

TRADE MARKS

1. What is a trade mark?

A trade mark is used by a trader or service provider to identify his goods or services and to distinguish them from those of other traders. A trade mark could take the form of, for example, a dictionary word, an invented word, numbers, letters, a logo, a picture, a slogan or any combination of these. Some examples of well-known trade marks are KODAK for cameras, MICROSOFT for computer programs and COCA-COLA for drinks.

A registered trade mark is a legal right granted by the government. It gives the owner a statutory monopoly for the exclusive right to use the mark in relation to the goods or services for which the mark is registered.

2. Are all trade marks registrable?

Not all trade marks are registrable. In general, marks which other traders would legitimately want to use to describe their goods or services are not registrable. Thus, for example, the mark should not be descriptive of the goods, it must be “distinctive”. Examples of unregistrable marks are “PERFECT” or “THE BEST”. Other unregistrable marks include well-known surnames or the name of a large city or country.

Also, the mark should not conflict with earlier filed or registered trade marks.

3. What is a service mark?

The term service mark refers to trade marks which are used in relation to services rather than in relation to products or physical goods. Examples of services include banking, insurance, hotels, restaurants, education, computer programming, cleaning, repairing, advertising and so on.

4. Why should you register a trade mark?

It is not compulsory to register a trade mark. However, if someone is infringing your mark, and the mark is not registered, then it will be necessary to take action under the common law of “passing off”. A passing off action can be very expensive, time consuming and the outcome can be very difficult to predict.

It is normally much simpler to prove infringement of a registered trade mark. In many cases, a cease and desist letter from your trade mark agent or lawyer is all that is needed to stop the infringing act.

5. Is it necessary to conduct a pre-filing search?

Before filing a trade mark application, or starting to use a new mark, it is advisable to first make a search at the Malaysian Trade Marks Office to ensure that there are no marks identical to, or closely resembling your mark, filed or registered by others for similar goods or services. The search is best handled by Registered Trade Mark Agents, who will be able to offer professional advice on the availability and registrability of the mark.

6. How do I obtain a trade mark registration?

To obtain registration of a trade mark, it is necessary for the owner of the mark to file a formal trade mark application with the Trade Marks Office. The application will be examined by the Examiner for conflict with any earlier marks and its registrability will be determined based on various factors such as distinctiveness.

7. What is the duration of a trade mark registration?

The term or duration of a trade mark registration is initially 10 years from the date of application. Upon payment of a fee, the registration is then renewable every 10 years in perpetuity.

8. What about protection in other countries?

A trade mark registered in Malaysia is valid only in Malaysia. If you intend to export your products to other countries, you should consider applying for

protection in each country in which protection is desired. However, it is possible to file a single application for a trade mark for a group of 25 countries in the European Union, by filing a European Community Trade Mark (CTM) application.

9. What can a registered trade mark agent do for you?

Registered trade mark agents possess skill and knowledge in all phases of trade mark prosecution and registration. They can advise on the registrability of your mark, conduct pre-filing searches, prepare all the necessary paperwork required to file a trade mark application, handle any objections raised by the Trade Marks Registrar and/or any oppositions raised by third parties during the process of registration. Trade mark agents also have close contacts with foreign associates for the purpose of obtaining appropriate trade mark protection in other countries.

10. What is the difference between trade marks, domain names and company names?

Trade marks should not be confused with company names or domain names.

Unlike a registered trade mark, company and domain names do not give you statutory monopoly right.

A company name merely serves to identify the owners of the business. A domain name is merely a textual address for a location on the Internet.

Many organisations now register the same mark both as a trade mark and as a domain name.