



(KLINIK PERUNDANGAN PKNS SIRI 2/2020)
INTRODUCTION TO TRADE MARK

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OUTLINE

- ♥ What is TM?
 - ♥ What law applicable for TM?
 - ♥ What are the subject matters under TM?
- ♥ Examples of trademarks that we have applied/registered recently
 - ♥ What are the elements for TM registration?
 - ♥ Special features of TMA 2019?
- ♥ Why do we need to register TM & Effect of Non-Registration?



WHAT IS TRADE MARK

Section 3 of TMA 2019

Any SIGNS that is represented graphically (visually)



Capable of distinguishing goods/services owned by one party from another



Irrespective of whether the goods/services has monetary worth or not



WHAT LAW APPLICABLE FOR TM?

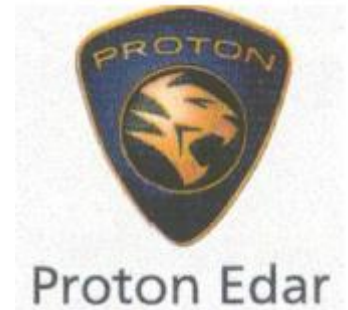
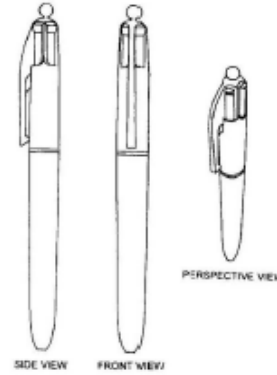
Trademarks Act 2019 | Act 815

Trademark Regulations 2019



WHAT ARE THE SUBJECT MATTERS UNDER TM?

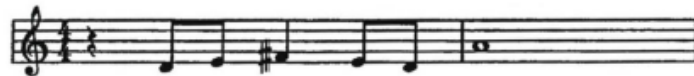
Taylor Swift



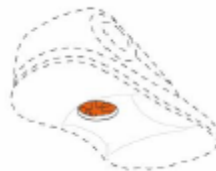
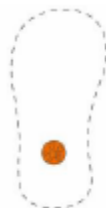
Shape of ball point pens



Colour



John Hancock



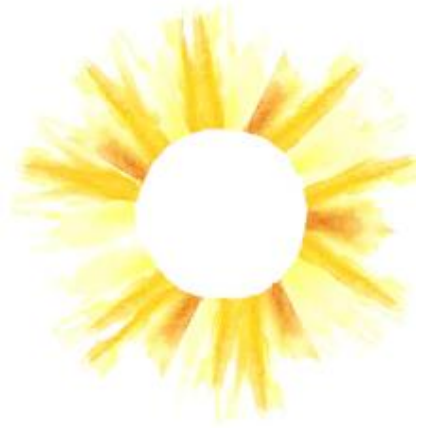
“

EXAMPLES OF TRADEMARKS THAT WE & HAVE APPLIED/REGISTERED RECENTLY



MEMBINA KOMUNITI, MEMPERKASA KEHIDUPAN ... MEREALISASI IMPIAN





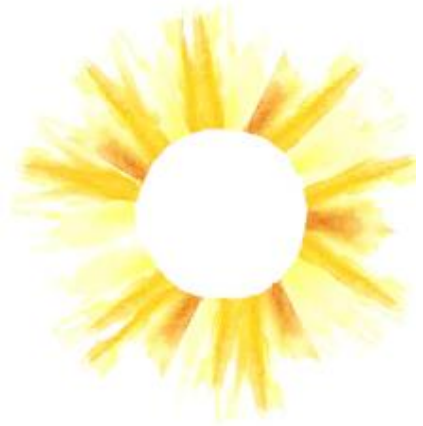
EXAMPLES OF TRADEMARKS THAT WE HAVE APPLIED/REGISTERED RECENTLY

INSPIRING CONNECTIONS

PROTON

PROTON X70





EXAMPLES OF TRADEMARKS THAT WE HAVE APPLIED/REGISTERED RECENTLY

**INTELLIGENCE
THAT EXCITES**

**INTELLIGENCE
THAT MOVES**

**INTELLIGENT
PROPOSITION**

**INTELLIGENCE
THAT CARES**

**INTELLIGENCE
THAT INSPIRES**





EXAMPLES OF TRADEMARKS THAT WE HAVE APPLIED/REGISTERED RECENTLY



نعيش قيمنا
Living the Values



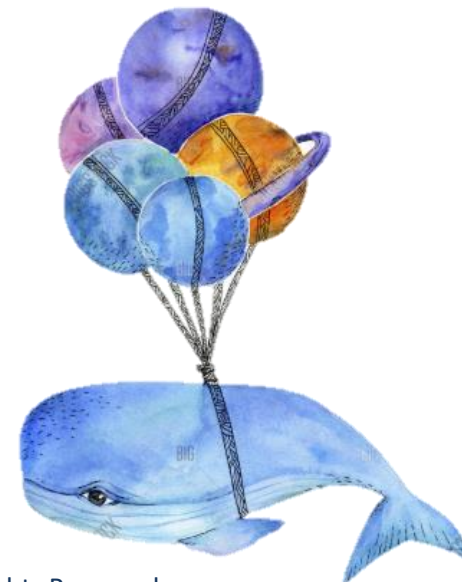
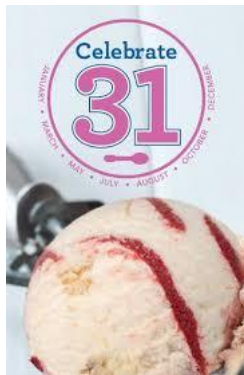
WHAT ARE THE ELEMENTS FOR TM REGISTRATION?



1st

The mark must be listed with
the subject matter of the trade mark

Case : BASKIN ROBBINS INTERNATIONAL v
AVONDAY





WHAT ARE THE ELEMENTS FOR TM REGISTRATION?

2nd

Use / Proposed to be used in relation to goods/services

Case : THERMAX TM





WHAT ARE THE ELEMENTS FOR TM REGISTRATION?

3rd

Mark must be able to be represented in graphical manner
& capable of distinguishing goods/services
owned by one party from another.

... as per TRADEMARKS ACT 2019





WHAT ARE THE ELEMENTS FOR TM REGISTRATION?


4th

Mark must be 'distinctive'

TRADEMARKS ACT 2019 :

Why : To ensure that the mark is capable of distinguishing the goods / services between one party to another.

How:

- **Section 20 :** Colour of the trademark (Eg: )
- **Section 23(2) :** Acquired through the result of its use.



WHAT ARE THE ELEMENTS FOR TM REGISTRATION?



5th

Mark must not be within the class of restricted mark.

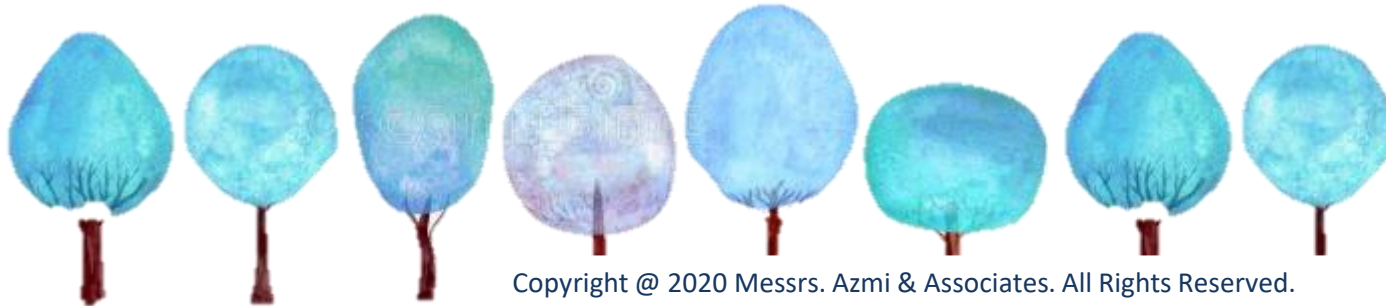
TRADEMARKS ACT 2019 :

Section 23 : Absolute ground of refusal of registration

CASE : HALLELUJAH'S APPLICATION

"Scandalous or Offensive"

~~Hallelujah~~



WHAT ARE THE ELEMENTS FOR TM REGISTRATION?



Cont. 5th

Mark must not be within the class of restricted mark.

TRADEMARKS ACT 2019 :

Section 24 : Relative ground of refusal of registration

CASE : RE LOVREN v KONSTED

'Leocilin' vs ~~'Ledercilin'~~





SPECIAL FEATURES OF TMA 2019?

- ♥ **Definition of 'signs'** - Addition of subject matter of trade mark
 - ♥ **Section 18** - Multiple class application
 - ♥ **Section 37** - Divisional application
 - ♥ **Section 38** - Merger application





WHY DO WE NEED TO REGISTER TM & EFFECT OF NON-REGISTRATION?

- ♥ **Section 39** – Registration's duration is 10 years + Right of renewal
- ♥ **Section 48** – Exclusive rights to use / authorize others to use the trade mark
- ♥ **Section 56** – The infringement action can be brought by the 'registered proprietor' of the trade mark.





Q&A





Thank You



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