




Perbadanan Harta Intelek Malaysia
Intellectual Property Corporation of Malaysia

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NOTIFICATION OF PROVISIONAL REFUSAL OF AN INTERNATIONAL REGISTRATION DESIGNATING MALAYSIA

1. Office making the notification :
Intellectual Property Corporation of Malaysia (MyIPO)
2. Date of the provisional refusal :
11 August 2021
3. International Registration Number :
1531791
4. Malaysia Trademark Number :
TM2020009837
Class Number(s) : 3, 5, 34, 35, 40
5. Name of the Holder :
Individual entrepreneur Vasily Bogatyrev Alexandrovich
6. Representation of the mark :

7. Basis for refusal :
This total provisional refusal is based on an ex-officio examination.
8. Scope of refusal in respect of goods and/or services:
This refusal applies to all goods claimed in Classes 3, 5, 34, 35 and 40.
9. Grounds of Refusal :
9.1 This application is refused under Section 23(1)(b) of the Trademarks Act 2019 because the trademark is devoid of any distinctive character.
9.2 This application is refused under Section 23(1)(c) of the Trademarks Act 2019 because the trademark consists exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose and other characteristics of goods or services.

Objection :

The trademark "C10H14N2" consists of the molecular formula which is referred to nicotine. This formula is an alkaloid which is an active principle of tobacco. Therefore, it is directly referring to the goods or services provided, hence it is considered as a non-distinctive trademark.

9.3 Specification of goods and/or services

The following goods are objectionable under Section 19(1) of the Trademarks Act 2019 and Regulation 11 of the Trademarks Regulation 2019.

Class 35

- a. The description "**online retail and wholesale services for goods**" is vague. Please be specific on the services that you wish to seek protection.

10. Relevant law :

The relevant provisions of the Trademarks Act 2019 are attached.

11. Respond to the refusal :

This provisional refusal will be reviewed if the holder :

- a. Submit written arguments against the refusal **or**
b. Apply for a hearing by filing form Fee Code TMC1 (RM 150.00) for each class

The request for review must quote the International Registration number, Malaysia trademark number and class number(s) and must be submitted through a registered trademark agent in Malaysia by filing form **Fee Code TMR7** (RM 20.00). The list of trademarks agent can be accessed at <http://www.myipo.gov.my>

12. Timeframe for responding :

If the holder does not request for a review of this application or does not apply for an extension of time by **11 October 2021**, this refusal will become final.

Request for an extension of time to respond to this provisional refusal is possible by filing form **Fee Code TMK1** (RM50.00) and form **Fee Code TMK3** (RM 100.00) per month.

13. This refusal is issued by :

Norhaslinda Hasan (Ms)
for the Registrar of Trademarks
Malaysia

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TRADEMARKS ACT 2019

23. (1) Subject to subsection (2), the Registrar shall refuse to register a trademark based on the following absolute grounds for refusal of registration:

- (a) signs which are not capable of being represented graphically and not capable of distinguishing goods or services of one undertaking from those of other undertakings;
- (b) trademarks which are devoid of any distinctive character;
- (c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, other characteristics of goods or services or the time of production of goods or of rendering of services; or
- (d) trademarks which consist exclusively of signs or indications which have become customary in the current language of the territory or in the bona fide and established practices of the trade.

(2) Notwithstanding paragraphs (1) (b), (c) and (d), the Registrar shall not refuse to register an application of a trademark if, before the date of application for registration, the trademark has in fact acquired a distinctive character as a result of its use.

(3) The Registrar shall refuse to register a sign as a trademark if the sign consists exclusively of—

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(4) Notwithstanding subsections (1) and (2), the Registrar shall refuse to register the following as a trademark if—

- (a) the trademark consists exclusively of the name of a country; or
- (b) the trademark contains or consists of recognized geographical indications.

(5) In addition to the grounds in subsections (1), (3) and (4), the Registrar shall refuse to register a trademark based on any of the following absolute grounds for refusal of registration:

- (a) if the use of the trademark is likely to deceive or cause confusion to the public or contrary to any written law;
- (b) if it is of such a nature as to deceive or mislead the public as to the nature, quality or geographical origin of the goods or services;
- (c) the trademarks are contrary to public interest or to morality;
- (d) the trademarks contain or consist of any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law;
- (e) the trademarks contain a matter which is in the opinion of the Registrar is or might be prejudicial to the interest or security of the country;
- (f) the trademarks contain or consist of the name or representation of another person whether living or dead unless the applicant furnishes the Registrar with the consent of that person, if living, or of the representative of that person if deceased;
- (g) the trademarks contain or consist of flag of a country, national emblem, emblem, insignia or royal arms unless the applicant furnishes the Registrar with the authorization of the competent authorities or international intergovernmental organization as specified in section 78 or 79, as the case may be;

(h) the trademarks contain or consist of a word which is commonly used as or is the accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, or which is declared by the World Health Organization as an international non-proprietary name or which is deceptively similar to such name unless it is used—

(i) to denote only a brand or to make the element or compound as made by the proprietor of the trademark or the licensee as distinguished from the element or compound as made by others; and

(ii) in association with a suitable name or description open to public use; or

(i) the trademarks contain or consist of any of the following signs or a sign similar to any of those signs as is likely to be taken for that sign:

(i) the word “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, and “Copyright” or words to the like effect in any language whatsoever; or

(ii) any sign as prescribed.

24. (1) The Registrar shall refuse to register a trademark if it is identical with an earlier trademark and the goods or services for which the trademark is applied for are identical with the goods or services of the earlier trademark.

(2) The Registrar shall refuse to register a trademark if there exists a likelihood of confusion on the part of the public—

(a) where the trademark is identical with an earlier trademark and is to be registered for goods or services similar to the earlier trademark; or

(b) where the trademark is similar to an earlier trademark and is to be registered for goods or services identical with or similar to the earlier trademark.

(3) The Registrar shall refuse to register a trademark if—

(a) it is identical with or similar to a well-known trademark which is not registered in Malaysia and it is to be registered for the identical goods or services of the proprietor of the well-known trademark; or

(b) it is identical with or similar to a well-known trademark which is registered in Malaysia and it is to be registered for goods or services which are not identical or not similar to those in respect of which the well-known trademark is registered and—

(i) the use of the trademark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the well-known trademark;

(ii) there exists a likelihood of confusion on the part of the public because of such use; and

(iii) the interests of the proprietor of the well-known trademark are likely to be damaged by such use.

(4) Subject to subsection (6), the Registrar shall refuse to register a trademark if, or to the extent that, its use in Malaysia is prevented—

(a) by virtue of any rule of law protecting an unregistered trademark or other sign used in the course of trade including under the law of passing off; or

(b) by virtue of an earlier right other than those referred to in paragraph (a) or in subsections (1) to (3) including under the law of copyright or industrial designs.

(5) A person entitled to prevent the use of a trademark is referred to in this Act as the proprietor of an “earlier right” in relation to the trademark in subsection (4).

(6) The Registrar may refuse to register a trademark on any grounds under subsection (4) if that ground is raised in proceedings in opposition to the registration under section 35 by the proprietor of the earlier right.

(7) Notwithstanding the relative grounds for refusal of registration under subsections (1), (2), (3) and (4), the Registrar may register a trademark if the proprietor of the earlier trademark or other earlier right consents to the registration in the prescribed manner and shall take into account the interest of the public and the likelihood of confusion on the part of public.

(8) For the purposes of this section, if the registration of an earlier trademark expires, the Registrar in determining the registrability of a trademark shall continue to take into account the earlier trademark for a period of twelve months after its expiry.