



## PRACTICE AREA Step-by-step CHECKLIST

### Trademark

. 1 .

#### File reference:

**DISCLAIMER** This Checklist is only intended to provide a general overview of the matters that should be considered in managing your case/transaction. The information provided in this Checklist is not intended to be legal advice. Many factors may affect the applicability of any steps or procedures set out here to your case and consequently you should apply your own discretion or seek appropriate advice (where applicable) before relying on these procedures.

	Yes	No	Remarks
<b>1. Applicant to file Form TM5 (Application for registration for a mark)</b>			
The checklist below is applicable to manual filing – some of the items in the checklist do not apply to online filing.			
a. Five copies of the completed TM5 with trademark affixed to each copy.			
b. One original copy of the Statutory Declaration (“SD”) with the trademark affixed to it.			
c. Trade mark size must <b>NOT</b> exceed 10 cm x 10 cm.			
d. One copy of Form 49/Form D/company detail from company registrar if the registration of trademark is made under company name. <b>Note: Whilst this is not practiced now, the Registrar may still request for such document.</b>			
e. One copy of priority date claim document if claiming priority from a corresponding application.  If the priority date claim document is not in English, a certified translation of the same is required.			
f. One copy of certified transliteration and translation if the trademark is in other than Roman character form, eg Chinese characters.  Certified translation if the trade mark is in a language other than English or Bahasa Malaysia. The language of the original trademark must also be stated.			



My notes...





	Yes	No	Remarks
g. Payment of prescribed fee for filing Form TM5 and Form TM1: <ul style="list-style-type: none"> <li>• Manual Filing – RM 415 per application made payable by cash/cheque/money order/bank draft to “Perbadanan Harta Intelek Malaysia”.</li> <li>• E-Filing – RM 370</li> </ul>			
Proceed to No 4 if application does not require Expedited Examination.			

## 2. Request for approval for Expedited Examination Form TM5A – within 4 months from application date

a.	A statutory declaration stating the reasons for requesting the Expedited Examination; and			
b.	Payment of prescribed fee;- <ul style="list-style-type: none"> <li>• Manual Filing Fees – RM250</li> <li>• E-Filing Fees – RM200</li> </ul>			
c.	Registrar will notify applicant of the Approval of Form TM5A.			

## 3. Applicant to file Form TM5B to request – for Expedited Examination application

a.	Must be filed within five working days from the date of receipt of the Registrar’s decision, ie No 2.			
b.	Payment of prescribed fee;- <ul style="list-style-type: none"> <li>• Manual Filing Fees – RM1,200</li> <li>• E-Filing Fees – RM1,060</li> </ul>			

## 4. Does application comply with the statutory requirement?

If yes, proceed to No 5.			
If no, ie application is rejected due to non-compliance with statutory requirement: <ul style="list-style-type: none"> <li>• Applicant has 12 months to comply with formality requirements. If the Registrar has issued a written notice specifying the non-completion and a time period for compliance then the time period must be complied with. The Applicant may seek an extension of time as set out under No 7 but approval will be at the Registrar’s discretion.</li> </ul>			





	Yes	No	Remarks
<b>5. Search and Examination must be done by MyIPO – within one month and two weeks</b>			
Examination on registrability and search for prior marks.			
If accepted, <u>proceed to No 6.</u>			
If rejected, <u>proceed to No 7.</u>			
<b>6. Request for advertisement of an accepted application in the Gazette</b>			
a. Applicant is required to file Form TM31 within one month for expedited applications and two months for normal applications from the date of Notification of Acceptance (TM31). The Applicant may seek an extension of time as set out under No 7.			
b. Payment of prescribed fee: <ul style="list-style-type: none"> <li>• Manual Filing Fees – RM650</li> <li>• E-Filing Fees – RM600</li> </ul>			
Any opposition from third party within two months from the date of publication of the trade mark in the Government Gazette?			
If yes, <u>proceed to No 9</u> – Opposition procedure inter-parte hearing.			
If no, <u>proceed to No 11.</u>			
<b>7. Written Appeal within two months from the date of receipt of Registrar’s objections</b>			
If accepted by the Registrar, <u>proceed to No 6.</u>			
If rejected by the Registrar, <u>proceed to No 8.</u>			
The Applicant may apply for an extension of time using Form TM27. <ul style="list-style-type: none"> <li>• Manual Filing Fee - Application for Extension of Time RM80</li> <li>• Manual Filing Fee – Per month charges – RM140</li> <li>• E-Filing Fee – Application for Extension of Time – RM70</li> <li>• E-Filing Fee – Per month charges – RM 130</li> </ul>			



My notes...





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<b>8. Ex-Parte Hearing to be applied for using Form TM9A – within two months from the date of receipt of the Registrar’s decision</b>			
If accepted by the Registrar, <u>proceed to No 6.</u>			
If rejected by the Registrar, <u>proceed to No 10.</u>			
The Applicant may apply for an extension of time as set out under number 7.			
<b>9. Opposition Procedure Inter-Parte</b>			
a. File Form TM7 [Notice of Opposition] within two months of the date of the Government Gazette in which the mark is published and at the same time send a copy of the Notice of Opposition to the Applicant or its agent. <ul style="list-style-type: none"> <li>• Manual Filing Fees – RM650 + RM45</li> <li>• E-Filing Fees – RM600 + RM40</li> </ul>			
b. Counter-statement by Applicant to a notice of opposition, file Form TM8 within two months from the date of receipt of the Notice of Opposition from the Opponent and at the same time send a copy of the Counter Statement to the Opponent. <ul style="list-style-type: none"> <li>• Manual Filing Fees – RM440</li> <li>• E-Filing Fees – RM400</li> </ul>			
c. Evidence in support of opposition Opponent shall file evidence in support by way of statutory declaration within two months of the receipt of the Counter Statement and at the same time send a copy of that evidence to the Applicant.			
d. Evidence in support of application Applicant shall file evidence in reply by way of statutory declaration within two months of the receipt of the Opponent’s evidence and shall at the same time send a copy of that evidence to the Opponent.			



My notes...





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e. Evidence in reply Opponent may file evidence in reply within two months of the receipt of the Applicant's evidence and shall at the same time send a copy of that evidence to the Applicant.			
f. Upon completion of the evidence, the Registrar will notify the parties of a date by which the parties may send to him any arguments or submissions in writing which shall be at least one month after the date of receipt of the Notice issued by the Registrar.			
g. If extension of time is required during the opposition proceedings, file Form TM27A. <ul style="list-style-type: none"> <li>Manual Filing Fee - Application for Extension of Time – RM80</li> <li>Manual Filing Fee - Per month charges – RM140</li> <li>E-Filing Fee – Application for Extension of Time – RM70</li> <li>E-Filing Fee – Per month charges – RM 130</li> </ul>			
Opposition accepted by the Registrar, <u>proceed to No 10.</u>			
Opposition rejected by the Registrar, <u>proceed to No 11.</u>			
<b>10. Decision of Registrar following an ex-parte hearing under No 8 – shall be communicated to the applicant in writing</b>			
If Applicant objects to a decision pursuant to ex-parte hearing under No 8, he may within two months from date of receipt, require, on Form TM6, the Registrar to state in writing the grounds of, and the materials used by him in arriving at, his decision. <ul style="list-style-type: none"> <li>Manual Filing Fee – RM700</li> <li>E-Filing Fee – RM650</li> </ul>			
The date when such statement is sent to the applicant shall be deemed to be the date of the Registrar's decision pursuant to ex-parte hearing under No 8 for the purpose of appeal.			



My notes...





	Yes	No	Remarks
<p>If the Applicant objects to a decision pursuant to an Opposition under No 9 he may appeal to the High Court (Intellectual Property). The Registrar's written grounds are usually provided together with the Registrar's decision.</p> <p>Appeal to High Court (Intellectual Property) within one month of the Registrar's decision.</p> <p>Appeal to High Court (Intellectual Property) within one month of the Registrar's decision.</p>			
<b>11. Search and Clearance</b>			
*Only applicable for Expedited Examination. If not applicable, <u>proceed to No 12.</u>			
Does trade mark comply with six month PDC Paris Convention?			
<b>12. Issuance of certificate of registration by the Registrar</b>			
Expedited applications to be issued in seven days.			
For normal applications between two months and one day to six months.			
<b>13. Renewal fee due after 10 years from filing</b>			
<p>File application for renewal using Form TM12 - Any time not less than three months before the expiration of the last registration of a trademark.</p> <ul style="list-style-type: none"> <li>Manual Filing Fee (TM12)– RM600</li> <li>E-Filing Fee (TM12) –RM550</li> </ul>			
If on a date not less than one month and not more than two months before the expiration of the last registration of a trademark Form TM12 has not been received the Registrar shall notify the registered proprietor in writing of the impending expiration.			
<p>If <b>renewal</b> not filed before expiry of the registration – to file application for late renewal using Form TM13 – within one month from the expiration of the last registration of a trademark.</p> <ul style="list-style-type: none"> <li>Manual Filing Fee (TM13)– RM870</li> <li>E-Filing Fee (TM13) –RM820</li> </ul>			





	Yes	No	Remarks
<p>If <b>late renewal</b> not filed within one month the Registrar shall remove the mark from the Register as of the expiration of the last registration. Within one year from the expiration of the last registration – registered proprietor may file Form TM14 to seek restoration and renewal of the registration.</p> <ul style="list-style-type: none"><li>• Manual Filing Fee (TM14)– RM930</li><li>• E-Filing Fee (TM14) –RM880</li></ul>			

## SOURCE:

TRADE MARKS ACT 1976 (ACT 175).

THE OFFICIAL WEBSITE OF INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA.

TRADE MARK REGISTRAR'S NOTICE 2/2011, SUMMARY GUIDELINES OF TRADE MARK REGULATIONS 1997 (AMENDMENT 2011) (UPDATED 16 JANUARY 2012).



My notes...

