided with, save where the contrary appears.

2. I hereby confirm to have completed the following action: -

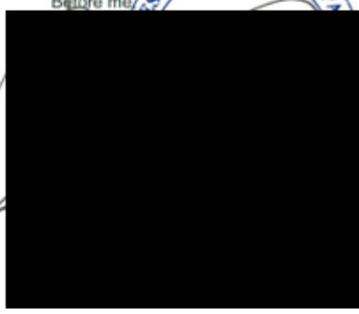
- To have uploaded the copy of the Statutory Declaration on MYIPO on the 7th of January 2025. Attached herewith marked as Annex "A" is the proof of submission.
- To have served by hand a copy of the Statutory Declaration on the 7th January 2025 to the Opponent's representative and/or agent. Attached herewith marked as **Annex**

"B" a copy of the acknowledgement of receipt of the hard copy by the Opponent's representative.

Thank you for your kind attention in this matter. We await the Registrar's favourable reply.

And we make this solemn declaration conscientiously believing the same to be true and in accordance with the Statutory Declaration Act 1960.

Solemnly declared by)
the above named)
at PETALING JAYA)
this 13 JAN 2025)

Before me 




Important to get
Acknowledgement
Chop and
Received Date





patent, trademark, industrial design, copyrights,
licensing, franchising, commercialization.

Our Ref: 
Your Ref: 





Acknowledgement Copy

6th January 2025

Dear Sir/Madam,

STATUTORY DECLARATION IN RESPONSE TO THE NOTICE OF OPPOSITION FOR TRADEMARK 

APPLICATION NO.  IN CLASS 03.

We refer to the above matter.

In addition, please find our Statutory Declaration in response to the notice of opposition.

Separately, a copy of this notice will be sent to the representative of the opponent.

Kindly note the address for the other party's representative is as below:



We look forward to receiving a favourable response from your side.

Thank you.

Kind Regards,



9.11 Modes of Serving Opposition Documents

9.11.1 There are several modes available for serving opposition documents. The mode of serving should be determined by the parties themselves. Some of the commonly accepted modes of service include:

- a. By hand delivery
- b. By courier service
- c. By AR registered post
- d. By fax
- e. By email (with acknowledgment of receipt)

9.11.2 In some cases, a party may request to be served by physical copies only and may refuse to accept service by any other means. In such circumstances, the Registrar will take into account the date on which the physical copies were received by the party as the official 'date of receipt'.

9.11.3 Parties involved in an opposition proceeding are encouraged to serve the opposition documents via email first, followed by delivery of the physical copies by hand, courier, or registered post. The serving party must ensure that they receive an acknowledgement notice from the receiving party confirming receipt of the opposition documents. Please refer to Part 9.10.1 for an example of acknowledgement from the other party.

9.12 Extension of Time for Opposition

9.12.1 Each stage of opposition proceedings is subject to the possibility of an extension of time. A party may request an extension at any stage by submitting a formal request to the Registrar, using Form TMK1 and TMK2 together with the prescribed fee.

Maximum Extension Periods

9.12.2 Except for the notice of opposition, which allows for a maximum extension of 2 months, all other stages namely, the counterstatement, statutory declarations, and written submissions, are eligible for a maximum extension of 6 months at each stage.

9.12.3 Parties are not required to request the full 6-month period and may apply for a shorter duration based on their needs.

No Extension of Time for Affidavit of Service

9.12.4 It is important to note that no extension of time is allowed for the filing of the affidavit of service.

Deferment After Exhausting Extension of Time

9.12.5 Once the maximum extension of time has been utilized, a party may request a deferment if additional time is required, provided that the request falls within the circumstances permitted for deferment.

9.12.6 Deferment is only available from the counterstatement stage onwards, as opposition proceedings are considered to have commenced only upon the filing of the notice of opposition.

9.13 Deferment of Opposition

Duration and Extension of Deferment - [Reg 35]

9.13.1 The applicant or opponent may request a deferment of opposition proceedings at any stage of opposition process by submitting a formal request to the Registrar, along with Form TMP2 and the prescribed fee.

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

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

9.13.4 Additionally, the deferment period requested does not have to be for the full 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 accordingly.

Circumstances for Deferment of Opposition Proceedings

9.13.5 The Registrar may grant deferment of opposition proceedings under the following circumstances:

- (a) both the opponent and applicant are parties to ongoing Court proceedings in Malaysia.
- (b) 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.

9.13.6 Where deferment is requested due to settlement discussions, the requesting party must provide supporting documents, such as written consent from the other party for the deferment application or a draft settlement agreement. Any confidential or privileged information in the draft settlement agreement may be redacted before submission.

9.14 IRDM – Function of Madrid Monitor

9.14.1 Madrid Monitor is a website provided by WIPO that contain all the details of the international registrations under the Madrid Protocol. Each IRDM have an International Registration Number (IRN). IRN are shown in the page of the MyIPO Record. For example, as follows:

Bibliographical Data				Activities	Discussion(s)	History	Document(s)	Examination	Payment(s)
- Case Data									
Status	Published	Submission Date	30 Mar 2023						
Application Number	[REDACTED]	Filed/Designation Date	12 Jan 2023						
International Registration Number	[REDACTED] Madrid Monitor details	Publication Date	23 Nov 2023						
Application Type	International Registration Designation	Registered/Protected on	N/A						
Journal Name	42_2023	Date of Abandonment	N/A						
		Date of Certificate Issued	N/A						
		International Registration Date	12 Jan 2023						

9.14.2 If the link below the IRN is clicked, it will directly lead to the IRDM record in the WIPO Madrid Monitor, as shown below:

Current Search

[REDACTED]

image search [icon] download [icon] monitor [icon]

1 - 1 / 1 Display: 30 per page options [icon]

Trademark	Image	Status	Or	Holder	Req. No	Req. Date	Nice Cl.	Vienna Cl.
[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	2023-01-12	23, 24	05.03, 05.07, 27.03, 27.05

1 - 1 / 1 [icon] 1 / 1 [icon]

9.14.3 If the trademark link is clicked, the page will display the full details of the IRDM, as shown below:

Active

	Registration Date	Expiration Date	Nice
	12.01.2023	12.01.2033	23, 24

Summary

Designation Status

Real-time Status

732 Name and address of the holder of the registration

English

Multilingual

811 Contracting State of which the holder is a national
SG

842 Legal nature of the holder (legal entity) and State, and, where applicable, territory within that State where the legal entity is organized
Private Limited Company, SINGAPORE

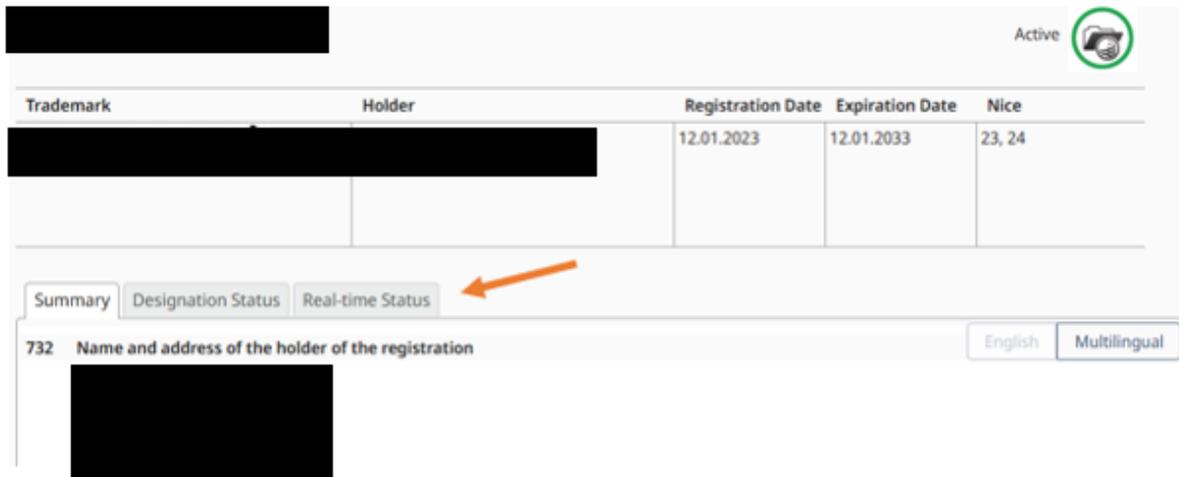
740 Name and address of the representative

531 International Classification of the Figurative Elements of Marks (Vienna Classification) - VCL(9)
05.03.13 ; 05.07.23 ; 27.03.11 ; 27.05.01

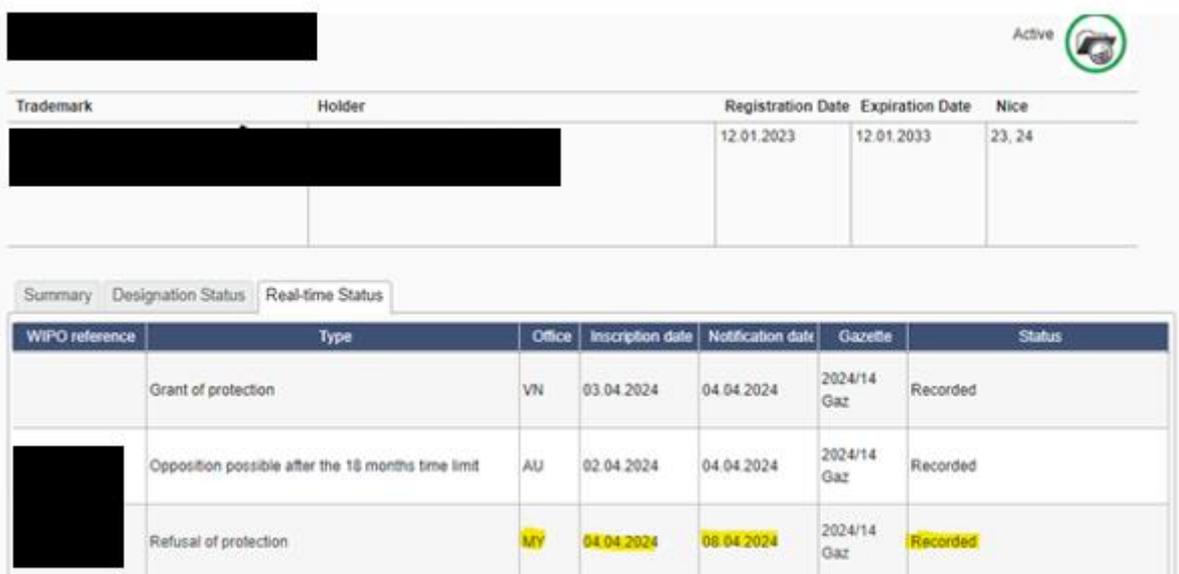
511 International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) - NCL(12-2023)

23 Carded yarns of hemp for textile use; carded yarns in natural fibres for textile use; carded threads in natural fibres for textile use; chemical fiber base mixed thread and yarn; chemical-fiber threads and yarns for textile use; coil thread and yarn; combed yarns made of natural fibres; cotton thread and yarn; elastic thread and yarn for textile use; heat-stable yarns and threads; hemp thread and yarn; jute thread and yarn; linen thread and yarn; mixed spun threads and yarns; natural yarns;

9.14.4 If the Opponent wishes to check whether the IB has sent the Notice of Opposition to the Holder, this can be verified via Madrid Monitor by clicking on the “Real-time Status” tab.



9.14.5 Based on Madrid Monitor, MyIPO’s letter was reviewed by the IB (Inscription Date) on 4 April 2024, and the IB sent the notification of opposition to the Holder on 8 April 2024 (Notification Date). Below is the screenshot from the Madrid Monitor showing the details:



9.14.6 In the example (highlighted in yellow), the deadline for the Holder to submit the counterstatement is 2 months from 8 April 2024 (8 April 2024 to 8 June 2024).

9.15 Task Due Date Management

9.15.1 Opposition documents can be submitted online in accordance with the Practice Direction No. 1-2024. The opponent or applicant may request that the actual date of receipt of opposition documents be recorded under the following circumstances:

- (a) The opponent or applicant received any form or documents stated in paragraph 3(1)(a), 3(1)(b), 3(1)(c), 3(1)(d) or 3(1)(e) later than the filing date recorded in the Electronic Filing System (EFS);
- (b) The opponent or applicant shall provide the evidence of acknowledgement of receipt of the documents, to the satisfaction of the Registrar; and
- (c) The request is sent to the Registrar via email at sphioppo@myipo.gov.my.

9.15.2 If the Registrar is satisfied with the request, the Registrar shall record the actual date of receipt of the documents. The due date for filing any form or document in the opposition proceeding will then be calculated from the recorded date of receipt.

Scenario (1)

The opponent filed the notice of opposition together with the grounds of opposition to the Registrar on 20 March 2024. The Opponent chose to send the notice of opposition together with the grounds of opposition to the applicant on 20 March 2024 via registered postal service.

The applicant received the copy of the notice of opposition together with the grounds of opposition on 25 March 2024. In this case, the applicant may send an email to the Registrar at sphioppo@myipo.gov.my requesting that the due date for filing the counterstatement be calculated within 2 months from 25 March 2024 instead of from 20 March 2024.

Scenario (2)

The opponent filed the notice of opposition together with the grounds of opposition to the Registrar on 20 March 2024. The Opponent chose to send the notice of opposition together with the grounds of opposition to the applicant on 20 March 2024 via registered postal service.

The applicant received the copy of the notice of opposition together with the grounds of opposition on 25 March 2024. However, the applicant did not inform the Registrar of the actual date of receipt by emailing sphioppo@myipo.gov.my. In this case, the due date for filing the counterstatement will be calculated as 2 months from 20 March 2024, regardless of the later date of receipt.

9.16 Division for Opposition Files

Division of a trademark application that is already under the status of “Under Opposition” is only permitted in the following two situations:

- (i) Before the applicant submit the counterstatement; or
- (ii) After the opposition decision has been issued by the Opposition Officer, but before either party (applicant or opponent) files an appeal to the Court.

9.16.1 Division for National Trademark Applications “Under Opposition”

The applicant must apply for division before submitting the counterstatement. Once the division is approved by the Formality Section, and a new application number is issued for the class(es) that have been opposed, the Applicant must then submit the counterstatement using the new division number.

Since approval of the division may take time, if the Applicant anticipates that the deadline for filing the counterstatement is approaching, an extension of time should be requested. The original application number will only retain the class(es) not opposed and may proceed directly to registration.

9.16.2 Division for IRDM “Under Opposition”

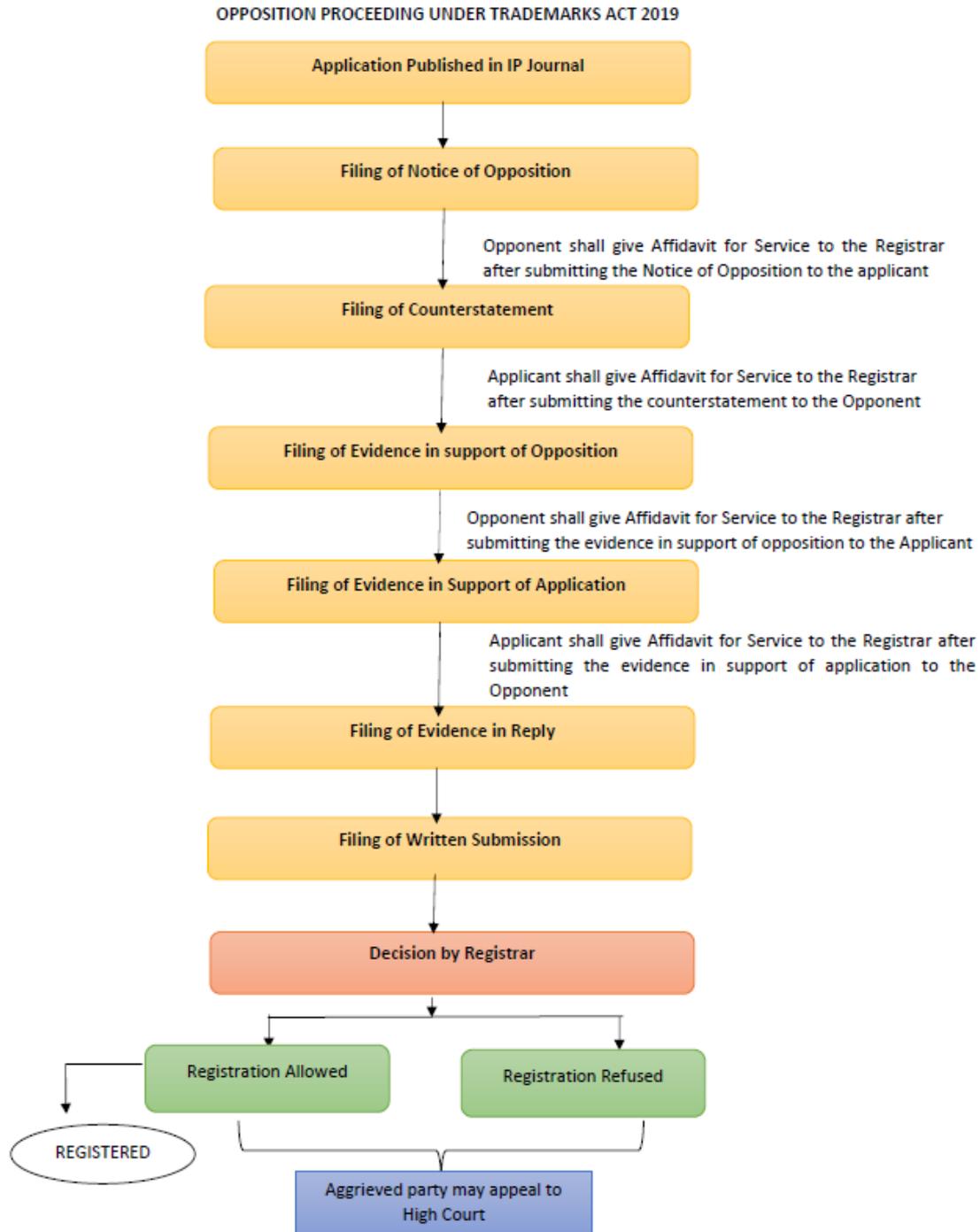
For IRDM application, the holder will receive a notification from the International Bureau (IB) informing them that their trademark is being opposed in Malaysia. The holder must submit the counterstatement to MyIPO within 2 months from the notification date issued by the IB.

If the holder intends to divide the IRDM application, the request for division must be submitted before filing the counterstatement. The holder must first submit the application for division to the MyIPO Madrid Unit, which will then forward the request to the International Bureau (IB).

Once the IB has processed the division, it will assign a new international application number for the class(es) that have been divided. The holder must then use this new number to submit the counterstatement to MyIPO.

Since the process of obtaining a new number from the IB may take time, the holder is advised to apply for an extension of time to file the counterstatement if the deadline is approaching. The original application number will only cover class(es) not opposed, and therefore, may proceed for registration.

9.17 Flowchart for Opposition Proceeding



9.18 Grounds of Opposition

9.18.1 Pursuant to the Trademarks Act 2019, an opposition may be filed against a trademark application on various statutory grounds. An opponent may rely on the following grounds in support of their opposition:

- Absolute grounds for refusal under Section 23 of the Act;
- Relative grounds for refusal under Section 24 of the Act, including passing off;
- That the applicant is not the rightful proprietor of the trademark (Section 34(2)(b));
- That the trademark is identical or similar to a well-known mark in Malaysia (Section 34(2)(c));
- Other grounds under Section 24(6), including:
 - (i) Copyright infringement;
 - (ii) Conflict with earlier industrial design rights.

9.18.2 Detailed discussions on the absolute and relative grounds of opposition are provided in Chapter 5 (Distinctiveness), Chapter 6 (Distinctiveness on non-traditional trademarks) and Chapter 7 (Conflicts with prior registered rights). This Part will specifically address the grounds of Passing Off, Copyright, Industrial Design and Well-Known Trademarks.

Grounds of Opposition Based on Passing Off

9.18.3 Passing off is a common law concept. It refers to the misrepresentation of the goods or services one is offering as coming from another party. This false impression is created through use of another provider's recognizable trademark, either by the production of an identical copy, or a closely comparable mark.

9.18.4 The charge of passing off differs from statutory trademark infringement in that it is not governed by legislation, but rather enforced through common law, based on judicial precedent and case law principles.

9.18.5 Passing off law exists as a tort, which may be dealt with by the bringing of a civil suit. Under the grounds of passing off, there are three elements that need to be established (refer to the case of *Reckitt & Coleman v. Borden*):

- (i) Goodwill;
- (ii) Misrepresentation; and
- (iii) Damage

Goodwill

9.18.6 In the case of *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited*, it was stated that “goodwill” is:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or sources.”

9.18.7 Goodwill represents the link between the business and customer, while reputation is a matter of fact and does not require there to be a business in the country. It should be noted that, passing off will always protect claimant’s goodwill, however, will not always protect claimant’s reputation (*Harrods v. Harrodian School*).

9.18.8 Section 24(4)(a) of the Act at the very least requires an opponent to adduce sufficient evidence to establish a prima facie case on goodwill, misrepresentation and damage. The case of *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* can be a guidance on how to interpret Section 24(4)(a) since this case had clarified Section 8(7)(a) of the Singapore Trademarks Act (which is equivalent to Section 24(4)(a) of the Malaysia Trademarks Act 2019):

“[164] Having considered the statutory language of s 8(7)(a) of the TMA and the limited authorities on the

matter, I am of the view that s 8(7)(a) of the TMA at the very least requires an opponent to adduce sufficient evidence to establish a prima facie case on goodwill, misrepresentation, and damage...”

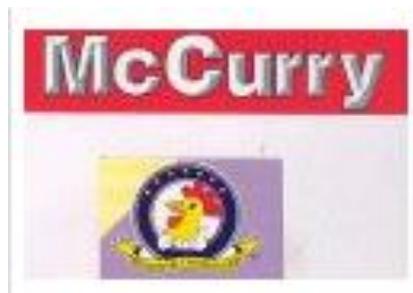
Singapore’s Case: Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd [2015] SGHC 216	
Opponent’s Marks – Class 30	Applicant’s Marks – Class 30
<p>T1111886Z</p> <p>“Red Bird Mark”</p> 	<p>T1204840G</p> <p>“Angry Bite Mark”</p> 
<p>T1113897F</p> <p>“Angry Birds Word Mark”</p> <p>ANGRY BIRDS</p>	

9.18.9 It is important to note that the Opponents must establish that they have acquired goodwill as at the relevant date and this date is the date on which the defendant's conduct complained of started.

Misrepresentation

9.18.10 The Malaysian case in the Court of Appeal of McCurry Restaurant v. MacDonalds Corp can offer guidance on the interpretation of 'misrepresentation' in Malaysia. In this case, Plaintiff was a multi-outlet fast food operator. Defendant was a single outlet Indian food operator. The Court decided that the Plaintiff and the Defendant were dissimilar in get up & style, menu, food type, customer type. Thus, the judge Gopal Sri Ram JCA held that no reasonable person would associate the Defendant with the Plaintiff. Accordingly, at the suit of Plaintiff, the court held that there was no passing off by Defendant.

TM No: 99001355



Class: 43

Specification of Services: Restaurant and catering services; all included in Class 43.

9.18.11 Guidance in relation to this element can also be found in the Singapore’s Court of Appeal case of the Sarika Connoisseur Café Pte Ltd v Ferrero SpA [2012] SGCA 56. In this case, it was held that:

“(20) ...the findings for the misrepresentation requirement were in turn based on the finding of a likelihood of confusion under s 27(2)(b) TMA...”

Singapore Case Court of Appeal: Sarika Connoisseur Café Pte Ltd v Ferrero SpA Opponent’s Marks			
No	Trade Mark No	Trade mark	Specifications
1	T73/59592H: (registered on 16 August 1973)	NUTELLA	Confectionery, baking powder, chocolate products, cream comprising cocoa with or without other ingredients.
2	T82/01892B (registered on 16 April 1982)		Chocolate cream spread.
3	T04/09636H (registered on 15 June 2004)	 	Pastry and confectionery, chocolate candies, chocolate biscuits, chocolate bars, chocolate spreads and ice creams.

Applicant's Mark

No	Menu	Representation
1	2009 Drinks Gallery menu	
2	Booklet	
3	Website	 Nutello

Damages

9.18.12 If the Opposition officer finds that the elements of goodwill and misrepresentation are established, only then will the 3rd element damages will be assessed. Case law provides several examples of how damages may be proven.

(i) Mere drop in sales is not proof of damage

Case: JS Staedtler v. Lee



TM No: MB051889

Class: 16

Specification of the Goods:

Wood - cased pencils fountain pens, ball - points pens, pencil leads, stationery, paper and paper articles, cardboard and cardboard articles and printed matter; all included in Class 16.

The trade mark was registered on 20 May 1969 under the repealed Trade Marks Ordinance 1950 in clause 16 in respect of wood cased pencils, fountain pens, ball point pens, pencil leads, stationery, etc. The trade mark was registered in Part B Registration under section 11 of the Trade Marks Ordinance 1950.

Facts of the case: Plaintiff was registered proprietor of TM (comprising yellow and black colour strips with Staedtler 120-2B) for pencil. Defendant launched Nikki 120-2B pencil with similar (but not identical) colour combination. Defendant's product compared with Plaintiff's registered mark resembles Plaintiff's mark in essential features (the colour stripes, not the brand names or 120-2B). Students buy this product and the value of the product is very small, so that the risk of confusion is higher.

Held: Accordingly, it was an infringement (section 38(1) TMA). But it was not passing off as Plaintiff failed to prove resultant damage. A mere drop in sales for Plaintiff is not proof of resultant damage.

(ii) Same trade – likelihood of damage will be presumed

Case: Sykt Zamani Tamin v. Yong Sze Fun

TM No: 90006139



Class: 32

Specification of the Goods: Syrups, cordial fruit juice, flavour concentrate, soft drinks and other non-alcoholic drinks; all included in Class 32.

Facts of the case: Plaintiff was selling Tamin syrups. Defendant then launched Tamin sauces. It is no defence for Defendant to say Plaintiff mark not registered, as passing off action is preserved in TMA (section 82(2)).

Held: As parties were in same trade (food industry), likelihood of damage (widely interpreted) will be presumed.

(iii) No commercial activity – no damage

In the case of *Day v. Brownrigg* (1878) 10 Ch. D 294, the Plaintiff lived in a house that he called Ashford Lodge. The Defendant lived in a smaller house that was called Ashford Villa. The Defendant changed the name of his residence & house and called it Ashford Lodge. The Plaintiff was unhappy about this and he sued for an injunction to prohibit the Defendant from calling his house as Ashford Lodge. Plaintiff also sued Defendant for passing off. The parties had lived next door to each other for a long time and the Plaintiff had used the name Ashford Lodge for 60 years.

The Court held that there was no commercial activity involved and thus, there was no damage. There is no legal or equitable right to the exclusive use of the name of a private residence. Thus, the Plaintiff's action for passing off was summarily struck-off.

Grounds of Opposition Based on Industrial Design (Section 24(4) and (6))

9.18.13 In raising this ground, it is anticipated that the opponent would need to demonstrate sufficient evidence to support the claim of ownership and potential infringement of industrial design rights. Generally, the following elements may be relevant in establishing such a claim:

- That the opponent is the registered proprietor of a valid industrial design under the Industrial Designs Act 1996
- That the industrial design is valid and subsisting at the time the opposition is filed (i.e., not expired or lapsed)
- That the applied trademark is identical with or similar to the opponent's registered design
- That the use or registration of the applied mark is likely to cause confusion among the purchasing public.

9.18.14 To support this ground, the Opponent was advised to submit sufficient documentary evidence. This may include a certified copy or official extract of the industrial design registration certificate and/or evidence of its renewal, representations of the registered industrial design, comparison of the design and the applied trademark, highlighting the similarity in visual features. Additionally, any other relevant supporting documentation demonstrating the use of the industrial design in the marketplace should be provided.

Grounds of Opposition Based on Copyright Section 24 (4) and (6)

9.18.15 In addition to industrial design rights, TMA 2019 also recognise copyright ownership as a possible ground of opposition. This provision, although relatively new and largely untested in opposition proceedings, provides an avenue for opponents to rely on their copyright to prevent the registration of a mark that copies or substantially reproduces their original works. Generally, the following elements may be relevant in establishing such a claim:

- That the material relied on is a work eligible for copyright protection under the Copyright Act 1987 (e.g., artistic works such as logos, graphic designs, or typographic arrangements, and other original visual creations);
- That the opponent is the rightful owner of the work;
- That the applied trademark is identical with or similar to the opponent's copyrighted work;
- That the use or registration of the applied mark is likely to cause confusion among the purchasing public or amount to an infringement of the opponent's copyright.

9.18.16 Opponents are advised to support their claims with sufficient documentary evidence such as copies of the original work, records of creation (e.g., dated sketches, drafts, or publications), and any relevant copyright registration or licensing documentation. Where possible, a legal opinion or expert report on the originality and ownership of the work may be submitted to strengthen the claim.

9.19 Well-known Mark Protection (Section 34(2)(c))

9.19.1 A trademark may be opposed if it is identical or similar to a well-known trademark in Malaysia, regardless of whether the goods or services are identical, similar, or unrelated.

9.19.2 Such protection extends even if the well-known trademark is not registered in Malaysia. It must be assessed whether the use of the applicant's mark would indicate a connection with the well-known mark, thereby causing confusion or damage to the interests of the proprietor (opponent) of the well-known mark.

9.19.3 The burden of proof under this ground rests entirely with the opponent OR (the party claiming its trademark's well-known status). To succeed in an opposition based on a well-known mark, the opponent must provide sufficient evidence to support their claim.

9.19.4 This opposition applies under the following conditions:

- (a) The opponent's trademark is well known in Malaysia at the relevant date;
- (b) The applicant's mark is identical or similar to the opponent's well-known mark;
- (c) The use of the applicant's mark is likely to cause confusion or suggest a connection with the opponent; and
- (d) Such use would likely damage the interests of the opponent.

9.20 Criteria of Well-known Mark

9.20.1 Criteria for Determining Well-Known Status was stated under Regulation 5 of Trademarks Regulations 2019. Whether a mark is well known is a question of fact. The Registrar will take into account the criteria of well-known trademarks under Regulation 5 of the Trademarks Regulations 2019, which include:

- (a) the extent of knowledge or recognition of the trademark in the relevant sector of the public;
- (b) the duration and extent, and geographical area of any use of the trademark;
- (c) the duration and extent of any promotion of the goods or services where the trademark applies and the geographical area where the promotion is carried out;
- (d) the duration and place of registration, or duration and place of application for registration, of the trademark, to the extent that they reflect use or recognition of the trademark;
- (e) The record of successful enforcement of rights in the trademark, in particular, the extent to which the trademark was recognized as well-known by competent authorities; and
- (f) the value associated with the trademark.

Guidance on Supporting Evidence for Each Criterion

9.20.2 Extent of Knowledge or Recognition:

- The opponent may provide evidence such as consumer surveys, market research, media coverage, or sales figures that demonstrate public awareness of the trademark in Malaysia.

9.20.3 Duration and Geographical Area of Use:

- Regarding the duration and geographical area of use, the opponent may submit invoices, sales records, or distribution contracts that show how long the mark has been in use and the areas in which it has been marketed or sold, particularly within Malaysia.

9.20.4 Promotion and Marketing:

- For promotion-related evidence, the opponent may provide advertising materials (e.g., TV advertisements, newspaper and magazine print advertisements, social media campaigns), records of participation in trade fairs or sponsored events, and documentation of the geographical extent of such promotions. It is important to also submit documentation showing the geographical extent of these promotional activities, especially within Malaysia.

9.20.5 Duration and Place of Registration:

- The opponent may submit trademark registration certificates, along with information about the filing date and jurisdiction. If international registrations are relied on, and those are under a different legal entity, the opponent should provide documents proving the relationship between the entities (e.g., parent-subsidiary relationship, licensing agreements).

9.20.6 Enforcement of Rights:

- In terms of successful enforcement of rights, the opponent may provide documentation of prior legal action, such as opposition proceedings, infringement lawsuits, or administrative decisions where the trademark was recognized as well known by competent authorities. This may include court judgments, settlement agreements, or tribunal decisions rendered in the opponent's favour.

9.20.7 Value of the Trademark:

- To establish the value associated with the trademark, the opponent may be able to provide financial documentation such as brand valuation reports, profit and loss statements, or expert opinions.