



**INTELLECTUAL PROPERTY CORPORATION
OF MALAYSIA (MyIPO)**

**TRADEMARKS ACT 2019
PRACTICE DIRECTION NO. 1/2021**

1st Issued: 3 November 2021

Revoked: 1 February 2024

**TRADEMARKS ACT 2019
PRACTICE DIRECTION NO. 1/2021**

Effective Date Upon Issuance:	4 November 2021
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LIST OF VARIATIONS / REVOCATION

Variation Series	Variation Date	Effective Date of Variation	Series Number
Revoked	1 February 2024	1 March 2024	(VA1-2024)

TRADEMARKS ACT 2019
PRACTICE DIRECTION NO. 1/2021

THIS PRACTICE DIRECTION is issued in the exercise of the power conferred upon the Registrar of Trademarks by sections 160 and 183 of the Trademarks Act 2019 [Act 815].

PART I

Preliminary

Citation, effective date and scope

1. (1) This practice direction may be cited as the Practice Direction No. 1/2021.
- (2) The Practice Direction No. 1/2021 shall be effective on 4 November 2021 until further notice by the Registrar of Trademarks. Beginning 1 March 2024, this Practice Direction No.1/2021 is hereby revoked.
- (3) This Practice Direction No. 1/2021 sets out the requirements for giving, filing, sending, submitting or serving any documents or any other matter required or authorized by the repealed Act or the Trademarks Act 2019 to, with or on the Registrar of Trademarks by way of email—
 - (a) to be complied with by any applicant for registration, opponent, registered proprietor or any person recognized under the repealed Act or the Trademarks Act 2019; and
 - (b) the documents or any other matter required or authorized by the repealed Act or the Trademarks Act 2019 does not involve any requirement of payment of prescribed fee.

Notes:

No prescribed forms under the repealed Act or model forms under the Trademarks Act 2019 together with proof of payment through instant online transfer is allowed to be filed by way of email.

Any filing of prescribed forms under the repealed Act or model forms under the Trademarks Act 2019 together with proof of payment through instant online transfer via email shall be deemed to be as invalid and to have not been made with the Registrar of Trademarks.

- (4) Beginning from the effective date of the Practice Direction No. 1/2021 any document or any other matter required or authorized by the repealed Act or the Trademarks Act 2019 that does not involve any requirements of payment of prescribed fee may be given, sent, filed, submitted or served to, with or on the Registrar of Trademarks by way of email.
- (5) In order to assist with the interpretation of the requirements under this Practice Direction No. 1/2021 and its application, notes and illustrations have been inserted. Any action or conduct which departs from the notes or illustrations may be taken into account by the Registrar in determining the compliance with this Practice Direction as well as the Trademarks Act 2019, Trademarks Regulations 2019 and Guidelines of Trademarks 2019.
- (6) By complying to this Practice Direction No. 1/2021, the applicant for registration, opponent, registered proprietor of trademark or person recognized under the repealed Act or the Trademarks Act 2019 shall be deemed to have fulfilled the requirement of filing the documents with the Registrar—

- (a) according to regulation 8 of the Trade Marks Regulations 1997;
 - (b) in other manner as directed by the Registrar according to paragraph 30 of the Guidelines of Trademarks 2019; and
 - (c) in other manner as determined by the Registrar according to paragraph 31 of the Guidelines of Trademarks 2019.
- (7) This Practice Direction No. 1/2021—
- (a) replaces and supersedes the Practice Direction No. 2/2020 including the variations made to it on fulfilling the requirements of giving, sending, filing or serving any documents under the repealed Act or the Trademarks Act 2019 to, with or on the Registrar of Trademarks by way of email; and
 - (b) does not replace the availability of filing relevant application at the Trademarks Office or through electronic filing system which is made available by the Registrar of Trademarks.

Interpretation

2. (1) Unless otherwise defined, all words or terms used in this Practice Direction shall have the meaning as defined in the Trademarks Act 2019, Trademarks Regulations 2019 and Guidelines of Trademarks 2019.
- (2) In this Practice Direction No. 1/2021, unless the context otherwise requires, “Practice Direction” means the Practice Direction No. 1/2021.

PART II

Requirements to be complied with in filing document without payment

Filing of document with Registrar

3. (1) Where the repealed Act, the Trademarks Act 2019, the Regulations or the Guidelines of Trademarks 2019 authorize or require any document to be given, filed, sent, submitted or served to, with or on the Registrar,

the giving, sending, filing, sending, submission or service may be made by way of email according to manner stated in paragraphs 3(2) and 3(3).

- (2) For the purpose of giving, filing, sending, submitting or serving as stated under paragraph 3(1), the applicant for registration, registered proprietor or any person recognized under the repealed Act or the Trademarks Act 2019 may do so by emailing the document to **nopaymentcd@myipo.gov.my**.

Note:

- (1) This paragraph is applicable to giving, filing, sending, submission or service of documents which are not subject to any payment of the prescribed fee such as:
- (a) a reply to an objection letter issued by the Registrar under regulation 27 of the Trade Marks Regulations 1997; or
 - (b) a written submission to a provisional refusal issued by the Registrar under regulation 17 of the Trademarks Regulations 2019.
- (2) The maximum capacity of an email together with the attachment to be sent to the Registrar is 10MB. If the applicant or registered proprietor wishes to send an attachment beyond the capacity, the applicant or registered proprietor may do so by sending the email in consequent to the first email sent to the Registrar. If the applicant or registered proprietor is sending more than one emails to the Registrar to respond to the same matter, the title of the email should reflect as follows:

Email 1:

RE: Written Submission for Trademark Application No. 2020123456 (1/3)

Email 2:

RE: Written Submission for Trademark Application No. 2020123456 (2/3)

Email 3:

RE: Written Submission for Trademark Application No. 2020123456 (3/3)

- (3) Upon receiving the document under paragraph 3(2), the Registrar shall issue an email acknowledging the filing made by the applicant, registered proprietor or person recognized under the repealed Act or the Trademarks Act 2019.
- (4) In giving, filing, sending, submitting or service the document under paragraph 3(1), all other requirements stipulated under the repealed Act, Trademarks Act 2019, Trademarks Regulations 2019, Guidelines of Trademarks 2019 and Guidelines of Trademarks (Transitional Matters) 2019, whichever relevant, shall be applicable.

Filing documents under regulations 40, 41, 42, 43 and 46 of the Trade Marks Regulations 1997 and regulations 25, 26, 27, 28 and 30 under the Trademarks Regulations 2019 with Registrar

4. (1) An opponent or applicant for registration of trademark under the repealed Act or the Trademarks Act 2019 may file the documents under regulations 40, 41, 42, 43 and 46 of the Trade Marks Regulations 1997 or regulations 25, 26, 27, 28 and 30 under the Trademarks Regulations 2019 with the Registrar by way of email by fulfilling the requirements under paragraph 4(2) and 7(3).

- (2) For the purpose of filing the documents as stated under paragraph 4(1), the opponent or applicant of registration of trademark may do so by emailing the document to **nonpaymentoppo@myipo.gov.my**.

Note:

The maximum capacity of an email together with the attachment to be sent to the Registrar is 10MB. If the opponent or applicant wishes to send an attachment beyond the capacity, the applicant or opponent may do so by sending the email in consequent to the first email sent to the Registrar. If the opponent or applicant is sending more than one emails to the Registrar on to the same matter, the title of the email should reflect as follows:

Email 1:

RE: Evidence in Support of Opposition for Trademark Application No. 2020123456 (1/3)

Email 2:

RE: Evidence in Support of Opposition for Trademark Application No. 2020123456 (2/3)

Email 3:

RE: Evidence in Support of Opposition for Trademark Application No. 2020123456 (3/3)

- (3) Upon receiving the document under paragraph 4(2), the Registrar shall issue an email acknowledging the filing made by the opponent or applicant.

- (4) In filing the document under paragraph 7(1), all other requirements stipulated under the repealed Act, Trademarks Act 2019, Trademarks Regulations 2019, Guidelines of Trademarks 2019 and Guidelines of Trademarks (Transitional Matters) 2019, whichever relevant, shall be applicable.

REGISTRAR OF TRADEMARKS

1 FEBRUARY 2024

**SUMMARY OF VARIATIONS MADE TO THE
PRACTICE DIRECTIONS NO. 1/2021 (VA1-2024)
(Issued: 1 February 2024)**

The summary of key variations made to the Practice Direction No. 1/2021 (VA1-2024) issued on **1 February 2024** is provided as follows:

1. General		
(a)		Consequential amendment to the Practice Direction and certain other referencing changes following the variations.
(b)		Editorial amendments including insertion and rephrasing of certain paragraphs and schedule without any change in policy.
2. Specific variation		
No.	Paragraph/Schedule	Variation
(a)	Paragraph 1 (2)	<p>Paragraph 1 (2) is amended.</p> <p>This means that this Practice Direction No. 1/2021 is hereby revoked and any filing/submission of forms or documents with the Registrar via email as allowed by this Practice Directions is no longer available beginning on 1 March 2024.</p>