

Trademarks in Malaysia – What You Need to Know about Provisional Refusal

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In today's competitive business environment, trademarks serve as powerful tools to differentiate products and services, build brand recognition, and protect intellectual property rights. However, registering a trademark in Malaysia is not always straightforward. One of the key challenges that applicants may face is a **Provisional Refusal** – a crucial checkpoint in the trademark registration process.

In this article, we explain the concept of Provisional Refusal, how to prevent it, and strategies to overcome it effectively.

What Is a Provisional Refusal?

A Provisional Refusal arises when the Malaysian IP Office (MyIPO) preliminarily rejects a trademark application due to specific legal concerns. This temporary refusal, issued under **Section 29 of the Trademarks Act 2019**, serves as an opportunity for applicants to respond and address the issues.

Section 29 provides: - (1) The Registrar shall examine whether a trademark application satisfies all registration requirements. - (2) For this purpose, the Registrar may conduct a search of earlier trademarks to determine registrability.

There are two main categories of grounds for refusal:

Absolute Grounds for Refusal

These are based on the inherent characteristics of the mark itself. Examples include: - Generic or non-distinctive signs. - Descriptive terms indicating quality, purpose, or origin (e.g., "gourmet" for food services). - Terms customary in trade or lacking originality. - Geographical names or misleading place-based associations. - Marks contrary to public policy or morality.

Relative Grounds for Refusal

These focus on the likelihood of confusion with existing rights: - Identical or similar trademarks registered for similar goods or services. - Similarity with well-known trademarks, even for different classes of goods or services.

A Provisional Refusal under either ground will delay the registration process and require a formal response.

How to Avoid a Provisional Refusal

Taking proactive steps during the trademark application process can greatly reduce the risk of a refusal.

1. Conduct a Trademark Search

Before filing, conduct a comprehensive availability search to ensure your mark does not conflict with existing registered or pending trademarks. This minimizes the risk of refusal on **Relative Grounds**.

2. Avoid Descriptive or Common Words

Marks that describe the goods/services (e.g., “delicious” for restaurants) are often refused for lacking distinctiveness. Instead, choose **arbitrary**, **coined**, or **suggestive** terms that create uniqueness.

3. Avoid Geographical Terms

Geographical names often lack registrable distinctiveness and may mislead consumers. Avoid names of countries or cities unless they directly relate to the origin of your goods/services and are not misleading.

4. Prioritize Distinctiveness

Distinct trademarks are easier to register and enforce. Create new words or creative combinations that do not resemble common industry terms.

5. Seek Expert Guidance

Consult a qualified trademark professional to evaluate your mark’s registrability, identify risks, and ensure compliance with legal requirements.

How to Respond to a Provisional Refusal

If you receive a Provisional Refusal, stay calm and respond strategically. The refusal is not a final rejection – the applicant is given a chance to reply.

Step 1: Review and Confirm Deadline

The Registrar typically gives a two-month deadline (extendable up to six months) to respond. Missing this deadline will result in the application being deemed abandoned.

Step 2: Understand the Grounds for Refusal

Identify whether the refusal is based on Absolute or Relative Grounds. This helps determine your best course of action.

Under the **Trademarks Act 2019**, applicants only have **one opportunity** to respond to a provisional refusal. If that fails, appealing to the **High Court** is the next step – which is costly and time-consuming.

Step 3: Choose a Response Strategy

Under **Regulation 17(1)** of the Trademarks Regulations 2019, you may:

i. Request an Ex-Parte Hearing

Submit a Hearing request along with written submissions and/or a Statutory Declaration with evidence of use. This allows you to engage directly with the examiner. However, it may take time for MyIPO to fix a date and issue a decision.

ii. File a Written Submission Only

Submit your arguments before the deadline without requesting a Hearing. This is faster initially, but you lose the opportunity for direct engagement. A decision may still take 12 months or more.

iii. Submit Evidence of Use

Show proof that your trademark has acquired distinctiveness through use. Evidence (e.g., packaging, advertising, invoices, social media posts) must be submitted via a **Statutory Declaration**.

Conclusion

Provisional Refusals are common but manageable obstacles in the trademark registration process. By understanding the legal grounds, preparing a distinctive application, and responding strategically, you can significantly improve your chances of success.

Engaging an experienced **Trademark Agent** is highly recommended. A qualified professional will guide you through the nuances of Malaysian trademark law and help you craft a strong, well-argued response within the limited window for appeal.