



European
Commission

SOUTH-EAST ASIA IP SME HELPDESK

MALAYSIA IP Country FACTSHEET



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1) THE FACTS: Business in Malaysia for EU Companies

- Malaysia GDP in 2019: **EUR 326 billion** (Source: [DG Trade](#))
- Malaysia GDP growth in 2019: **4.5%** (Source: [DG Trade](#))

SIZE of the market (Source: [DG Trade](#))

- EU-27 exports in goods to Malaysia in 2019: **EUR 13.0 billion**
- EU-27 imports in goods from Malaysia in 2019: **EUR 23.6 billion**
- Total trade in goods in 2019: **EUR 36.6 billion**
- EU-27 exports in services to Malaysia in 2018: **EUR 3.2 billion**
- EU-27 imports in services from Malaysia in 2018: **EUR 2.9 billion**
- Total trade in services in 2018: **EUR 6.1 billion**
- Malaysia is the EU's third largest trading partner among the countries of the Association of Southeast Asian Nations (ASEAN), behind just Singapore and Vietnam (and 23rd worldwide). Conversely, the EU is Malaysia's fourth largest trading partner overall (accounting for 8.6% of Malaysia's total external trade), after China, Singapore and the USA (source: [DG Trade](#)).
- Negotiations for a Free Trade Agreement (FTA) between the EU and Malaysia were launched in 2010 and put on hold in 2012 after seven rounds of negotiations at the request of Malaysia. A stocktaking exercise took place in 2016–17 to assess the prospect of resuming negotiations. The current government has yet to take a position on the possible resumption of negotiations.

Key INDUSTRY SECTORS (Source: [DG Trade](#))

- The EU's exports to Malaysia are mainly: i) machinery and appliances (42.9%); ii) transport equipment (13.2%); and iii) products of the chemical or allied industries (11.5%).
- Whereas (i) machinery and appliances are also the EU's dominant import from Malaysia (65.0%), they are followed by (ii) optical and photographic instruments (7.2%) and (iii) plastics, rubber and articles thereof (6.3%).

2) IPR in Malaysia for SMEs: BACKGROUND

Intellectual Property Rights for SMEs: Why is this RELEVANT to you?

Intellectual property rights (IPR), as intangible assets, are a key factor in the competitiveness of businesses in the global economy. IP is a primary source for securing a return on investment in innovation, and is particularly relevant to small and medium-sized enterprises (SMEs) (see EC definition at http://ec.europa.eu/enterprise/policies/sme/facts-figures-analysis/sme-definition/index_en.htm) when they internationalise their business to areas such as South-East Asia. Not only a way to help protect innovations from competitors, IP assets can also be an important source of cash-flow for SMEs through licensing deals or their sale, as well as a significant pull-factor when attracting investors.

Although SMEs often have limited time and resources, it is important to be aware of how IP can be valuable to businesses. IPR infringement is one of the most common concerns for businesses when dealing with countries in South-East Asia, and can lead to losses of business, revenue, reputation and competitive advantage, both in South-East Asia and in core domestic markets. Proactive steps should be taken to protect IP and deter potential infringers.

The main IP issues for EU SMEs in relation to Malaysia, concern aspects of IPR enforcement, such as the prevalence of online counterfeiting, and the absence of strong deterrent measures in relation to the prosecution of counterfeiters. Despite improvements in the registration procedures, they can still be quite long. SMEs should prepare well in advance before entering the Malaysian market.

How does Malaysia's IP legal framework compare to INTERNATIONAL STANDARDS?

Malaysia's legal system is fundamentally based on English common law. Historically, Malaysia's IP laws are closely linked to the evolution of laws in the United Kingdom, and generally conform with international standards, particularly with regard to the amendments made due to Malaysia's obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement). The TRIPS Agreement is a minimum standards agreement, which allows members to provide more extensive protection for IP if they so wish. Members are left free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice.

Malaysia's IP legal system is in line with international standards, and is a member of many international IP treaties, such as:

- Berne Convention for the Protection of Literary and Artistic Works (since 1 October 1990)
- Paris Convention for the Protection of Industrial Property (since 1 January 1989)
- TRIPS Agreement (since 1 January 1995)
- Patent Cooperation Treaty (PCT) (since 16 August 2006)
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) (since 27 December 2019)

For detailed information on World Intellectual Property Organization (WIPO) treaties, see the WIPO website at www.wipo.int.

Online services

The Intellectual Property Corporation of Malaysia (MyIPO) manages an IP Online System that offers online search and filing services for patents, trade marks, industrial designs and geographical indications (GIs). This system also allows applicants to check their application status. For more detailed information, please check out <https://iponline2u.myipo.gov.my/myipo/www/>.

Trademarks Act 2019

On 27 December 2019, the new Trademarks Act 2019 officially came into force in Malaysia. The Act repealed the Trade Marks Act 1976 and introduced a number of substantial changes to align Malaysia's trade mark legislation with international standards and procedures. The Trademarks Regulations 2019 are also now in force, having been published in the Government Gazette on 27 December 2019.

Madrid Protocol

Malaysia recently joined the Madrid Protocol, which entered into force in Malaysia on 27 December 2019. The Madrid system is a convenient and cost-effective solution for registering and managing trade marks worldwide by filing a single application and paying one set of fees to apply for protection in up to 122 countries (<https://www.wipo.int/madrid/en/>). With the addition of Malaysia, all the countries in the South-East Asian region, except Myanmar, are now members of the Madrid system.



3) IPR in Malaysia: THE BASICS

A. Copyright

WHAT is copyright?

Copyright is the proprietary right subsisting in works created by authors. Copyright protects literary, artistic, musical and dramatic works. Copyright also protects sound recordings, published editions, films, broadcasts and performer's rights. Copyright ownership can be held by the author, his employer or the person who commissions the work.

It must be noted that an author retains the right to have his/her name identified as the author of the work, based on what is called a moral right. The author also has the moral right to prevent the distortion, mutilation or other modification of his/her work. Ownership of copyright entails an exclusive right to commercially exploit the work. A classic example of commercialising a copyrighted work is the distribution of copies of the work for sale. This can be seen in traditional commerce, such as books and compact discs. As an intangible property right, copyright can also be licensed or assigned to third parties for royalties. When licensing, it is important to determine the extent of copyright use that is permitted.

Copyright in Malaysia: What you need to know

There is no formal requirement for the work to be registered in order for copyright to be claimed or recognised, however a copyright owner may voluntarily register their copyright in Malaysia. Registration is still advisable for foreign SMEs as the registration can be extremely useful in enforcement proceedings as evidence of your ownership. To claim copyright ownership (i.e. to forewarn third parties about infringement), a notice with the symbol © may also be placed in/on the work, followed by the name of the owner and the year of initial publication.

Malaysia issued the [Copyright \(Amendment\) Act 2012](#), introducing provisions on statutory damages, and prohibiting recording inside a cinema (anti-camcording) and the circumvention of technological protection measures. The amendments further regulate the liabilities of internet service providers and the owners' right to submit a takedown notice when they have detected copyright infringements on the internet.

How LONG does legal protection last?

Copyright protection is not perpetual. Generally, the Malaysian Copyright Act grants copyright protection (i.e. for literary, musical or artistic works) during the life of the author plus 50 years after his or her death. However, if a work has not been published during the lifetime of the author, copyright protection lasts for 50 years from the beginning of the calendar year following the publication date.

HOW do I register?

In order to file a voluntary notification of copyright, the applicant first has to determine whether the work is original or derivative. Literary, artistic and musical works are original, as are films, sound recordings and broadcasts. Translations, adaptations, arrangements and other transformations of original works or collections of works are derivative.

For original works, a standard form (Form CR-1) has to be completed. For derivative works, Form CR-2 has to be completed. The forms (depending on the type of work) have to be submitted at the MyIPO office, accompanied by a statutory declaration with a copy of the work annexed to it and the prescribed fee paid. The work submitted must be clear and of durable quality.

It is important to note that notification of copyright can only be made by a citizen or a permanent resident of Malaysia, regardless of whether the notification is done by the author/owner or a representative. If the notification is carried out by a representative, an additional form (CR-3) has to be completed and a prescribed fee paid. No additional form and fee are required if the notification is by the original author/owner.

The forms have to be signed or thumb-printed by the applicant if they are an individual. Where the applicant is a society, organisation, body corporate or firm, the forms must be signed by a director, manager, secretary, partner or other similar officer within the organisation.

The relevant forms are to be submitted to the MyIPO. This can be done either by hand, by post or using electronic means. Upon submission to the Controller, the relevant forms and documents are examined, the payment is processed and a receipt is issued. If the notification is in order, a notice will be sent to the applicant to confirm that the information and work has been recorded in the copyright register.

The agency dealing with voluntary copyright notification is the MyIPO:

Copyright Division

Intellectual Property Corporation of Malaysia (MyIPO)

Aras 18, Tower B, Menara UOA Bangsar, No. 5 Jalan Bangsar Utama 1, 59000 Kuala Lumpur, Malaysia

Tel: +603-2299 8400

Website: <http://www.myipo.gov.my/>



WHO can register?

A copyright notification can only be made by a citizen or a permanent resident of Malaysia. An applicant who is not a citizen or a permanent resident of Malaysia may appoint a Malaysian citizen or a permanent resident to file the notification on their behalf.

Which LANGUAGES can I use?

If the title of a work contains a word in a language other than English or the national language of Malaysia (Bahasa Malaysia), then the notification of copyright must include a translation of the word into English or Bahasa Malaysia, and a transliteration of the word, as well as the name of the language in question.

How much does it COST?

The typical official fees for a voluntary copyright notification in Malaysia start from MYR 155 (approximately EUR 35). Additional costs can arise depending on the kind of work. These do not include legal fees.

Copyright TIPS and things to WATCH OUT for in Malaysia

- Notification of copyright can only be made by a citizen or a permanent resident of Malaysia, regardless of whether the notification is done by the author/owner or a representative. If you are not a citizen or a permanent resident you may appoint one to file the notification on your behalf.
- In cases involving piracy, in order for action to be taken against the infringers, copyright owners may file complaints with the Enforcement Division (ED) of the Ministry of Domestic Trade and Consumer Affairs (MDTCA).

For more information on copyright protection in Malaysia check out our [South-East Asia IPR SME Helpdesk Guide to Copyright Protection in South-East Asia](https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Copyright_english.pdf), which is available to download from our website, https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Copyright_english.pdf.

B. Patents and Utility Innovations**WHAT are patents?**

In Malaysia, as in Europe, a patent is an exclusive right granted for an invention that is new, involves an inventive step and is industrially applicable. In other words, a patentable invention is product or process that provides a new way of doing something or offers a new technical solution to a problem.

Patents in Malaysia: What you need to know

In Malaysia, the following **cannot** be patented:

- Discoveries, scientific theories and mathematical methods;
- Plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes;
- Schemes, rules or methods for doing business, performing purely mental acts or playing games;
- Methods for the treatment of a human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body.

There are two types of patent that can be granted in Malaysia, 'Patents' and 'Utility Innovations'.

Utility innovations are exclusive rights granted for 'minor' inventions, which, unlike patents, do not require testing for inventiveness. Accordingly, utility innovations enjoy a quicker examination process. Utility innovations can be registered for a new product or process or any new improvement of a known product or process that is capable of industrial application. Only a single claim is allowed in a utility innovation application, all the other filing requirements are the same as those for a patent application.

Conversion from a patent to a utility innovation application and vice versa is allowable. If the applicant wants to convert their application, a conversion request must be filed no later than 6 months from the time the applicant is informed of the Examiner's Report.

Malaysia is party to the Paris Convention, which means that applicants for patents are entitled to a 'right of priority' if the same filing is made in Malaysia within 12 months of its initial filing in any other member country. Malaysia is also a party to the PCT, so if the PCT route is used, the applicant has up to 30 months from the earliest filing date to decide if they want to enter the national phase in Malaysia or not (check out further information about the PCT at <https://www.wipo.int/pct/en/>).



Patent accelerating programme

The Patent Prosecution Highway (PPH) is an initiative that provides a means of significantly accelerating the examination of a patent application if the examination work has already been conducted in another office. Under the PPH programme, if the claims of your application have been found acceptable in the Office of Earlier Examination (OEE), you can submit a Form PPH1 to request the acceleration of your corresponding application at the MyIPO. Currently, the MyIPO have implemented the pilot PPH/PCT-PPH programme with three offices: the Japan Patent Office (JPO), European Patent Office (EPO) and China National Intellectual Property Administration (CNIPA).

The ASEAN Patent Examination Co-operation (ASPEC) is a regional patent work-sharing programme involving 9 of the 10 IP offices in the ASEAN countries (only Myanmar is not yet involved). The objectives of ASPEC are to reduce complexity, achieve time savings and improve the quality of searches and examinations. Reference made to an earlier examination performed in one IP office will help an examiner in another to better understand the invention claim, reduce the amount of searches that need to be conducted and develop a more comprehensive examination strategy. For example, a patent application from Singapore could be able to take advantage of a speedier process at the MyIPO, reducing the time taken for patent protection to be granted. ASPEC is free-of-charge and operates in English in all ASEAN IP offices (except Myanmar).

How LONG does legal protection last?

Patent protection lasts for 20 years from the date of filing. The term of a utility innovation certificate is initially 10 years from the date of application and this term is extendable for another 2 consecutive 5-year terms (by filing a formal request for extension), making a total of 20 possible years of protection.

HOW do I register?

An application for a patent in Malaysia must be made using the official form and can be submitted either manually or [online](#). The application should be accompanied by the following:

- The inventor's details and a statement justifying the applicant's right to file the patent (e.g. through employment or assignment);
- The invention's specifications, including a description, claims, abstract and drawings (if any) —businesses usually hire a patent attorney or patent drafter for the purposes of providing this information accurately;
- Priority details and priority document (certified copy of earlier application), if any.

Applications in person can be made at:

Patents Registration Office
Intellectual Property Corporation of Malaysia (MyIPO)
 Unit 1–7, Aras Bawah, Tower B, Menara UOA Bangsar,
 No. 5, Jalan Bangsar Utama 1, 59000 Kuala Lumpur, Malaysia
 IP Online Helpdesk: +603-22998418 / +603-22998420
 Patent Helpdesk email: pttechsupport@myipo.gov.my
 MyIPO website: <http://www.myipo.gov.my/>

A Malaysian address must be provided. When an applicant's ordinary residence or principal place of business is outside Malaysia, the applicant must appoint an agent to act on their behalf.

For detailed information on how to file a patent application in Malaysia, please see the MyIPO's guidelines: <http://www.myipo.gov.my/en/apply-for-patentutility-innovation/?lang=en>.

If patent applications pass the preliminary examination (an examination to make sure that the application contains all the required elements), then they are made available for public inspection (for the 18 months following the priority date or filing date).

Applicants are also required to be proactive. Within 18 months of the filing of the national application or 4 years of the PCT filing date, you will have to request one of the 3 kinds of examinations provided by the legislation, using a:

- a. Request for 'substantive examination';
- b. Request for 'modified substantive examination';
- c. Request for 'deferment of substantive examination'.

If the applicant does not elect any of the above options, the application will lapse (with no possibility of reinstatement) and the patent will not be granted.

(a) Substantive examination

Substantive examination is a full examination on the substantive requirements of the patent application, i.e., 'novelty', 'inventive step' and 'industrial applicability'. To expedite the examination process, it is advisable to provide one of the following documents (if available) to assist the patent examiner during the examination of the application:

- Any information relating to patents granted (or applied for) for the same or essentially the same invention claimed by the applicant via the relevant authorities in the United States of America, the United Kingdom, Australia, Japan, the Republic of Korea or the EPO;
- Search results, bibliographic details or relevant official actions issued by any of the above jurisdictions.

As substantive examination is a full examination of all substantive and formality requirements, it generally takes a longer time for the patent to be granted.

(b) Modified substantive examination

Modified substantive examination may be requested if the applicant has already been granted a corresponding patent in the United States of America, the United Kingdom, Australia, Japan, the Republic of Korea or with the EPO. The modified substantive examination is a simplified examination whereby the substantive requirements of novelty, inventive step and industrial applicability are considered to have been met by the foreign patent. If your business has already patented an invention in any of the six jurisdictions mentioned, requesting a modified substantive examination can reduce the time it takes for a patent to be granted.

In pursuing this option, the applicant must:

- Amend the Malaysian patent specifications and claims to conform substantially to those granted in the foreign patent;
- Provide a certified copy of the foreign patent when filing the request for a modified substantive examination.

(c) Deferment of substantive examination

Requesting the deferment of substantive examination can defer the deadline for examination for up to 5 years from the date of filing the application (an extension of the initial 2-year deadline). This is particularly useful when your business has a foreign patent application pending, and intends to request a modified substantive examination once the foreign patent is granted.

After the examination, if the invention is found to be patentable, a certificate of the granting of the patent will be issued and the applicant will be informed. According to the MyIPO, the overall process for patent registration usually takes about 26 months (for ordinary examinations). Patent applications that are assisted by requests for expedited examination usually take around 20 months. The length of time required for patent registration may be longer, depending on the complexity of the invention and adequateness of the submitted documents.

WHO can register?

Individuals or corporate entities can register patents. The inventor does not have to be a Malaysian citizen or a Malaysian corporation.

Which LANGUAGES can I use?

All documents submitted must either be in English or in the national language of Malaysia (Bahasa Malaysia).

How much does it COST?

The fees for patent registration in Malaysia vary, depending on whether the application is filed online or manually. The basic fees for obtaining patent registration start from MYR 1210 (approximately EUR 268) for e-filing and MYR 1390 (approximately EUR 308) for manual filing.

Patent TIPS and things to WATCH OUT for in Malaysia

- Conducting a patent search, to ensure that the proposed application is patentable, is advisable. You can run a search at the MyIPO portal: <http://www.myipo.gov.my/en/search-patent/?lang=en>.
- Applicants may request that the Registrar undertakes an expedited examination if any of the following reasonable grounds are available:
 - It is in the national or public interest;
 - There are infringement proceedings taking place, or evidence showing potential infringement, with regards to the patent being applied for;
 - The applicant has already commercialised the invention or plans to commercialise the invention within 2 years of the filing date of a request for expedited examination;
 - The application is a condition for obtaining monetary benefits from the Government or institutions recognised by the Registrar;
 - The invention relates to green technologies that will enhance the quality of the environment or conserve energy resources.
- Applicants can consider using either the PPH or ASPEC accelerated programmes to shorten the patent registration process in Malaysia.

For more information on patent protection in Malaysia, check out our **South-East Asia IPR SME Helpdesk Guide to Patent Protection in South-East Asia**, which is available to download from our website: https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/EN_patent.pdf.



C. Designs

WHAT are industrial designs?

An industrial design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features such as the shape and configuration of an article, or two-dimensional features, such as pattern and ornamentation. The design features must be applied to an article by any industrial process or any other means that make features in the finished article appeal to the eye.

The registered design allows the owner to control its use and exploitation, and stop others from copying, making, selling or importing (without permission) any product with an identical design.

Industrial designs in Malaysia: What you need to know

In order to be registrable, a design must be new. An industrial design is not considered to be new if it has been disclosed to the public anywhere in Malaysia or elsewhere before the date of the initial filing. However, an industrial design shall not be deemed to have been disclosed to the public if, within the period of six months preceding the filing date:

- It appeared in an official or officially recognised exhibition;
- It had been disclosed by a person other than the applicant or his predecessor in title as a result of an unlawful act committed by that other person or another person.

It is possible to claim priority for an earlier application to protect the same design filed in a country that is a member of the Paris Convention, provided that the Malaysian application is filed within six months of the earlier application date.

In Malaysia, industrial design is a distinct IP protection. In some aspects it is more akin to, and in some instances may overlap with, copyright protection. If a design is registered under any written law relating to industrial design then no copyright protection subsists.

The designs of certain types of articles are specifically excluded from design registration in Malaysia. A design is not registrable if:

- It concerns an insignificant aesthetic feature pertaining to the appearance of an article, or the design features differ only in immaterial details;
- It is a method or principle of construction;
- It is contrary to public order or morality;
- The design of the article is conditioned exclusively by its functions;
- The design is for articles that are integral parts of other articles and whose features are dependent upon the appearance of the other articles.

How LONG does legal protection last?

A registered industrial design is given an initial protection period of 5 years (from the date of filing) and is extendable for a further 4 consecutive terms of 5 years each. The maximum protection period is 25 years.

HOW do I register?

An application for registering industrial designs in Malaysia must be made using the official form and can be submitted either manually or [online](#). The application should be accompanied by the following:

- A completed application form in Bahasa Malaysia or English;
- One copy or representation of the article to which the design is applied (drawings or photograph);
- A statement of novelty in respect of the industrial design applied for;
- Priority details and supporting document (certified copy of the earlier application), if any;
- The filing fee.

Applications in person can be made at:

Industrial Designs Registration Office
Intellectual Property Corporation of Malaysia (MyIPO)
 Unit 1-7, Aras Bawah, Tower B, Menara UOA Bangsar,
 No. 5, Jalan Bangsar Utama 1, 59000 Kuala Lumpur, Malaysia
 IP Online Helpdesk: +603-22998418 / +603-22998420
 Industrial Designs Helpdesk email: idthechsupport@myipo.gov.my
 MyIPO website: <http://www.myipo.gov.my/>

For detailed information on how to file an industrial design application, please see MyIPO's guideline [here](#).

The Registrar will conduct a formality check, examination and novelty search. According to the MyIPO, the registration process (from the acceptance of the completed application form, documentation and prescribed fees, to the granting of the certificate) usually takes around 8 months.

WHO can register?

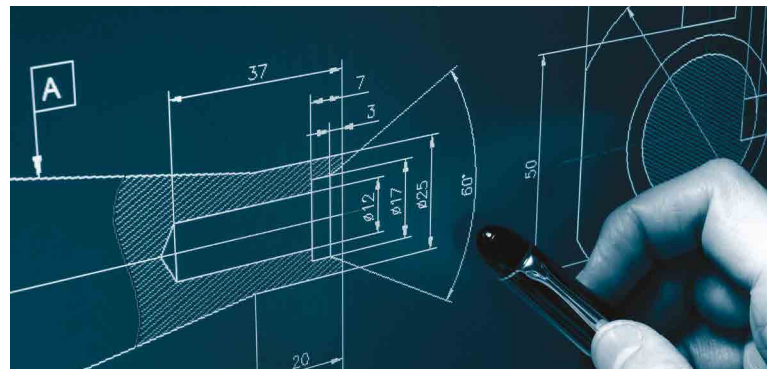
Individuals or corporate entities can register industrial designs. The designer is not required to be a Malaysian citizen or a Malaysian corporation. If an applicant's ordinary residence or principal place of business is outside Malaysia, the applicant shall appoint an agent registered in the Register of Industrial Designs Agents.

Which LANGUAGES can I use?

All the documents submitted must either be in English or the national language of Malaysia (Bahasa Malaysia).

How much does it COST?

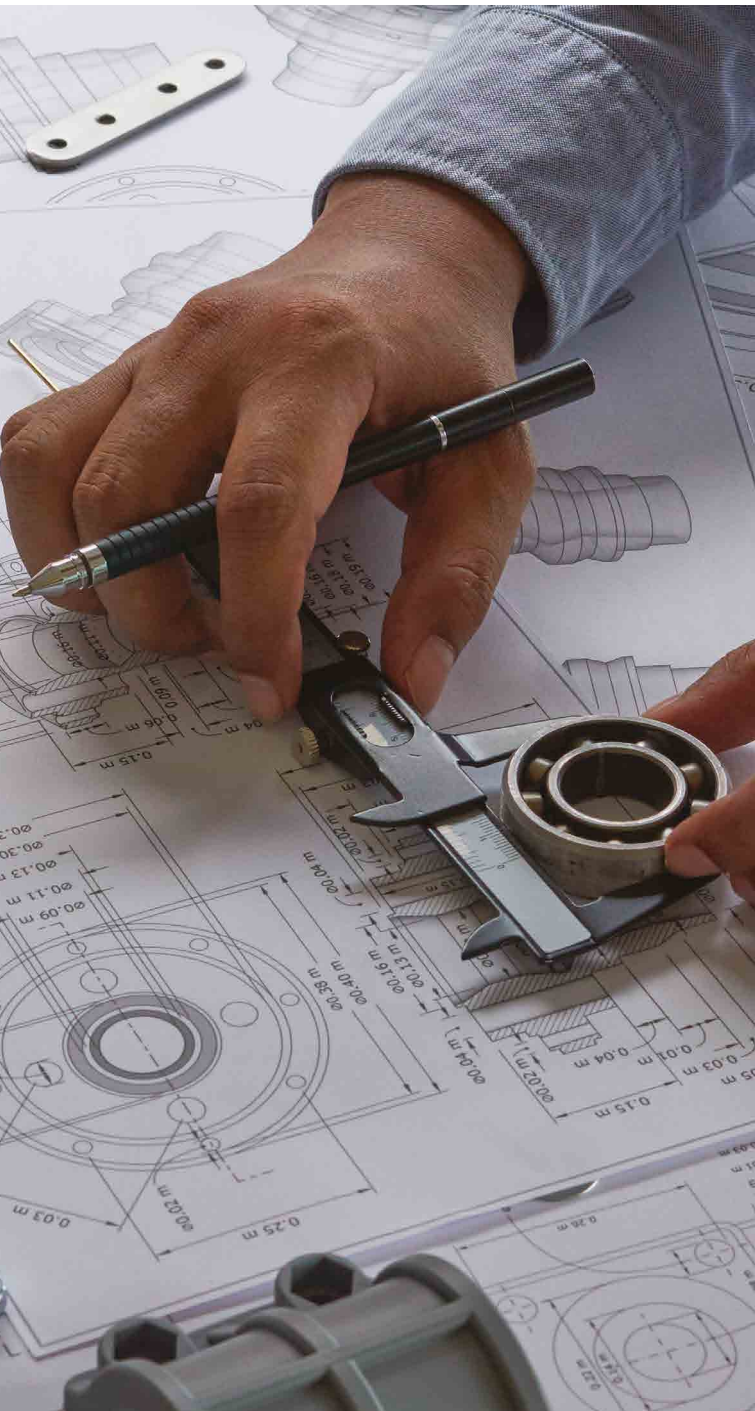
The basic fee for filing an application for a single industrial design in Malaysia is MYR 480 (approximately EUR 106) for e-filing or MYR 500 for manual filing (approximately EUR 111), plus MYR 200 (approximately EUR 44) in relation to the publication of each view of the representation contained in the application.



Industrial design TIPS and things to WATCH OUT for in Malaysia

- An industrial design has to be new in Malaysia or elsewhere if it is to be registrable.
- Conduct a pre-filing search to find out the registration availability of your industrial design. You can run a search via the MyIPO portal: <http://www.myipo.gov.my/en/search-industrial-design/?lang=en>.
- When registering wallpaper, lace or textile articles, a statement of novelty in respect of the industrial design applied for is not required.

For more information on industrial design protection in Malaysia, check out our **South-East Asia IPR SME Helpdesk Guide on Industrial Designs Protection in South-East Asia**, which is available to download from our website: https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/industrial_designs_protection_in_south-east_asia.pdf.



D. Trade Marks

WHAT are trade marks?

A trade mark may be a letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion or any combination thereof. A trade mark is used for the purpose of distinguishing the goods or services of one trader from those of others.

By registering a trade mark, SMEs gain the exclusive right or use of the trade mark in relation to the goods and services applied for. In general, SMEs will be able to stop third parties from using an identical or confusingly similar trade mark.

Trade marks in Malaysia: What you need to know

In Malaysia, a trade mark is prohibited from being registered if: its use is likely to deceive or cause confusion to the public; it is identical with (or closely resembles) a well-known mark in Malaysia that represents the identical goods or services of another proprietor; it is identical with (or closely resembles) a mark well-known in Malaysia for the non-identical goods or services of another proprietor, the use of which would indicate a connection to the well-known mark proprietor, or be likely to confuse and damage the interests of the well-known mark proprietor; it is designed to deceive or mislead the public as to the nature, quality or geographical origin of the goods or services in question.

Malaysia is party to the Paris Convention (see more details and a full list of members [here](#)). This allows SMEs to make a 'priority claim' for registration. This right means that, on the basis of a regular initial application filed in one of the contracting states to the Paris Convention, the applicant may (within six months) apply for protection in any of the other contracting states. These subsequent applications will be treated as if they had been filed on the same day as the initial application. In other words, they can have priority over earlier applications.

The trade mark registration system in Malaysia follows a 'first-to-use' model, which means that the prior use of a trade mark establishes the rights to it. However, obtaining a trade mark registration in Malaysia is advisable, because a trade mark that is not registered may be difficult to enforce. It is worth noting that the registration certificate issued by the MyIPO is used as prima facie evidence of trade mark ownership.

Malaysia's new Trademarks Act 2019 recently came into force (on 27 December 2019). This is a significant milestone, as it introduces substantial and long-awaited changes to trade mark legislation in Malaysia, and aligns Malaysia's trade mark system with current international standards. Notable changes include:

- **Accession to the Madrid Protocol** — Foreign companies can now seek to protect their marks in Malaysia by submitting an international trade mark application in their home office and choosing Malaysia as one of the designate countries. The Madrid system, administered by the WIPO, is a convenient and cost-effective solution for registering and managing trade marks worldwide. The system allows the

brand owners to seek the protection of their trade marks in up to 122 countries by filing one application, using one language and paying one set of fees. Except Myanmar, all ASEAN countries are now members of the Madrid system.

- **Registration for non-traditional marks** — Non-conventional marks such as colours, sounds, scents, holograms, positioning, and motions are now registrable in Malaysia.
- **Multi-class applications** — While the old system only permitted single-class applications, the new Act has introduced multi-class applications to facilitate the process of protecting a mark across several classes of goods and/or services.
- **Late filing of application documents** — The new Act allows, in the event that formalities are not complied with, the filing to be deferred to a date when the non-compliance issue has been remedied. It is important for all information to be included at the time of filing, including the translation and transliteration of any mark in a foreign language. For collective mark and certification mark applications, the appropriate documents must also be filed within 2 months to avoid a later filing date being issued.
- **Stricter laws against infringement** — The old law stated that trade mark infringement only occurred if an identical or similar mark was used on goods and/or services that were identical to those covered by the earlier mark. The new Act allows for trade mark infringement to be established even in cases where the goods and/or services are not identical, but similar, if the similarity is likely to cause confusion.

How LONG does legal protection last?

Trade mark registration lasts for 10 years from the date of the application.

A trade mark registration is renewable every 10 years. It is good practice to renew trade mark registration before it expires to avoid missing the renewal date.

HOW do I register?

An application for registering trade marks in Malaysia must be made using the official form and can be submitted either manually or online. The application should be accompanied by the following:

- Information of the applicant;
- Clear indication of the nature of the trade mark and a description of the trade mark (if the nature of trade mark is the shape of goods or their packaging, a colour, sound, scent, hologram, positioning, or a sequence of motions);
- A graphical representation of the trade mark;
- If a trade mark contains or consists of a word which is not in Roman characters, Bahasa Malaysia, or English, the applicant shall provide a translation of the word in Bahasa Malaysia or English and its transliteration;
- List of goods/services of the intended trade mark application;
- Priority claim (if any);
- Appointment of agent (if any);
- Application fees.

The application can be made in person at the following address:

Registry of Trade Marks

Intellectual Property Corporation of Malaysia (MyIPO)
Unit 1–7, Aras Bawah, Tower B, Menara UOA Bangsar,
No. 5, Jalan Bangsar Utama 1, 59000 Kuala Lumpur, Malaysia
IP Online Helpdesk: +603-22998418 / +603-22998420
Trade Mark Helpdesk email: tmtechsupport@myipo.gov.my
MyIPO website: <http://www.myipo.gov.my/>

If the applicant does not reside or carry out their principal business in Malaysia, a registered trade mark agent must be appointed to file the application and work with MyIPO on the applicant's behalf.

Once an application has been filed, it will be examined for registration purposes within a year of the filing date. If there is no objection raised by the examiner, the application will be published for public inspection. If there is no opposition filed within two months of the publication date, the mark will proceed to registration. The overall registration process will usually take around 12 months from the filing date if no issues are encountered.

Expedited examination request

The applicant can submit a request for expedited examination (within 4 months) of the filing date if:

- It is in the national or public interest;
- There are infringement proceedings taking place or evidence showing potential infringement in respect of the trade mark applied for under Regulation 18;
- The registration of the trade mark is a condition for obtaining monetary benefits from the government or institutions recognised by the Registrar;
- There are other reasonable grounds that support the request.

If the examiner is satisfied with the reason for expedited examination, the trade mark is found to be registrable and no opposition is filed, the application can be processed and registration granted within 7 months. However, the expedited examination process is not available for colour, sound, scent, hologram, positioning, sequence of motion, collective and certification marks.

WHO can register?

Any individual or a corporate entity can register a trade mark. If the applicant resides abroad, a service address in Malaysia must be provided. A trade mark agent must be engaged for this purpose.

Which LANGUAGES can I use?

All documents submitted must either be in English or Bahasa Malaysia.

How much does it COST?

The basic filing fee (excluding agent costs) for trade mark registration in Malaysia starts from MYR 950 (approximately EUR 211).

Trade mark TIPS and things to WATCH OUT for in Malaysia

- Before filing a trade mark application, conducting pre-filing searches to establish if there are any prior identical or similar marks that may prevent your trade mark from being registered in Malaysia is highly recommended. You can run trade mark searches at MyIPO Online Search, ASEAN TMview or the WIPO Global Brand Database.
- Preliminary advice and searches. The MyIPO also allows applicants to apply to the Registry for preliminary advice and searches (prior to submitting a trade mark application), to establish registrable availability in Malaysia. The searches are conducted for both absolute grounds and relative grounds and the results are available within one month of the date on which the request was made. As Malaysia has a multi-racial, multi-cultural and multi-religious society (Islam, Christianity, Hinduism, Buddhism), getting affirmative search results from the MyIPO may help to avoid applying for the registration of a trade mark that may have an undesired meaning or could be deemed offensive.
- Voluntary disclaimer: if your trade mark contains any elements that are likely to be rejected (e.g. lack of distinctive character), you may consider offering a voluntary disclaimer in relation to that element when filing the application to avoid the delays and costs related to possible objections from the MyIPO.
- Pre-approved lists of good/services are contained in the Nice Classification and the Madrid Goods & Services Manager. The applicant will enjoy lower filing fees if their application pertains to the goods/services chosen from these pre-approved lists.
- You should keep in mind that Malaysia is a first-to-use system. Therefore, even if your application precedes that of a competitor, if they were the first to use the trade mark, they will legally prevail and be recognised as the owner of the trade mark in question.
- If ownership of a well-known mark can be proven, the initial user of the mark in Malaysia can be legally defeated (if the initial use of the mark was after the date that new Trademarks Act 2019 came into force). The sale of a product over the internet qualifies as use of a trade mark in Malaysia.
- Revocation due to non-use: after registration is granted, you should put your trade mark to use to avoid it being removed from the register (due to non-use over a 3-year period). By supplying evidence of non-use, any third party can submit a request to the court to have an inactive registered trade mark revoked.

For more information on trade mark protection in Malaysia, check out our [South-East Asia IPR SME Helpdesk Guide to Trade Mark Protection in South-East Asia](https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/sea-trademarks-ea-02-20-035-en.pdf), which is available to download from our website: <https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/sea-trademarks-ea-02-20-035-en.pdf>.

E. Geographical indications (GIs)

WHAT are GIs?

A GI is a distinctive sign used to identify a product as originating in the territory of a particular country, region or locality where its quality, reputation or other characteristic is linked to its geographical origin. GIs differ from trade marks in the sense that GIs may be used by all producers or traders whose products originate from that place and share a particular quality, reputation or other characteristics, while trade marks may only be used by the trade mark owner, or with the owner's consent. 'Champagne' from France and 'Parmigiano Reggiano' from Italy are examples of European GIs while 'Sabah Tea' and 'Sarawak Pepper' are examples of Malaysian GIs.

GIs in Malaysia: What you need to know

GIs have been available for registration and IP protection in Malaysia since 2001. The Geographical Indications Act 2000 defines GI as an indication which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin.

GIs that are contrary to public order or morality or territory of origin; or which are not or have ceased to be protected in their country or which have fallen into disuse in their country or territory of origin.

How LONG does legal protection last?

A registered GI is protected for 10 years from the date of filing and is renewable every 10 years, as long as it is still in use.

HOW do I register?

Applications for registering GIs in Malaysia must be made using the official forms and can be submitted either manually or [online](#). The application should be accompanied by the following:

- Applicant's information;
- Statutory Declaration;
- GI name;
- Geographical area (additional information, possibly in graphic forms, maps);
- Type and description of product;
- The quality, reputation or other characteristics of the product;
- The link between the geographical area and a specific characteristic of the product (e.g. soil condition, climate characteristics, human factor, etc.);
- Application fees.

The application in person can be made at:

Registrar of Geographical Indications
Intellectual Property Corporation of Malaysia (MyIPO)
Unit 1-7, Aras Bawah, Tower B, Menara UOA Bangsar,
No. 5, Jalan Bangsar Utama 1, 59000 Kuala Lumpur, Malaysia
IP Online Helpdesk: +603-22998418 / +603-22998420
MyIPO website: <http://www.myipo.gov.my/>

If the applicant does not reside or do business in Malaysia, they are required to appoint an agent to work with the MyIPO on their behalf.

If the Registrar is satisfied, after examining the application for registration, that the application has complied with the requirements and that the GI is not contrary to public order or morality, it will be advertised for public inspection for a period of 2 months. If no opposition is filed during this period, the GI will proceed to registration.

The overall process for GIs usually takes around 8 months if no issues are encountered.

WHO can register?

The following people are entitled to file an application for the registration of a GI in Malaysia:

A person carrying out an activity as a producer in the geographical area specified in the application with respect to the goods specified in the application. The registration of the GI is based on an affiliation ownership concept for the producers who are carrying on an activity in the specified geographical area and not an individual ownership concept. A GI can also be registered by a competent authority, such as a local authority, government agency, statutory body, trade organisation or association.

Which LANGUAGES can I use?

Applications can be made in English or Bahasa Malaysia.

How much does it COST?

The filing fee (excluding agent costs) for GI registration in Malaysia is MYR 250 (approximately EUR 60), followed by MYR 450 (approximately EUR 100) for the advertisement and issuance of the certificate.

GI TIPS and things to WATCH OUT for in Malaysia

- To file a GI application in Malaysia you have to carry on an activity as a producer in the geographical area, or be a competent authority or a trade organisation or association.
- To file an application, a detailed description of the GI and a clear map of the location in question is required.

For more information on Geographical Indications in Malaysia, check out our **South-East Asia IPR SME Helpdesk Guide to Geographical Indications in South-East Asia**, which is available to download from our website: https://www.southeastasia-iprhelpdesk.eu/sites/default/files/sea_geographical_indications_guide_ea-01-20-199-en-n.pdf



F. Trade Secrets

WHAT are trade secrets?

Trade secrets are recognised in Malaysia and qualify for IP protection there. Some examples of confidential information (i.e. trade secrets) include manufacturing processes, formulas and even information relating to customers, suppliers, cost prices and customer requirements. In general, substantial time and effort are required for information of this nature to legally qualify for protection, as it must satisfy these three criteria:

- The information must be confidential and not generally known to the public;
- The recipient of the information must have been made aware of their obligation to keep the information confidential (e.g. through signing a confidentiality agreement);
- The information must have been used, in an unauthorised way, to the detriment of the trade secret owner or their business.

To help prove that the information in question is confidential, SMEs will need to demonstrate the measures taken to identify and safeguard it (e.g. signing non-disclosure agreements, marking documents as confidential, protecting electronic data with a password, etc.). When enforcing trade secrets in legal cases, it is also better to identify specific information as opposed to generalised information, and where possible, to express this information in a tangible form so SMEs can distinguish it from ordinary information that an employee could acquire through their daily work. Supporting this, it is important to consider how such information is managed within the company — restricting access to information can both prevent trade secrets from being lost in the first place and the measures themselves can be used to demonstrate to courts that steps were taken to keep information confidential.

Trade secrets in Malaysia: What you need to know

It is advisable for EU SMEs to incorporate confidentiality terms in employment contracts to protect confidential information or trade secrets. The term 'confidential information' in contracts should also be defined in sufficiently broad terms, even including information created by the employees in the course of their employment. Such express terms are useful for two important reasons — firstly, to facilitate the manner in which the company's confidential information can be managed and used by employees, and secondly, to draw the employees' attention specifically to their duty to guard company secrets (and to pre-empt any later claims of ignorance or lack of knowledge).

Legal protection for trade secrets depends on the facts of each case. Because there is no formal registration process for trade secrets, these are often referred to as 'unregistered rights'.

In theory trade secrets may last forever, as long as the information does not become available in the public domain (for example, the Coca-Cola™ recipe was never patented and still remains a trade secret). Despite being unregistered, trade secrets are recognised in Malaysia and rights related to them can therefore be enforced, provided SMEs can prove that the secrets are non-public, the use or abuse of them is to the company's detriment and that they took measures to protect their confidentiality.

Trade secret TIPS and things to WATCH OUT for in Malaysia

- Be mindful that you should insert confidentiality clauses in employment contracts.
- For dealings with external parties, it is always advisable to require them to sign a non-disclosure agreement (NDA) before divulging any of your confidential information. The NDA should expressly impose an obligation of confidence on the receiving party to not misuse your confidential information to the detriment of your company. The confidentiality obligation extends even to third-party recipients who know, or are reasonably expected to have knowledge, of the confidential nature of the information in question.

For more information on trade secret protection in Malaysia, check out our **South-East Asia IPR SME Helpdesk Guide to Protecting Your Trade Secrets in South-East Asia**, which is available to download from our website: https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/en_trade_secrets_201704.pdf



4) Using CUSTOMS to Block Counterfeits

HOW can customs help in protecting IP?

The competent authority for the enforcement of IPR in Malaysia is the MDTCA. The Royal Malaysian Customs Department enforces IPR under an ex-officio capacity provided for under Sections 81–94 of the Trademarks Act 2019. Customs are authorised to detain goods (suspicious of infringing or counterfeit), only when a complaint is lodged to the Registrar of Trade Marks under the MDTCA.

Customs in Malaysia: What you need to know

There is no system available for registering IP with customs so that counterfeit products can be detained. If SMEs suspect that counterfeit versions of their products are going to be imported into Malaysia they can, however, apply to the Registrar of Trade Marks to invoke a seizure. They must provide certificates proving the ownership of the trade mark that the expected counterfeits infringe, and provide information relating to the goods and the shipment to enable the customs officers to identify the imported goods and detain them. SMEs also have to file a civil suit to obtain an order preventing the goods from being released. It should also be noted that, if the goods have been seized and the company fail to commence civil action within the retention period, the person that owns the seized goods may apply to the court for compensation. If the court is satisfied that the person aggrieved had suffered loss or damage as a result of the seizure of the goods, they may order the company to pay the amount of compensation which they think fit.

Customs TIPS and things to WATCH OUT for in Malaysia

- While you cannot directly apply to the Royal Malaysian Customs Department to detain or seize goods, if you suspect that counterfeit versions of your products are going to be imported into Malaysia you can apply to the Registrar of Trade Marks to invoke a seizure or to file a complaint with the Enforcement Division of the MDTCA.
- When applying for a seizure of goods, you should be prepared to follow through with civil litigation within the legal timeframe, otherwise the person that owns the seized goods may apply to the court for compensation.
- There may be a substantial retention fee to be paid in relation to the seizure of goods.
- To file a complaint with the MyIPO (who will then liaise with the ED of the MDTCA in relation to cases of counterfeiting) you have to have a registered trade mark in Malaysia.



5) ENFORCING your IP

Besides using customs to block counterfeits (as described in the previous section), when IP assets are being infringed in Malaysia, there are two main avenues of enforcement: criminal enforcement, which involves lodging complaints with the MyIPO or the ED of the MDTCA, and civil litigation. In many cases however private mediation via legal professionals is more effective and should be considered as a viable option, particularly for SMEs with budget limitations.

Criminal enforcement

In Malaysia complaints can be lodged with the MyIPO or the ED of the MDTCA for cases in relation to counterfeiting or piracy. The complaint will be acted upon by the ED, MDTCA and they have the power to seize products and prosecute offenders/counterfeiters. These actions are quite efficient and can be cost-effective. In brief, the owner of the IPR has to provide the MyIPO or the ED of the MDTCA with documents to prove their rights, an investigation report to show the infringing activity, and also a letter of complaint. Enforcement by the ED MDTCA is also recommended because it provides for the immediate confiscation of infringing goods. The actions undertaken by the MDTCAED can include raids against suspected counterfeiters or people dealing in pirated goods. Any goods found at the premises in question can be seized. Subsequent to the seizures, the matter will be investigated by the EDMDTCA. They can fine the infringer or prosecute them in court. It should be noted that a brand or right owner helps the ED of the MDTCA to initiate the action against counterfeiters or people dealing in pirated goods. Although SMEs can rely on the authorities to initiate the action and complete the investigation, they have to support it (by identifying the seized goods for example, or appearing as a witness in court if necessary).

Civil litigation

In cases of trade mark or copyright infringement, rights owners also have recourse to a civil suit in the High Court. An action can be filed against the infringers, usually resulting in an injunction (i.e. a court order obliging the infringer to immediately stop their infringing activities), and damages to be paid to the rights owner. In 2010, the Chief Justice issued a direction stating that civil cases should, as far as possible, proceed to trial within nine months of the filing date. This has helped to ensure that the backlog of cases in the courts is minimised.

IP courts in MALAYSIA

In 2007 the judiciary introduced dedicated IP courts: 15 'Sessions Courts' to sit in each state, and 6 'High Courts' to sit in certain states (i.e. Kuala Lumpur, Johor Darul Ta'zim, Perak Darul Ridzuan, Selangor Darul Ehsan, Sabah and Sarawak). The purpose of assigning special IP courts is to give proper attention to IP cases in the criminal and civil courts, and

ensure that the judges hearing these cases are equipped to handle IP issues. Due to the small volume of cases, the designated IP courts only sit in the High Court and Sessions Court in Kuala Lumpur.

These Sessions Courts (lower courts) hear criminal cases, and can impose fines for IP infringing acts. There is no limit to the fines that they can impose. The High Courts are designated for civil cases, because in these IP cases the damages are usually unquantifiable until they have been assessed post-trial. The High Court can impose injunctions (i.e. court orders obliging the infringer to immediately stop their infringing activities) and also award unlimited monetary damages. The IP courts are considered to be a great success in Malaysia, as they process IP cases much more efficiently than before.

Enforcement TIPS and things to WATCH OUT for in Malaysia

- Making complaints to the ED entails a commitment to assisting and supporting the investigation of the complaint until its resolution. You, as brand owner, play a supporting role in initiating the action against counterfeiters or people dealing in pirated goods. This may include attending court proceedings for criminal prosecutions.
- No matter which enforcement route you take, you will need to prepare and collect evidence to show that you are the owner of the IPR in question in Malaysia (e.g. provide your Malaysian trade mark registration certificate), and show proof that the IPR has been infringed by a third party.
- The specialised IP courts introduced by the Malaysian government are very efficient at addressing issues relating to IPR and appear to be the most advisable enforcement route.



6) RELATED LINKS and Additional Information

- South-East Asia IPR SME Helpdesk website — <http://www.southeastasia-iprhelpdesk.eu/>
- IPR Helpdesk blog, for all the latest news and information on IP in South-East Asia and China — <http://www.youripinsider.eu/>
- MyIPO — <http://www.myipo.gov.my/>
- EU Delegation to Malaysia — https://eeas.europa.eu/delegations/malaysia_en
- Royal Malaysian Customs Department — <http://www.customs.gov.my/>
- Ministry for Domestic Trade and Consumer Affairs — <https://www.kpdnhep.gov.my/en/>
- Ministry for Domestic Trade and Consumer Affairs — <https://www.kpdnhep.gov.my/en/>
- WIPO — <http://www.wipo.int/>
- ASEAN IP Portal — <http://www.aseanip.org>



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