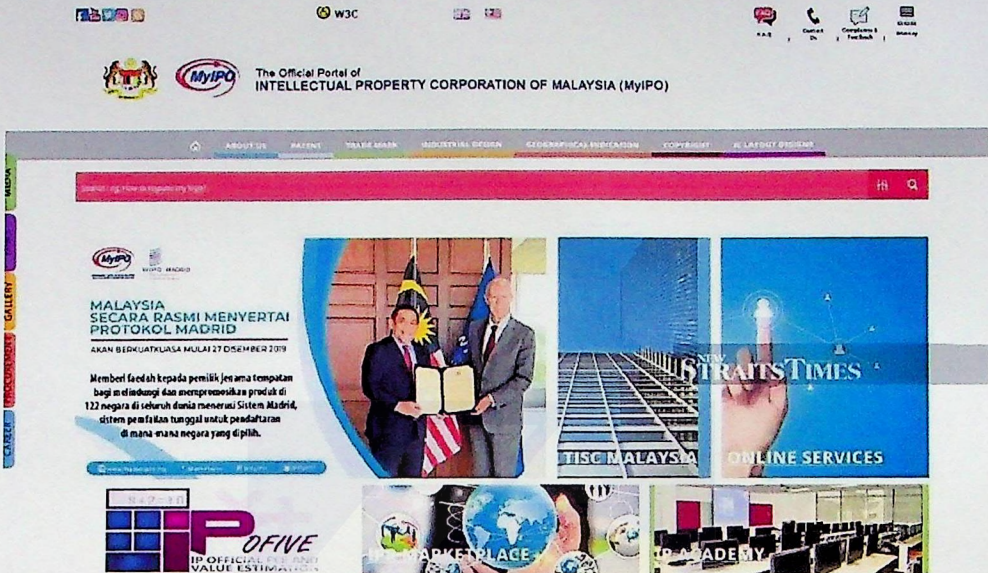


Get your brand registered



A screenshot of the MyIPO website. Under Malaysia's Trademarks Act 2019, businessmen can register 'intangible materials' as their trademarks such as shape of goods, packaging, sound, scent and colour.

By Salleh Buang
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ON Sept 27, the Malaysian government deposited its instrument of accession to the Madrid Protocol with the director-general of the World Intellectual Property Organisation (Wipo) in Geneva, Switzerland.

With that, we've become the 106th member of the Madrid System, which now covers 122 countries. The Protocol will enter into force for Malaysia this Dec 27.

From then on, Malaysian businessmen can (and should) start using the Madrid System to protect their trademarks (their distinctive brands) in all these countries by simply filing a single international application for trademark protection and paying a single set of fees.

Likewise, foreign companies (trademark owners) can secure protection under the Madrid System when doing business (selling their products or offering their services) in this country.

To prepare for this new legal landscape affecting intellectual property (IP) rights, Parliament passed the Trademarks Act 2019 last July, replacing the Trade Marks Act 1976 (modelled on the old UK Trade Marks Act 1938).

Other Asean countries that have acceded to the protocol are Brunei, Cambodia, Indonesia, Laos, the Philippines, Singapore, Thailand and Vietnam.

A brief explanation on the Madrid system.

It provides for a convenient international registration of trade marks by way of a single application that can cover more than one country.

The system is administered by the International Bureau of Wipo.

The international registration protects the trademark owner for 10 years from the date of registration. Section 3 of the Trademarks Act 2019 defines "trademark" to mean "any sign capable of being represented graphically, which is capable of distinguishing goods or services of one undertaking from those of other undertakings".

A trademark is one of eight types of intellectual property (IP). The other seven types are patents, copyright, industrial design rights, plant variety rights, trade dress, geographical indications and in some jurisdictions, trade secrets.

If trademarks are used to identify services, they are usually called service marks.

The objective of the IP law is to encourage the creation of a wide variety of "intellectual goods" for consumers.

It confers on the owners (the creators of these intellectual goods) certain rights for a limited length of time.

Under Section 39 of the Trademarks Act 2019, the protection is for 10 years from the date of registration, and may be renewed for another 10 years.

The new act also empowers the registrar (under Section 45) and the court (under Section 46) to revoke the registration of trademarks under certain circumstances.

Under Section 48, the rights conferred on the registered proprietor include the "exclusive right" to use it, to authorise other persons to use it and to obtain relief of the infringement of the trademark.

In cases of infringement, the registered proprietor can (under Section 56) seek the court's injunction, damages, an account of profits and, in certain cases, the award of additional damages.

We may see an increase in trademark and intellectual property applications in the coming months. In fact, Domestic Trade and Consumer Affairs Minister Datuk Seri Saifuddin Nasution Ismail had alluded to this earlier.

Under the new law, businessmen can register "intangible materials" as their trademarks, such as shape of goods, packaging, sound, scent, colour, holograms, positioning and sequence of motions that could be graphically presented to distinguish goods and services from others.

It would indeed be advisable for local entrepreneurs to register their brands' rights under the new law as soon as possible and not risk having counterfeiters and imitators hijack their rights to the brands.

Malaysian companies should also have "a long-term brand strategy to protect and leverage their trademarks" as suggested by Saifuddin.

The new law imposes severe penalties for anyone committing trademark infringements — a fine of up to RM1 million, a prison term of five years, or both. Under the old law, the penalty was only a fine of RM5,000 for the first offence, a prison term of three years or both.

Currently, many Malaysian trademarks (brands) have achieved fame and fortune in the global arena, thanks to global IP protection laws.

The following are examples (goods and services) — Life sauces, Kawan food products, Munchy's biscuits, Baba's spices, PappaRich restaurants, OldTown White Coffee outlets, Mamee snacks, Mister Potato crisps, Brahim's sauces and pastes, Beryl's chocolates, Secret Recipe outlets, Marry Brown restaurant chain, The Chicken Rice Shop, Bonia and British India.

According to Malaysia Intellectual Property Office (MyIPO), there were only 1,777 trademark registrations in 2000.

Last year, the figure climbed to 34,566. Under the new law, sound and smell trademarks may push the figure even higher.

It would be timely to revise the MyIPO's Manual of Trade Marks Law and Practice 2003 to keep up with this new law.

The writer, a former federal counsel at the Attorney-General's Chambers, is deputy chairman of Kuala Lumpur Foundation to Criminalise War

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