

## **Procedural Changes under the Malaysian Trademarks Act 2019**

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*This article was updated in June 2025 to improve accuracy and readability.*

Since our last article in August 2019 discussing Malaysia's new Trademarks Act 2019 ("the Act") and its subsequent enforcement on 27 December 2019, the world has experienced dramatic shifts, particularly due to the COVID-19 pandemic. Amidst these changes, Malaysia's trademark landscape has continued to evolve. In this article, we highlight key procedural updates at the Malaysian IP Office ("MyIPO") following the introduction of the Act.

### **1. Filing Date Requirements under Section 22**

One significant procedural update is Section 22 of the Act, which governs the date of filing for new trademark applications. Under this section, the filing date is tied to the requirements set out in Section 17. When the requirements under Section 17 are fulfilled on different days, the Registrar will record the latest of those days as the official filing date.

Importantly, Subsection (3) of Section 22 clarifies that any priority claims do not affect the filing date of the application, except in the context of the search and examination process.

#### **Section 17 Requirements**

To better understand the implications, Subsection (2) of Section 17 mandates that a trademark application must be submitted in the prescribed form, within the prescribed time frame, and accompanied by the requisite fees. Subsection (3) requires additional information where the trademark includes characters that are not in Roman script, Bahasa Malaysia, or English. Specifically, applicants must furnish:

- (a) A transliteration of the trademark;
- (b) A translation of the trademark; or
- (c) Any other information as determined by the Registrar.

Failure to provide these documents within the prescribed time will result in the application being deemed withdrawn under Subsection (4).

#### **Practical Example**

For example, Applicant X submits a trademark application on 1 October 2020 with Chinese characters but omits the translation and transliteration ("TNT"). These are later filed on 15 October 2020. The official filing date will be recorded as 15 October 2020. This contrasts with the previous Act, which allowed up to twelve months to provide TNT without affecting the filing date. Under the new regime, Regulation 14 of the Trademarks Regulations 2019 limits this to a maximum of two months, and the filing date will be determined based on the last fulfilled requirement.

This change makes it essential for applicants to submit complete documentation upfront, especially when foreign language elements are involved, to avoid prejudicing the filing date.

## 2. Limitation on Examination Responses – Regulation 17

Another key change occurs during the search and examination stage. Previously, applicants could respond to objections through written submissions and, if unsuccessful, request a hearing. This two-stage response mechanism has been significantly streamlined under Regulation 17 of the Trademarks Regulations 2019.

Under the new procedure, applicants may only respond to provisional refusals in one of the following ways:

- (a) Make a written representation or request a Hearing (not both);
- (b) Amend the application to meet the Registrar's requirements; or
- (c) Provide further information or evidence via statutory declaration or viva voce.

This "one-shot" response requirement means applicants must now choose carefully whether to respond in writing or proceed directly to a Hearing. If the application is ultimately refused, the only recourse is to file an appeal with the High Court, which introduces added legal costs and complexity.

## 3. Opposition Proceedings and Affidavit of Service Requirement

A third area of procedural change concerns Opposition proceedings. Regulation 23(2) of the Trademarks Regulations 2019 shortens the timeframe for filing a Notice of Opposition to two months after publication, with a possible extension of only two additional months. Under the old Act, extensions of up to six months were available.

MyIPO has also introduced a new requirement: parties must file an Affidavit of Service within 14 days after serving the Notice of Opposition or the Counter Statement. This affidavit must contain proof of the date of receipt by the other party. Failure to comply results in the withdrawal of the Opposition for the Opponent or abandonment of the trademark application for the Applicant.

While this procedural safeguard promotes accountability and ensures both parties are properly informed, it also introduces additional administrative burdens and costs. The use of affidavits, typically a litigation tool, in an administrative proceeding may be viewed as excessive by some.

## Conclusion: Navigating the New Trademark Landscape

The procedural changes under Malaysia's Trademarks Act 2019 have substantial implications for applicants at every stage of the trademark registration process—from initial filing to examination and opposition. While it is still early to gauge their long-term impact, these changes reflect MyIPO's efforts to modernize and streamline processes in line with international standards.

Applicants are advised to be meticulous in meeting documentation and timing requirements to safeguard their rights. As always, engaging with a professional IP firm ensures that these regulatory nuances are addressed effectively.