

MALAYSIAN BRANDS ABROAD: A BEGINNER'S GUIDE TO PROTECTING YOUR BRAND INTERNATIONALLY

Expanding a brand beyond domestic borders has become a crucial step for businesses seeking growth and sustainability in today's interconnected world. Introducing a brand to the global market presents numerous opportunities, but it also comes with its fair share of challenges. One of them is to ensure that effective measures have been taken in order to ensure that the brand is being protected in each of the countries where the business is being conducted. In this article, we will explore the topic of international trademark registration to help Malaysian companies and entrepreneurs understand how to safeguard their brands in global market.

The Essence of Trademark Registration

Trademark registration is vital for brand protection. When successfully registered, the owner gains exclusive rights conferred by the local law such as the right to exploit the registered trademark and the right to prevent any other third party from using identical or similar mark to the registered trademark. In Malaysia, trademarks can be registered through the Intellectual Property Corporation of Malaysia ("**MyIPO**") for a period of ten (10) years, renewable indefinitely.

Expanding your business globally requires protecting your brand in each target country. Trademark rights are territorial and valid only within specific countries or regions. Generally, separate trademark applications must be filed in each country for brand protection. However, Malaysia offers an alternative route through the Madrid System, a centralized filing system of trademark applications and streamlined management of registrations.


Madrid System

The Madrid System is a highly convenient and cost-effective system administered by the World Intellectual Property Organization ("**WIPO**") offering one-stop solution for any eligible person to file an international application in one single application form, by designating the

countr(ies) or region(s) that have already become the contracting parties to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("**Madrid Protocol**"). The current list of the contracting parties to the Madrid Protocol can be accessed via <https://www.wipo.int/madrid/en/members/>.

The Madrid System, as a centralized system may also be utilized to manage international registration such as to track the current status of an international trademark application, to perform renewal and to apply for subsequent designation in case there is a need to expand the territory where the trademark protection is to be sought. The international trademark application process has become easier since the application can be made in one language i.e. English language which eliminate the need for translation services and the applicant is only required to pay one set of fees in one currency i.e. in Swiss francs.

Examples of Malaysian Brands Benefiting from the Madrid System:

1. '  **Julie's** ' mark by Julie's Manufacturing Sdn. Bhd.

'Julie's' is a renowned name in the Malaysian biscuit industry. The brand, known for its delectable range of biscuits, pastry, confectionery and other cereals-based products, take their local success to an international scale. The company has designated several countries under the Madrid Protocol, from Middle Eastern nations like Bahrain and Egypt to countries with emerging economies like Mexico and Colombia. The company also protect its brand in markets like Azerbaijan, Ghana, Iran, Democratic People's Republic of Korea, Kazakhstan, Mongolia and Tunisia.

2. 'NEUTROVIS' mark by Maystar Beauty Sdn Bhd

One brand that comes to mind when it comes to face masks is Neutrovis. Maystar Beauty Sdn Bhd, understanding the importance of brand identity, has protected its 'NEUTROVIS' mark as the company penetrate the Southeast Asian market. By designating countries like Brunei Darussalam, China, Indonesia, Cambodia, Lao People's Democratic Republic, Philippines, Singapore, Thailand and Viet Nam under the Madrid Protocol, the company's brand is safeguarded against potential infringements.

Checklist: Filing an international application using the Madrid System

An international application for registration of a trademark via the Madrid System shall be made through the MyIPO as the office of origin ("**International Application**"). The following checklist are some of the matters that requires the applicant's attention for the filing of the International Application:

No.	Checklist	Explanation
1.	<p>Check your eligibility criteria</p>	<p>(a) The status of the applicant The applicant must be:</p> <ul style="list-style-type: none"> (i) a citizen of Malaysia; (ii) a body or corporation incorporated or constituted under the law of Malaysia; (iii) a person domiciled in Malaysia; or (iv) a person who has a real and effective industrial or commercial establishment in Malaysia. <p>(b) Basic Mark The applicant must have already filed an application for registration of the trademark or registered the trademark in Malaysia ("Basic Mark"). The Basic Mark and the International Application must be an identical mark, owned by the same applicant and having the same or narrower list of goods and/or services.</p> <p>Before applying for Basic Mark, it is crucial to conduct a search to check if the proposed trademark is eligible for protection and if it has already been registered or applied for by someone else. The Malaysian Trademarks Act 2019 provides the relevant information pertaining to eligibility of protection and the MyIPO Online Search and Filing System can be utilized for trademark search purposes.</p> <p>Furthermore, it is also crucial to choose your trademark carefully due to the risk of a central attack. Central attack occurs when a Basic Mark ceases to be effective within five-year dependency period ("Initial Period") due to rejection, withdrawal, cancellation or other reasons, in which cases the International Registration ("IR") will be cancelled accordingly. In other word, the IR's validity relies on the existence and status of the Basic Mark during the Initial Period.</p>
2.	<p>Conduct trademark search</p>	<p>Before filing the International Application, the applicant should conduct trademark searches in the designated countr(ies) or region(s) from the contracting parties ("Designated Countr(ies)") to ensure that the proposed trademark is not similar or identical to a well-known mark and to check whether the trademark has already been registered or applied for registration by another party for the same goods or services. Online databases such as TMview, ASEAN TMview and the WIPO Global Brand Database can be utilized.</p>

No.	Checklist	Explanation
3.	<p>Required details for the purpose of filing the International Application</p>	<p>(a) The information of the applicant This includes, among others, the name, address, email address and telephone number of the applicant.</p> <p>(b) The details of the Basic Mark (i) If the Basic Mark is yet to be registered in Malaysia, to provide the basic application number and the date of basic application of the Basic Mark; or (ii) If the Basic Mark has been registered in Malaysia, to provide the basic registration number and the date of registration of the Basic Mark.</p> <p>(c) Priority claimed The details of the priority claimed (in case the applicant is keen to apply for priority of an earlier filing) such as the office of the earlier filing, the number of earlier filing (if applicable) and the date of earlier filing.</p> <p>(d) Representation of the proposed trademark The softcopy of the representation of the proposed trademark in accordance with the requirements set by the WIPO.</p> <p>(e) Claim as to the colour (if any) Information as to the colour(s) claimed by the applicant (in case the applicant claims colour(s) as a distinctive feature of the proposed trademark).</p> <p>(f) Miscellaneous indications This includes, among others, the transliteration and/or translation of the proposed trademark, the description of the proposed trademark (as it may be required for certain designations) and the voluntary disclaimer (if the applicant wishes to disclaim protection for certain element(s) of the proposed trademark).</p> <p>(g) Goods and services The list of goods and services to be covered under the International Application (which must have already been covered in the Basic Mark).</p> <p>(h) Designated Countr(ies) The name of the countr(ies) or region(s) to be included in the Designated Countr(ies).</p> <p>(i) The signature of the applicant (if any) Only applicable if required by the MyIPO.</p>

The fees for filing the International Application

The breakdown of the fees for filing one (1) International Application (either in a single class or multiple classes) can be seen as follows:

Matters	Official Fees RM/CHF
<p><u>Application through MyIPO as the office of origin</u></p> <p>(i) Handling Fee Charged by MyIPO</p> <p>(ii) Fee to be paid to WIPO:</p> <p>a. Basic fee:</p> <ul style="list-style-type: none"> • basic fee (black/white reproduction of the mark); or • basic fee (reproduction of the mark is in colour); <p>and</p> <p>b. Fees for designated country:</p> <ul style="list-style-type: none"> • a complementary fee per Designated Countr(ies); and • a supplementary fee per class of goods and/or services beyond three classes in the International Application; <p>or</p> <ul style="list-style-type: none"> • an individual fee for those designated countries or regions that require it. This fee replaces both complementary and supplementary fees. (The WIPO has published a list of countries and regions that implement the individual fee together with the corresponding fee which is accessible via link https://www.wipo.int/madrid/en/fees/ind_taxes.html.) 	<p>RM200.00</p> <p>CHF 653 CHF 903</p> <p>CHF 100 CHF 100</p> <p>Varies</p>

Summary of the process of International Application

There are three (3) basic steps in the process of filing the International Application (in case of a smooth application):

1. Application through MyIPO as the office of origin	An International Application shall be filed through MyIPO using Forms MM2 and TMMP1 to MyIPO. MyIPO will review and certify the International Application and thereafter forward Form MM2 to WIPO. This stage will take approximately two (2) months.
2. Examination of formalities by WIPO	<p>(a) WIPO will conduct only a formal examination of the International Application. This means that it does not refuse or grant trademark protection. WIPO simply checks the information presented in the International Application.</p> <p>(b) If the application complies with formal requirements, the applied trademark is recorded in the International Register and published in the WIPO Gazette of International Marks.</p> <p>(c) At this stage, the applicant becomes the holder of an International Registration. WIPO will send a certificate of registration and notify the IP Offices in all the Designated Countr(ies).</p> <p>This stage will take approximately two (2) months.</p>
3. Substantive examination by national / regional IP offices	<p>(a) After receiving a notification from WIPO, the IP offices of the Designated Countr(ies) will conduct substantive examination of the applied trademark in accordance with their laws.</p> <p>(b) Each IP office will decide, within twelve (12) or eighteen (18) months, whether or not the applied trademark can be protected in their territories. WIPO will inform the applicant of their decisions.</p> <p>(c) If an IP Office of the Designated Countr(ies) refuses to protect the applied trademark, either totally or partially, this decision will not affect the decisions of other IP offices.</p> <p>(d) If an IP office of the Designated Countr(ies) accepts the applied trademark, it will issue a statement of grant of protection. The international registration of the trademark is valid in each designated contracting party for ten (10) years. The applicant can renew the registration through the Madrid System at the end of each 10-year period.</p>

By utilizing the Madrid Protocol, Malaysian companies and entrepreneurs can protect their brands internationally, expand into new markets and effectively manage their trademark

registrations. However, it is essential to choose the Basic Mark that is distinctive, conduct thorough searches and make careful preparation prior to and during filing the International Application. Further to the above, be active in managing your international registrations to ensure long-term brand protection and business success.

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