



BIOTECHCORP

MALAYSIAN BIOTECHNOLOGY CORPORATION SDN BHD
(Company No. 691431-D)

PATENT PROTECTION IN MALAYSIA – A BASIC GUIDE

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1. INTRODUCTION

1.1. BACKGROUND

Patent protection in Malaysia is governed by the Patents Act 1983 (PA) and the Patents Regulations 1986 (PR). These statutes, which came into force on 1st October 1986, marked the beginning of an independent patent registration system for Malaysia.

Prior to 1st October 1986, to obtain patent protection in Malaysia, one needed to secure a patent registration in the United Kingdom (UK) and subsequently re-register the same in Malaysia. The re-registration would provide the registrant in Malaysia the same privileges and rights as that conferred in the UK as if the patent had been granted in Malaysia. The earlier system of re-registration of UK patents has since been repealed.

The PA and the PR are administered by the Intellectual Property Corporation of Malaysia (Corporation). The Corporation, also known as MyIPO, is an agency under the jurisdiction of the Ministry of Domestic Trade, Cooperative and Consumerism which is responsible for the development and management of the intellectual property (IP) system in Malaysia.

1.2. INTERNATIONAL AGREEMENTS, CONVENTIONS AND TREATIES

Malaysia, to comply with international standards on intellectual property, has acceded to a number of international agreements, conventions and treaties, amongst which are:-

- The Paris Convention for the Protection of Industrial Property 1883 (Paris Convention)
The Paris Convention, which was established in 1883, is one of the major international treaties designed for the protection of industrial property, including patents.
- Convention establishing the World Intellectual Property Organisation (WIPO) 1967 (WIPO Convention)
The WIPO Convention was signed in 1967 to establish the World Intellectual Property Organisation (WIPO), an international organisation with the mandate/ dedicated to promote the protection of IP throughout the world through cooperation among member states and in collaboration with other international organisations.
- The Trade Related Aspects of Intellectual Property Rights Agreement 1994 (TRIPS Agreement)
Administered by the World Trade Organisation (WTO), the TRIPS Agreement basically sets down the minimum standard of protection to be observed by the members of WTO for the various forms of IP.
- The Patent Cooperation Treaty (PCT)
The PCT, concluded in 1970, is an international patent law treaty, which provides a unified and simplified procedure for seeking patent protection in each of its member states, through filing a single patent application.

As a signatory to both the Paris Convention and the Patent Cooperation Treaty, patent protection in Malaysia may be pursued via two different routes - one route being through the filing of a direct national application under the national patent law while the other is by way of a filing of an international patent application through the PCT system.

2. PATENTABILITY

2.1. PATENT

What is a patent?

A patent is a grant issued by the government to the owner of an invention which gives him exclusive rights to exclude others from exploiting the invention without his permission for a limited period of time.

In return for this privilege, the owner is required to make a full disclosure of the invention to the public, such that any person skilled in the art is able to carry out or work the invention.

The protection accorded by patent rights is said to be the main motivation in the creation of new inventions and promotion of commercialization, technology transfer and international trade.

The patent system may thus be regarded as a form of social contract between the government and the owner of the invention. Its symbiotic nature benefits society at large as it not only helps widen the sharing of technological knowledge, it also encourages investment, scientific research and industrial progress, leading to wealth creation for social and economic welfare.

2.2. INVENTION

An idea itself is not patentable but if it has been reduced to the form of an invention, then the invention may be patented.

Definition

What exactly is an invention? An invention is defined by the PA as an idea of an inventor which permits a practical solution to a specific problem in a field of technology. It may be a product or a process. In other words, an invention is a product or a process that provides a new way of doing something, or offers a new technical solution to a problem.

However, not all inventions which fall within the definition of “invention” are patentable. In order to qualify for a patent, the invention must fulfil certain requirements.

2.3. PATENTABLE INVENTIONS

For an invention to be patentable, it must meet the following criteria:-

- It must be new or novel;
- It must involve an inventive step; and

- It must be industrially applicable.

Novelty

An invention is regarded as new or novel if it is not anticipated by prior art. Prior art consists of everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention.

There are however exceptions for prior disclosure to be disregarded in certain circumstances. A novelty grace period of twelve (12) months preceding the filing date of the Malaysian application is available for prior disclosure if such disclosure was by the applicant (or his predecessor in title), or due to the abuse of the rights of the applicant (or his predecessor in title).

Novelty of an invention is assessed relative to existing prior art and the standard method used for this purpose is by way of a prior art search.

(For more information on prior art search, please refer to the Guidance Paper entitled "Patent Registration Procedure in Malaysia".

Inventive Step

An invention is considered as involving an inventive step if, having taken into account any prior art, such inventive step would not have been obvious to a person having ordinary skill in the art. A person skilled in the art is someone with knowledge and experience in the technological field of the invention.

The basis for the requirement of an inventive step is to ensure that patent rights are awarded in respect of substantial technical advancements in a given field of technology and not to every trifling or trivial invention.

Assessment of the inventive step requirement is a complex step and the tests applied to assess inventiveness may vary on a case to case basis depending on the nature of the invention.

Some examples of what may qualify as an inventive step are as follows:-

- an invention which provides a solution to a long-existing technical problem, which have been sought by others but have not been successfully resolved;
- an invention which involves a series of steps to achieve or arrive at the desired result and is not merely one step away from a prior art; and
- an invention which has not been produced by competitors, the reason being the solution intended by the invention was not obvious to them.

In contrast, examples of what may not satisfy the inventive step prerequisite include the following:-

- a mere modification of an existing product or process; and
- a mere substitution of an existing equivalent which is commonly known.

Industrial Application

An invention is considered industrially applicable if it can be made or used in any kind of industry. This requirement is easily met if it is shown that the invention has a practical application or use.

2.4. NON-PATENTABLE INVENTIONS

Not all inventions are patentable. Even if an invention satisfies all the criteria stated above, there are still exceptions.

The following inventions are not patentable under Malaysian patent law:-

- discoveries, scientific theories and mathematical methods;
- plant or animal varieties or essentially biological processes for the production of plants or animals not including 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; and
- methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body (this provision does not apply to products used in any such methods).

Discoveries, scientific theories and mathematical methods

Mere discoveries of known materials or substances freely occurring or available in nature are not patentable. However, if a material were to be extracted and isolated from its natural source, the new process developed for this purpose and also the material obtained from said process could be patentable, provided all the other conditions are met.

Similarly, scientific theories and mathematical methods themselves are not patentable but their practical applications may well be so. For instance, the theory of electricity would not be patentable but its application in the form of a new electrical device and the process for manufacturing the same may be.

Schemes, rules or methods for doing business, performing purely mental acts or playing games

The above category is perceived as abstract or intellectual in nature, and not of a technical character to qualify for patents. For example, a scheme for conducting a business activity or a method of book-keeping would not be patentable as it is lacking in technical character. However, machines, apparatuses or devices for playing games, for instance, a Pachinko machine (a Japanese gaming device), may be patentable.

Plant or animal varieties or essentially biological processes for the production of plants or animals not including man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes

Plant and animal varieties are excluded from patent protection. However, for new plant varieties, protection is conferred by the plant variety registration system

governed by the Protection of New Plant Varieties Act 2004, which is administered by the Department of Agriculture of the Ministry of Agriculture and Agro-based Industries.

As for “essentially biological” processes, whether a particular process is considered as “essentially biological” depends on the extent of human technical intervention in said process. If such intervention brings about significant changes in the end results, the process would not be regarded as “essentially biological” and thus, may not be excluded from patentability.

Some examples of “essentially biological” processes which are excluded or non-patentable are methods of cross-breeding or selective breeding of animals, whereby, such methods merely involve selecting and bringing together animals with certain traits for the purpose of breeding.

Man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes are specifically exempted from the exclusion for non-patentability. The same are perceived to involve some form of human technical intervention, for instance by genetic engineering.

Methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body

Methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body are also excluded from patent protection under the PA. This provision however does not apply to products used in any such methods, and as such, patents may be obtained for instruments or products used in such methods, for example, diagnostic kits, surgical apparatus and bone implants, to name a few. Also, novel drugs used in such methods may be patentable.

2.5. OTHER EXCEPTIONS TO PATENTABILITY

Apart from the above exclusions, Malaysian patent law also prohibits the patenting of any invention that would be –

- contrary to public order or morality; or
- prejudicial to the interest or security of the nation.

Inventions which may be excluded by the above provisions include those which may induce riots or public disorder, or lead to criminal or other generally offensive or immoral behaviour. A classic example would be a novel kind of letter-bomb. Others include explosives and nuclear weapons.

2.6. ISSUE OF PATENTING BIOTECHNOLOGICAL INVENTIONS

In recent years, the issue of patenting of biotechnological inventions, particularly naturally occurring biological materials such as living organisms, stem cells, genetic sequences and also those involving traditional knowledge, has spawned a number of endless battles across the globe. These conflicts have left legislators baffled as they struggle to strike a right balance between protecting public interests and private rights.

Patenting of biological materials such as gene sequences is one example which has sparked heated debates, even among scientists. Adversaries to patents of such nature argue that the same are features of the natural world, not human inventions and as such their discoveries do not entitle anyone to the exclusive rights conferred by patents.

Opponents of DNA patenting also contend that allowing such patents, does more public harm than good as it hinders medical breakthroughs which could save lives. Instead of promoting innovations, it stifles scientific research and hurts patient care due to the exorbitant costs associated with using patented data, they claim.

Conversely, promoters of gene patents disagree that gene sequences are mere discoveries. They assert that substantial time and efforts are expended in isolating and studying a particular gene sequence, to find its use and chemical make-up for the benefit of mankind, and such noble efforts merit reward and recognition in the form of patent rights. It is also argued that huge investments of resources for further research are encouraged only by the award of such rights.

Another area of concern involves the use of human embryos and their cells for scientific research as well as stem cell research itself. The controversy surrounding the same is as yet unresolved as it is a delicate and sensitive area of science and raises concerns not only from ethical and moral perspectives but also from religious angles.

Other conflicting subject matters include patenting of animals. Patents encompassing traditional knowledge is another classic subject which raises criticism, often leading to patent disputes.

2.7. POSITION IN MALAYSIA

The PA, as it stands now, does not provide clear guidance on the patenting of biotechnological inventions per se. Although there are some exclusions on the matter, the current position in Malaysia with regard to inventions in the field of biotechnology is still vague.

In light of the increasing demands for the protection of biotechnological inventions and uncertainties clouding the patentability of inventions of such nature, the PA is currently under review and amendments to include clear provisions and provide directions in this regard are expected in the near future.

3. RIGHTS TO A PATENT

3.1. RIGHT TO A PATENT

The right to the grant of a patent belongs to the owner of the invention.

The owner, who may be an individual or a corporation, is entitled to apply for a patent in Malaysia.

3.2. JOINT OWNERS

Inventions may be owned jointly by multiple parties. In such instances, the application for patent may only be filed jointly by all the joint owners.

3.3. INVENTIONS MADE BY AN EMPLOYEE OR PURSUANT TO A COMMISSION

The PA defines the terms “employee” and “employer”. “Employee” means a person who works or has worked under a contract of employment, or who is in employment under, or for the purposes of, any individual or organization, whereas, the term “employer”, in relation to an employee, means the person by whom the employee is or was employed.

For an invention developed by an employee in the course of his employment, the rights to the invention are deemed to vest with the employer, unless there are provisions to the contrary in his contract of employment.

Similarly, for an invention developed pursuant to the execution of a commissioned work, the rights to the invention belong to the person who commissioned the work, provided that there are no provisions to the contrary in the agreement between the parties.

The PA however stipulates that in the event the invention acquires an economic value much greater than the parties could reasonably have foreseen at the time of conclusion of the contract, the inventor is entitled to equitable remuneration, which, in the absence of an agreement between the parties, may be fixed by the Court.

There is however no guidance in the PA as to what would amount to an equitable remuneration or how the same is determined. It is therefore left to the parties concerned to come to an agreement, failing which, the matter may be taken to Court to be resolved.

3.4. INVENTIONS BY GOVERNMENT EMPLOYEES

The same provision also applies to Government employees or employees of Government organisations, whereby inventions created by employees will accrue to the Government or Government organisations as the case may be, unless otherwise provided by rules or regulations of such organisations.

4. APPLICATION, PROCEDURE FOR GRANT AND DURATION

4.1. APPLICATIONS BY RESIDENTS TO BE FILED IN MALAYSIA FIRST

Any person resident in Malaysia is required to file a patent application for his invention first in Malaysia prior to seeking patent protection overseas. After two (2) months of the filing in Malaysia, he may proceed to file his patent application overseas provided there is no prohibition from the Registrar of Patents (Registrar).

However, if the applicant wishes to apply for patent protection outside Malaysia first, he must first seek written permission from the Registrar to allow him to do the same.

Failure to seek such permission is deemed as an offence and on conviction, the offender is liable to a fine not exceeding fifteen thousand ringgit (RM15,000) or to imprisonment of a term of two (2) years or both.

4.2. RIGHT OF PRIORITY

Priority date

If there are no earlier filings, the priority date of an application for a patent is the filing date of the application.

Priority claim

The Paris Convention provides for an applicant who has filed his priority application or first application in one member country of the Paris Convention, to claim the benefit of the priority date or first filing date, in his subsequent application in another member country, provided that the subsequent application is filed within the priority term of twelve (12) months from the priority date or first filing date.

Illustrations of two different scenarios, one involving a Malaysian applicant and the other relating to a foreign applicant, are provided for better understanding.

- Scenario 1
For a Malaysian applicant, the first filing date of an application for his invention in Malaysia would be the priority date. Should he subsequently file an application for the same invention in Japan*, he would be entitled to claim the priority date of the Malaysian application in his Japanese application, provided that the subsequent application is filed within the priority term of twelve (12) months.
- Scenario 2
Similarly, in the case of a foreign applicant who has filed his priority application in Australia* for instance, he may claim the priority date of his Australian application in his subsequent application in Malaysia, as long as the application in Malaysia is filed within the priority term.

(*Note: Japan and Australia are members of the Paris Convention)

What is the significance of a priority claim? The significance of a priority claim is that, for the purposes of ascertaining novelty and inventive step of an invention only prior art available as of the priority date, and not the actual filing date of the subsequent application which would be later, will be considered. Hence, any relevant prior art which occurred after the priority date will not have an impact on the novelty or inventiveness of the invention.

4.3. STAGES OF APPLICATION AND REGISTRATION PROCEDURE

Patent application and grant (registration) stages:

- Application for Patent Grant;
- Preliminary Examination;
- Public Inspection;
- Substantive Examination; and
- Grant of Patent (Registration).

4.4. APPLICATION FOR PATENT GRANT

Patent protection is conferred through the system of registration. Therefore, to obtain protection, a patent must be registered with the Patent Registration Office of the Corporation. The Patent Registration Office is responsible for the administration, processing and registration of patents and certificates for utility innovations.

For further information on utility innovations, please refer to Section 12.

Application Requirements

An application for the grant of a patent may either be filed with the Patent Registration Office at the head office in Kuala Lumpur or at one of the branch offices. in Johor Bahru (Johor), Kuantan (Pahang), Seberang Jaya (Pulau Pinang), Kota Kinabalu (Sabah) and Kuching (Sarawak).

The location and contact details of the offices are provided in Appendix 1.

Alternatively, an application for a patent may also be submitted electronically through the online filing services known as “IP Online” which is now available.

The application must include the following:-

- Form 1 duly completed;
- A patent specification consisting of a description of the invention, a claim or a set of claims, an abstract and drawings (if any); and
- Payment of the prescribed filing fee.

The following information need to be provided in Form 1:-

- the title of the invention;
- the name, address and nationality of the applicant(s);
- the name and address of the inventor(s); and
- the details of a priority application (i.e. the filing date, application number and country of filing) from which priority is claimed (if applicable).

Other additional documents (together with the prescribed fees), which need to be lodged with the Patent Registration Office at the time of filing the application, if applicable, are as follows:-

- Form 17 (Appointment of Patent Agent), if a patent agent is appointed; and
- Form 22 (The Statement Justifying the Applicant’s Right to a Patent), if the applicant is not the inventor of the invention.

A local applicant has the option of filing an application on his own behalf or appointing a registered patent agent to handle the matter. A foreign applicant however needs to appoint a local agent to represent him.

Application fee

An application for the grant of a patent will not be accepted and processed unless the payment of the prescribed fee has been made.

Language

A Malaysian application may be submitted either in the English language or the national language, Bahasa Malaysia.

Certificate of Filing

An application filed with the Patent Registration Office will be accorded an official filing date if the requirements have been met. A Certificate of Filing bearing the official filing and the allotted application number will be issued.

Forms and fees

The recent amendments to the PR, which became effective on 15 February 2011, include an upward revision in the official fees. Additionally, there are now two scale of fees available; one scale for the conventional manual filing, while the other is a discounted set of fees applicable for electronic filing.

All fees are payable to the Intellectual Property Corporation of Malaysia. For manual filing, payment may be made in the form of a cheque, money order, bank draft or postal order. Payment in cash is also accepted at the payment counter at the Patent Registration Office. For further details, please refer to Appendix 1.

As for online filing, payment must be made through a pre-paid account which the applicant is required to open with the Patent Registration Office.

A list of the latest forms and fees payable is provided in Appendix 11. Forms are downloadable from the website of the Corporation, <http://www.myipo.gov.my>.

First to file system

Malaysia, like most countries, adopts a first to file patent system. Under this system, the first person to file an application for his invention has priority over others for the same invention.

It is therefore crucial to ensure that an application for a patent is filed without unnecessary delay to avoid the loss of priority of one's invention.

Territorial rights

Patent rights are territorial in nature. As such, the rights conferred by a patent granted in Malaysia extend only to Malaysia.

4.5. WITHDRAWAL OF APPLICATION

At any time during the pendency of the application, an applicant may withdraw his application by submitting a declaration to the Registrar. It is important to note that the withdrawal of an application may not be revoked once effected.

The application for withdrawal is made on Form 2. There is however no payment involved.

4.6. PRELIMINARY EXAMINATION

After being accorded a filing date, the pending Malaysian application will undergo a preliminary examination to determine whether it complies with the formal requirements of the PA and PR. No formal request for preliminary examination need to be made by the applicant as the same will be conducted as a matter of course.

If any non-compliance is found as a result of the examination, a Preliminary Examination Adverse Report indicating the non-compliances will be issued to the applicant, giving him a time frame of three (3) months to address the same.

Should the applicant require more time to respond to the adverse report, he may request for an extension of time. However, only one such request for a maximum period of six (6) months is allowed.

The request for an extension of time is made on Form 21 together with payment of the prescribed fees.

If the applicant fails to respond to the report or request for an extension of time to do so within the given time frame, the application will be refused.

However, if the formal requirements have been fulfilled, or the non-compliances have been successfully addressed, a Preliminary Examination Clear Report will be issued.

4.7. PUBLIC INSPECTION AND PROVISIONAL PROTECTION

Public Inspection

Generally, after eighteen (18) months from the earliest priority date or the filing date, whichever is the earlier, a pending Malaysian patent application is made available for public inspection. The application is not published in printed form but the details of the application and the patent specification (including any amendments which may have been made to the application) are made available to any person who wishes to inspect the same, upon payment of a prescribed fee (RM30 per hour).

Provisional Protection

The making available for public inspection of a pending application provides provisional protection. This entitles the patent owner, upon grant of the patent, to claim compensation for infringement which occurred between the date the application was laid open for public inspection and the date of grant of the patent.

Prohibition of Publication

Not all applications are made available for public inspection as there are exceptions in some cases. If an application appears to contain information which might be prejudicial to national interest or security or information which contravenes public order or morality, the same will not be made available for public inspection.

4.8. SUBSTANTIVE EXAMINATION

For substantive examination, a formal request together with the payment of the prescribed official fee must be filed within the stipulated timeline. Failure to do so within the stipulated time frame will result in the application being deemed as withdrawn.

With the recent amendments to the PR, the timeline to file the request for substantive examination has been shortened to eighteen (18) months from the date of filing of the application from the previous twenty four (24) months.

This new timeline however applies **only** to direct applications filed on or after 15 February 2011 and does not affect applications filed through the PCT route i.e. the PCT national phase applications.

For applications filed before 15 February 2011, the timeline to request for substantive remains twenty four (24) months from the date of filing of the application.

There are two types of substantive examination: normal substantive examination and modified substantive examination.

The request for normal substantive examination is made on Form 5 together with the prescribed fee whereas for modified substantive examination, the request is made on Form 5A together with the prescribed fee.

The main difference between these two types of examination lies in the method of examination.

Normal Substantive Examination

Under a normal substantive examination, the Malaysian patent examiner will conduct its own search and examination of the application to ascertain if the invention is patentable. Search and examination reports of corresponding foreign applications from Europe, United Kingdom, Australia, USA, Japan and Korea (which are required to be submitted at the time of filing of the request for examination if available to the applicant) will be utilized by the examiner to assist in the examination but not relied on totally.

Modified Substantive Examination

A request for modified substantive examination may only be made if the applicant has a corresponding patent granted in any of the prescribed countries mentioned above, and the applicant wishes to conform the Malaysian application with the

corresponding patent. The request for modified examination must be accompanied by a certified true copy of the corresponding patent (certified to be true by the issuing Patent Office). If the granted patent is not in the English language, then a certified English translation thereof is required to be submitted along with the request.

For the modified examination, the Malaysian application is examined for novelty, statutory subject-matter and also for conformity with the corresponding granted patent which forms the basis for the modified examination.

The modified examination, as opposed to the normal examination, is relatively cheaper and intended to be simpler and speedier.

Substantive Examination Report

On completion of the substantive examination, if the examiner has any objections, a Substantive Examination Adverse Report or Modified Substantive Examination Adverse Report indicating the nature of the objections will be issued to the applicant, giving him a time frame of two (2) months to address the same.

Should the applicant require more time to respond to the adverse report, he may request for an extension of time. However, only one such request for a maximum period of six (6) months is allowed.

The request for an extension of time is made on Form 21 together with payment of the prescribed fees.

If the applicant fails to respond to the report or request for an extension of time to do so within the given time period, the application will be refused.

However, if all requirements have been met to the satisfaction of the examiner, or the objections raised have been successfully overcome, a Substantive Examination Clear Report will be issued to the applicant.

Deferment of Substantive Examination

The filing of the request for substantive examination may be deferred on grounds that supporting information and documents of corresponding foreign applications are not available. An official request for deferment of the request for substantive examination must be filed within eighteen (18) months from the filing date of the application. Otherwise, the application will be deemed as withdrawn.

The maximum deferment period is five (5) years from the filing date of the Malaysian application.

The request for deferment is made on Form 5B. However no payment is required for the same.

Expedited Examination

The recent amendments to the PR also introduce a new provision for expedited examination of patent applications. This system of expedited examination,

however, will not be automatic upon request. It will be based on reasons acceptable to the Registrar of Patents and payment of additional fees.

The reasons acceptable to the Registrar for consideration of a request for expedited examination as set out in the PR are –

- the invention is in the national or public interest;
- there are on-going infringement proceedings or evidence showing potential infringement of the invention;
- the applicant has already commercialised the invention or has intentions for early commercialisation of the invention;
- patent registration being a condition for obtaining monetary benefits such as grants and loans from the government or other institutions recognised by the Registrar;
- the invention relates to green technologies which will enhance the quality of the environment or conservation of energy resources; or
- any other reasonable grounds.

It is important to note that this new provision for expedited examination only applies to direct applications and not applications filed via the PCT route.

An applicant who requests or has already requested for substantive examination may now request for an approval of expedited examination of his application from the Registrar. The request may be made after the application has been laid open for public inspection, that is, after eighteen (18) months from the priority date or filing date of the application.

The request for approval of expedited examination must be made on Form 5H together with payment of the prescribed fee and also accompanied by a statutory declaration stating the reasons for said request.

After due consideration of the application, a decision will be made by the Registrar and the applicant will then be notified of the Registrar's decision, which is expected to be within one (1) week from the application for approval.

On approval of the request for expedited examination, the applicant is required to submit the request for expedited examination within five (5) working days from the date of the Registrar's notification of approval. The request must be made on Form 5I together with the prescribed fee.

The application will then be examined and the first substantive examination report on the examiner's findings will be issued to the applicant within four (4) weeks from the request for expedited examination.

Should the examiner have any objections, a Substantive Examination Adverse Report indicating the nature of the objections will be issued to the applicant, giving him one opportunity to address the same within a time frame of three (3) weeks. No extension of time will be granted.

If the applicant files a response to the adverse report within the stipulated time, the examiner will re-examine the application within three (3) weeks and issue a final decision of the expedited examination.

However, if the applicant fails to respond to the report or is unable to satisfactorily overcome the objections raised within the given time period, the application for

expedited examination is deemed to be withdrawn. In such cases, the application will revert to the normal examination process and timelines.

On the other hand, if all requirements have been met to the satisfaction of the examiner, or the objections raised have been successfully overcome, a Substantive Examination Clear Report will be issued to the applicant and he is given one (1) week to verify the bibliographical information relating to the patent.

Subsequently, a Certificate of Grant of a Patent together with a copy of the granted patent is issued to the applicant within five (5) working days from the date of issuance of the Substantive Examination Clear Report.

The processing time for an expedited examination of a straightforward application, where the same is in compliance with all requirements and no adverse examination report is issued, is approximately two (2) months from the date of receipt of the request for expedited examination.

4.9. GRANT OF PATENT (REGISTRATION)

Subsequent to the issuance of the Substantive Examination Clear Report, a Certificate of Grant of a Patent together with a copy of the granted patent will be issued to the applicant and details of the same will be recorded in the Register of Patents. Further, the particulars of the patent, together with the abstract will be published in the Government Gazette.

4.10. DURATION OF A PATENT

Once granted, the duration of a Malaysian patent is twenty (20) years from the filing date of the application, subject to timely payment of prescribed annual fees. A grace period of six (6) months is allowed for late payment of annual fees subject to a surcharge of 100% of the annual fees payable.

Under the local patent system, annual fees are payable only upon grant of patent. No fees are imposed on pending applications unlike in some jurisdictions.

If annual fees are not paid, the patent will lapse and a notice of the lapsing of the patent for non-payment will be published in the Government Gazette.

4.11. REINSTATEMENT OF A LAPSED PATENT

An application to reinstate a lapsed patent may be made to the Registrar within two (2) years from the date of publication of the notice in the Government Gazette. A prescribed fee is payable together with the application for reinstatement on Form 5E.

The Registrar, after considering the application for reinstatement, may allow the reinstatement of the patent upon being convinced that the patent lapsed unintentionally due to an accident, mistake or other unforeseeable circumstances, and also upon receipt of payment of all overdue annual fees and prescribed surcharges.

Examples of circumstances referred above include the following –

- an accidental fire or a natural disaster, for example, a flood or typhoon, which destroyed the relevant records and resulted in the payment of annual fees being overlooked; or
- an annual fee reminder system which broke down and failed to notify the applicant of the payment due date; or
- an illness which prevented the owner from conducting his day-to-day business affairs.

If the patent is reinstated, a notice of reinstatement is published in the Government Gazette.

5. RIGHTS OF OWNER OF PATENT

5.1. RIGHTS OF OWNER OF PATENT

The owner of a patent has the following exclusive rights in relation to the patent:

- to exploit the patented invention;
- to assign or transmit the patent; and
- to conclude licence contracts.

Exploitation of a patented invention means any of the following acts:

- for a patent granted in respect of a product -
 - making, importing, offering for sale, selling or using the product; and
 - stocking such product for the purpose of offering for sale, selling or using.
- for a patent granted in respect of a process –
 - using the process; and
 - making, importing, offering for sale, selling or using the product obtained directly by means of the process.

5.2. LIMITATION OF RIGHTS

The rights conferred under the patent extend only to acts done for industrial or commercial purposes. The rights, in particular, do not extend to acts done only for scientific research.

The rights also do not extend to acts done to make, use, offer to sell or sell a patented invention solely for uses reasonably related to the development and submission of information to the relevant authority which regulates the manufacture, use or sale of drugs.

Further, the rights do not extend to the use of the patented invention on any foreign vessel, aircraft, spacecraft or land vehicle temporarily in Malaysia.

5.3. RIGHTS DERIVED FROM PRIOR MANUFACTURE OR USE

The PA also recognises and provides for rights derived from prior manufacture or use, despite the grant of the patent, to exploit the patented invention. This provision applies where a person at the priority date of the patent application -

- was in good faith in Malaysia making the product or using the process which is the subject matter of the invention claimed in the application;
- had in good faith in Malaysia made serious preparations towards the making of said product or using said process.

The entitlement to prior user rights is subject to the following conditions:-

- the product or process in question is used in Malaysia; and
- the prior user is able to prove that his knowledge of the invention was not due to the prior disclosure of the invention.

The prior user rights however cannot be assigned or transmitted except as part of the business of the person.

6. ASSIGNMENT AND TRANSMISSION OF PATENT APPLICATIONS AND PATENTS

A patent application or patent is a form of property and may be assigned or transmitted.

6.1. MEANING OF ASSIGNMENT AND TRANSMISSION

Meaning of Assignment

In the context of the patent system, “assignment” means sale. It is basically an outright transfer of ownership of the rights of the owner of a patent application or patent (i.e. the assignor) to another person or enterprise (i.e. the assignee) for a sum of consideration. For the purpose of the PA, an assignment must be in writing and signed by or on behalf of the contracting parties.

Meaning of Transmission

“Transmission” generally refers to the transfer of the rights of the owner of a patent application or patent to an heir or successor.

Effect against Third Parties

The person becoming entitled to the patent application or patent by virtue of an assignment or transmission may apply to the Registrar to have the same recorded in the Register of Patents.

Although it is not mandatory to effect the recordal of assignment or transmission in the Register of Patents, it is advisable to do so because such assignment or transmission will not have effect against third parties unless the same is recorded in the Register of Patents.

6.2. APPLICATION FOR RECORDAL OF ASSIGNMENT OR TRANSMISSION

An application to record the assignment or transmission in the Register of Patents must be made to the Registrar on Form 6 together with the prescribed fee. In the case of an assignment, the original or a certified copy of the assignment signed by or on behalf of the contracting parties must also be submitted together with the application, whereas for the purpose of a

transmission, any documents evidencing the change of ownership need to be furnished.

If all requirements have been complied with, the Registrar will record the assignment or transmission in the Register of Patents.

Where the change of ownership is in relation to a patent, a reference thereto is also published in the Government Gazette.

6.3. JOINT OWNERSHIP

In the case of joint ownership, unless there is an agreement to the contrary between the parties, joint owners of a patent application or patent may, separately, do any of the following acts:

- assign or transmit their rights in the patent application or patent;
- exploit the patented invention; and
- take action against any person exploiting the patented invention without their consent.

However, the following acts may only be done jointly by the joint owners:

- withdraw the patent application;
- surrender the patent; or
- conclude a licence contract.

7. LICENCE CONTRACTS

7.1. MEANING OF LICENCE CONTRACT

For the purpose of the PA, a licence contract means any contract by which the owner of a patent (i.e. the “licensor”) grants to another person or enterprise (i.e. the “licensee”) a licence to exploit the patented invention. A licence contract must be in writing and signed by or on behalf of the contracting parties.

7.2. ENTRY IN THE REGISTER OF PATENTS

A licensor may apply to the Registrar for an entry to be made in the Register of Patents that any person may obtain a licence from him. The application is made on Form 7 together with the payment of the prescribed fee.

After an entry has been made in the Register of Patents, any person may apply to the licensor for a licence through the Registrar.

Where a licence contract is concluded, the contracting parties are required to inform the Registrar of the fact. The request to record the particulars of the licence contract is made on Form 9 together with the prescribed fee and must be in writing and signed by or on behalf of the contracting parties.

The particulars relating to the licence, which the contracting parties wish to have recorded, will be recorded in the Register of Patents. The parties however will not be required to disclose or record any other particulars of the licence contract.

The licensor may also apply to the Registrar for cancellation of the entry made in the Register of Patents that any person may obtain a licence. The application is made on Form 8 together with the payment of the prescribed fee.

7.3. EFFECT OF PATENT APPLICATION NOT BEING GRANTED OR PATENT BEING DECLARED INVALID

Should any of the following events occur before the expiration of the licence contract in respect of a patent application or patent referred to in such contract, the licensee will no longer be required to make any payment to the licensor under the licence contract:-

- the patent application is withdrawn;
- the patent application is finally rejected;
- the patent is surrendered;
- the patent is declared invalid;
- the licence contract is invalidated.

In such situations, the licensee may also be entitled to repayment of the payment made to the licensor.

However, if the licensor is able to prove that such repayment would be inequitable under all circumstances, in particular if the licensee has effectively profited from the licence, then the licensor will not be required to make any repayment or will be required to make repayment only in part, as the situation warrants.

7.4. EXPIRY OR TERMINATION OF LICENCE CONTRACT

If a licence contract is terminated or it expires, the contracting parties may request for the fact to be recorded in the Register of Patents. The request must be made to the Registrar on Form 10 together with the payment of the prescribed fee and must be in writing and signed by or on behalf of the contracting parties.

The Registrar, upon receiving such request and being satisfied that a recorded licence contract has expired or been terminated, will record the fact in the Register of Patents.

8. COMPULSORY LICENCES

8.1. DEFINITION

For the purpose of the PA, “compulsory licence” means the authorisation given by the Corporation (MyIPO) to any person to exploit the patented invention in Malaysia without the agreement of the owner of the patent.

“Beneficiary of the compulsory licence” means the person to whom a compulsory licence has been granted.

Compulsory licence may be regarded as a remedy for abuse of patent rights by the owner of a patent.

8.2. APPLICATION FOR COMPULSORY LICENCE

Any person may apply to the Registrar for a compulsory license after three (3) years from the grant of a patent, or four (4) years from the filing date of the patent application, whichever is the later, under any of the following circumstances:-

- there is no production of the patented product or application of the patented process in Malaysia without any legitimate reason; or
- there is no production of the patented product in Malaysia for sale in any domestic market, or there are some but they are sold at unreasonably high prices or do not meet the public demand without any legitimate reason.

However, prior to making an application for a compulsory license, the applicant must have made efforts to obtain authorisation from the owner of the patent on reasonable commercial terms and conditions, within a reasonable period of time of six months (from the initial efforts made) but such efforts have failed. Evidence of such efforts need to be submitted with the application.

The application for a compulsory licence is made on Form 11 together with the prescribed fee.

8.3. DECISION BY THE CORPORATION

The Corporation, in considering the application, may require the applicant to appear before the Corporation to give a statement or provide any further documentation or any other item as deemed necessary.

After due consideration of the application, a decision will be made by the Corporation and the applicant will be notified of said decision.

8.4. SCOPE OF COMPULSORY LICENCE

In granting a compulsory licence, the following conditions are determined by the Corporation:

- the scope of the licence specifying the period for which licence is granted;
- the time limit within which the beneficiary of the compulsory licence must begin to work the patented invention;
- the amount and conditions of the royalty to be paid by the beneficiary of the compulsory licence to the owner of the patent.

8.5. LIMITATION OF COMPULSORY LICENCE

A compulsory licence granted by the Corporation –

- is not permitted to be assigned other than in connection with the goodwill or business in which the patented invention is used;
- is limited to the supply of the patented information predominantly in Malaysia; and
- is not allowed to be sub-licensed to third parties.

8.6. AMENDMENT, CANCELLATION AND SURRENDER OF COMPULSORY LICENCE

Amendment of decision

On the request of the owner of the patent or the beneficiary of the compulsory licence, the Corporation may amend the decision of granting a compulsory licence provided that such amendment is justified by new facts.

Cancellation of compulsory licence

The Corporation, upon the request of the owner of the patent, will cancel the compulsory licence, in the following circumstances:-

- if the ground for the grant of the compulsory licence no longer exists;
- if the beneficiary of the compulsory licence has not begun working the patented invention in Malaysia or made serious preparations towards such working, within the given time limit;
- if the beneficiary of the compulsory licence does not respect the given scope of the licence;
- if the beneficiary of the compulsory licence is in arrears of the fixed payment due to the owner of the patent.

Surrender of compulsory licence

The beneficiary of the compulsory licence may surrender the licence by a written declaration, signed by the beneficiary and submitted to the Registrar. The declaration must also be accompanied by payment of the prescribed fee.

Within one month of the date of receipt of the declaration of surrender, the Registrar will record the surrender in the Register of Patents and notify the owner of the patent of the same. The fact is also published in the Government Gazette.

The surrender takes effect from the date of receipt of the declaration by the Corporation.

9. SURRENDER AND INVALIDATION OF PATENT

9.1. SURRENDER OF PATENT

The owner of the patent may surrender the patent by a written declaration submitted to the Registrar, together with payment of the prescribed fee.

The surrender may be limited to one or more claims of the patent or may apply to the whole patent and takes effect from the date the Registrar receives the declaration.

The surrender is recorded in the Register of Patents and also published in the Government Gazette.

9.2. INVALIDATION OF PATENT

A patent, once granted, may be challenged by any aggrieved person.

Grounds for invalidation

Any aggrieved person may initiate Court proceedings against the owner of the patent for the invalidation of the patent on the following grounds:-

- the invention as claimed in the patent is not patentable;
- the description or the claims do not comply with the PR;
- any drawings which are necessary for the understanding of the claimed invention were not furnished;
- the right to the patent does not belong to the person to whom the patent was granted; or
- incomplete or incorrect information has been deliberately provided or caused to be provided in relation to the request for substantive examination.

The invalidation may apply to the whole patent or be limited to one or more claims of the patent or parts thereof.

Date and effect of invalidation

If the grounds for the invalidation are proven, the Court will make a decision to declare the patent or the claims or parts thereof, as the case may be, as invalid.

When the decision of the Court becomes final, the Registrar of the Court will notify the Registrar (of Patents). The declaration of invalidity will then be recorded in the Register of Patents and also be published in the Government Gazette.

Any invalidated patent or claim or part thereof will be regarded as null and void from the date of grant of the patent.

10. INFRINGEMENT

10.1. ACTS DEEMED TO BE INFRINGEMENT

An infringement of a patent occurs when a person other than the owner of the patent exploits the patented invention without the consent of the owner.

10.2. INFRINGEMENT PROCEEDINGS

The owner of the patent has the right to initiate Court proceedings against any person who has infringed or is infringing the patent. The proceedings however must be initiated within five years from the act of infringement.

10.3. REMEDIES FOR INFRINGEMENT

Where the owner of the patent proves that an infringement has been committed or is being committed, the Court will award damages and grant an injunction to prevent further infringement, and award any other legal remedy as deemed appropriate.

11. OFFENCES

11.1. ACTS DEEMED AS AN OFFENCE

Any person who commits any of the following acts is deemed to have committed an offence under the PA:-

- **Falsification of the Register of Patents**
Making a false entry or a writing falsely purporting to be a copy or reproduction of an entry in the Register of Patents, or producing or tendering in evidence any such false writing.
- **Unauthorised claim or false representation**
Falsely representing that anything disposed of by him for value is a patented product or process.
- **Unauthorised claim that patent has been applied for**
Representing that a patent has been applied for in respect of any article disposed of by him for value when in actual fact –
 - no such application has been made; or
 - any such application has been refused or withdrawn.
- **Misuse of title “Patent Registration Office”**
Misusing the words “Patent Registration Office” on one’s place of business or any document issued by him or any other words suggesting that his place of business is, or is officially connected with the Patent Registration Office.
- **Unregistered person practising, etc., as a patent agent**
Carrying on business, practising, acting and describing oneself as a patent agent without being registered in the Register of Patent Agents.

11.2. PENALTY

The offender, on conviction of any of the above offences, is liable to a fine not exceeding fifteen thousand ringgit (RM15,000) or to imprisonment for a term not exceeding two (2) years or to both.

12. UTILITY INNOVATIONS

The Malaysian patent system also includes a provision for the grant of certificates for utility innovations, or petty patents as known in certain jurisdictions.

12.1. DEFINITION

A certificate for a utility innovation is similar to a patent but it is granted for a “minor” or lower level invention called utility innovation.

The PA defines utility innovation as any innovation which creates a new product or process, or any new improvement of a known product or process which is capable of industrial application and includes an invention. It generally does not

display a high degree of inventiveness in comparison to an invention qualifying for a patent.

12.2. ELIGIBILITY CRITERIA

For a certificate for a utility innovation, unlike an invention qualifying for a patent, it does not need to meet the inventive step requirement. It however still has to satisfy the criteria of novelty and industrial application.

Also, befitting its nature, only one claim is allowed for a certificate for a utility innovation.

12.3. APPLICATION AND PROCEDURE FOR GRANT

The application and prosecution process for certificates for utility innovations is basically the same as for patents. There is a minor difference in terms of the prescribed forms and fees. For easy reference, a list of forms and fees payable is provided in Appendix 11.

12.4. DURATION OF CERTIFICATE FOR A UTILITY INNOVATION

The initial duration of a certificate for a utility innovation, upon grant, is ten (10) years from the filing date of the application. The term however is renewable for two (2) consecutive terms of five (5) years each, subject to proof of use of the utility innovation in Malaysia, or satisfactory explanation of non-use.

As with patents, prescribed annual fees are also payable to keep the certificate for a utility innovation in force.

12.5. CONVERSION OF AN APPLICATION

The PA also allows for conversion of an application for a patent into an application for a certificate for a utility innovation, and *vice versa*.

The request for conversion must be made within six months of the date of mailing of the substantive examination report. A prescribed fee must also be paid together with the request on Form 5G.

12.6. PATENT OR CERTIFICATE FOR UTILITY INNOVATION

A patent and a certificate for a utility innovation cannot both be granted for the same invention. Only one, either a patent or a certificate for a utility innovation, can be granted.

In the event an applicant for a patent also applies for a certificate for a utility innovation for the same invention, he will not be granted either of the above until one of the applications is withdrawn.

13. INTERNATIONAL APPLICATION UNDER THE PATENT COOPERATION TREATY

13.1. PATENT COOPERATION TREATY (PCT)

The Patent Cooperation Treaty (PCT), concluded in 1970, is administered by the International Bureau (IB) of the World Intellectual Property Organisation (WIPO) in Geneva.

The main aim of this Treaty is to provide a unified and simplified procedure for those wishing to pursue patent protection in many countries around the world, through filing one single international patent application, also known as the PCT application.

It is important to note that the PCT system only facilitates filing of international applications. It does not grant an international patent or a world-wide patent. The same is nonexistent.

Since Malaysia's accession to the Patent Co-operation Treaty, one now has the option of filing a direct national Malaysian application or an international PCT application designating Malaysia among other member countries of its choice.

13.2. PERSONS ELIGIBLE FOR INTERNATIONAL APPLICATION IN MALAYSIA

Any person who is a citizen or resident of Malaysia is entitled to file an international application in Malaysia at MyIPO, which acts as the Receiving Office (RO) for international applications.

A Malaysian citizen or resident may also file the international application with the IB of WIPO, which acts as a RO for nationals and residents of all PCT member countries.

13.3. PHASES OF INTERNATIONAL APPLICATION

There are basically two phases in an international application as follows:–

- International phase; and
- National phase.

13.4. INTERNATIONAL PHASE

The international phase, which is governed by the PCT and its Regulations, is the first phase of an international application. It begins with the filing of an international application at the RO and ends at the entry of the application into the national jurisdictions.

The international phase is divided into the following stages:–

- Filing of an international application;
- International search;
- International publication; and
- International preliminary examination.

Filing of an International Application

To file an international application, the applicant is required to submit the following to MyIPO:-

- A request in the prescribed form (Form PCT/RO/101);
- A patent specification consisting of a description of the invention, a claim or a set of claims, an abstract and drawings (if any); and
- Payment of fees as prescribed by the Treaty and MyIPO.

The request must contain the following:-

- A petition to the effect that the international application be processed according to the Treaty;
- The designation of the country or countries in which protection is desired;
- The name, nationality and residence of the applicant;
- The name and address of the inventor or inventors;
- The name and the place of business of the applicant's agent, if any; and
- The title of the invention.

The international application in Malaysia must be filed in the English language and submitted in three (3) copies.

The international application is processed in accordance with the Regulations of the PCT.

Fees

Basically, there are three main fees to be paid by the applicant for an international application, which are as follows:-

- The transmittal fee, which covers the work completed by MyIPO;
- The international filing fee, which covers the work completed by WIPO; and
- The search fee, which covers the work completed by the International Searching Authority (ISA).

All fees are payable to MyIPO in Malaysian Ringgit. Of the fees collected, MyIPO retains only the transmittal fee. The international filing fee and the search fee are sent to WIPO and the ISA respectively.

On receiving the application and the prescribed fees, the application is checked to see if the filing requirements of the PCT are met. If so, the application is accorded an international filing date and also an application number.

International Search

The application is next subjected to an international search undertaken by an International Searching Authority (ISA). The purpose of the search is to ascertain if there are any prior art which would have effect on the patentability of the invention. The ISA, on concluding the search, will issue an International Search Report (ISR) and a Written Opinion on the findings of the search.

The results of the search may be useful to assist the applicant in assessing his chances of securing patent protection in the designated countries.

International Searching Authority (ISA)

The ISAs are designated patent offices of certain members of the PCT which are entrusted to undertake the task of performing international searches and generating ISRs based on the requirements set by the IB.

For international applications filed in Malaysia, the applicant may choose any of the following ISAs (as specified by MyIPO) to undertake the international search:-

- Korean Intellectual Property Office (KIPO);
- Australian Patent Office (IP Australia); or
- European Patent Office (EPO).

Publication

Generally, after eighteen (18) months from the priority date or the international filing date, whichever is the earlier, the international application together with the ISR is published. The summary pages of all published applications appear in the WIPO journal known as PCT Gazette, which is available on the WIPO website, <http://www.wipo.org>.

International Preliminary Examination

The international preliminary examination, as opposed to the international search, is an optional step. Should the applicant decide to opt for the examination, he must submit a request or demand for international preliminary examination directly to the International Preliminary Examining Authority (IPEA) together with the payment of the prescribed fee. The request must be made within twenty two (22) months from the priority date or the international filing date of the application, whichever is the earlier.

On receipt of the request, the IPEA will perform a preliminary examination on the patentability of the invention and an opinion on the patentability of the invention will be reported in an International Preliminary Examination Report (IPER).

International Preliminary Examining Authority (IPEA)

The IPEAs, like the ISAs, are patent offices of certain members of the PCT. Designated by the IB based on its requirements, the IPEAs are entrusted to undertake the task of performing international preliminary examinations and generating IPERs.

The applicant in Malaysia may select any of the following IPEAs (as specified by MyIPO) to undertake the international preliminary examination:-

- Korean Intellectual Property Office (KIPO);
- IP Australia (Australian Patent Office); or
- European Patent Office (EPO).

13.5. NATIONAL PHASE

The national phase, which is the second phase of an international application, begins with the filing of individual national applications in each of the desired countries, where protection is sought. During this phase, national patent laws will apply.

For entry into Malaysia, the applicant is required to file an application with MyIPO within thirty (30) months from the priority date of the international application. The application should consist of the following:-

- A copy of the international application in the English language;
- A request in the prescribed form (Form 2A); and
- Payment of prescribed fees.

Applications which enter the national phase in Malaysia are processed in accordance with the requirements of the PA and PR.

13.6. ADVANTAGES OF INTERNATIONAL APPLICATION

The advantages of an international application or a PCT application include the following:-

1. Increased time period to make a decision on pursuing patent protection abroad
 - Under the PCT system, the applicant is provided thirty (30) months, that is, an additional eighteen (18) months on top of the priority period of twelve (12) months (as provided under the Paris Convention) to enter into the national phase. The increased time period gives the applicant an opportunity to first explore the commercial potential of the invention and only then come to a decision on the countries where protection needs to be obtained
 - The additional time period also provides the applicant a chance to create early market awareness for his invention
2. Preliminary assessment of the patentability of the invention
 - The ISR and IPER issued on the PCT application during the international phase provide the applicant with valuable information on the patentability of the invention, which is crucial in making an informed decision on whether to pursue further with the patent protection in the desired countries
 - If the findings of the ISR or IPER are detrimental to the patentability of the invention, it would help the applicant avoid incurring further expenditure
3. Deferred patenting costs
 - The filing of a single PCT application in one country, in one language and with one set of fees, has the effect of filing in all member countries. As such, some of the patenting costs, like the translation

costs and local filing fees, may be delayed. Such costs need not be incurred until the application enters into the national phase, which would be about thirty (30) months later

14. APPENDIX

14.1. Appendix 1 – Location and Contact Details of Authorities

14.2. Appendix 11 – Schedule of Forms and Fees

14.3. Appendix 111 – Flowchart of Patent Registration Procedure in Malaysia

14.4. Appendix 1V – Flowchart of Patent Cooperation Treaty Application Procedure

14.5. Appendix V – Flowchart of Expedited Substantive Examination Procedure

APPENDIX 1

LOCATION AND CONTACT DETAILS OF AUTHORITIES

OFFICES	LOCATION AND CONTACT DETAILS	BUSINESS HOURS
Head Office: Kuala Lumpur	Patent Registration Office Intellectual Property Corporation of Malaysia (Perbadanan Harta Intelek Malaysia) Unit 1-7, Ground Floor Menara UOA Bangsar No. 5, Jalan Bangsar Utama 1 59000 Kuala Lumpur Phone No: +603-2299 8400 Fax No: +603-2299 8989	8.15 a.m. – 5.15 p.m.
Branch: Southern Office (Johor Baharu, Johor)	Patent Registration Office Intellectual Property Corporation of Malaysia (Perbadanan Harta Intelek Malaysia) Lot 1A, Podium 1, Menara Ansar, Jalan Trus, 80000 Johor Bahru Johor Phone No.: +607 222 2873 Fax No.: +607 222 2870	8.15 a.m. – 5.15 p.m.
Branch: East Coast Office (Kuantan, Pahang)	Patent Registration Office Intellectual Property Corporation of Malaysia (Perbadanan Harta Intelek Malaysia) A21-GF, 1st & 2nd, Block A Kuantan Perdana Commercial Centre, Jalan Tun Ismail 1 25000 Kuantan Pahang Darul Makmur Phone No.: +609-517 3749 Fax No.: +609-517 3776	8.15 a.m. – 5.15 p.m.

<p>Branch: Northern Office (Pulau Pinang)</p>	<p>Patent Registration Office Intellectual Property Corporation of Malaysia (Perbadanan Harta Intelek Malaysia) 2nd Floor, Unit No. 1, 2 & 3 Kompleks Sempilai Jaya, Jalan Sempilai 13700 Seberang Jaya Pulau Pinang</p> <p>Phone No.: +604-390 4134 Fax No.: +604-390 2276</p>	<p>8.15 a.m. – 5.15 p.m.</p>
<p>Branch: Sabah Office (Kota Kinabalu, Sabah)</p>	<p>Patent Registration Office Intellectual Property Corporation of Malaysia (Perbadanan Harta Intelek Malaysia) 6th Floor, Block C Bangunan KWSP 49, Jalan Karamuning PO Box 2068 88999 Kota Kinabalu Sabah</p> <p>Phone No: +6088-233 571 Fax No: +6088-257 046</p>	<p>8.00 a.m. – 4.30 p.m.</p>
<p>Branch: Sarawak Office (Kuching, Sarawak)</p>	<p>Patent Registration Office Intellectual Property Corporation of Malaysia (Perbadanan Harta Intelek Malaysia) Lot 9936, (Sublot 5), 3rd Floor, Queen's Court, Block E Jalan Wan Alwi 93350 Kuching Sarawak</p> <p>Phone No: +6082-459 075</p> <p>Fax No: +6082-455 052</p>	<p>8.00 a.m. – 4.30 p.m.</p>

APPENDIX 11

SCHEDULE OF FORMS AND FEES

PART 1

Forms		Matter/ Proceeding	E- Filing Fee (RM)	Manual Fee (RM)
				
1	1	(a) Request for grant of patent (b) Claims (i) for 1st ten claim (ii) for every additional claim (per claim)	260.00 Nil 20.00	290.00 Nil 20.00
2	2	Declaration of withdrawal of application	Nil	Nil
2A	2A	Entering national phase (a) for first ten claims (b) for every additional claim (per claim)	260.00 20.00	290.00 20.00
2A	2A	Request for reinstatement under section 78OA	650.00 per month of delay	690.00 per month of delay
5	5	Request for substantive examination	950.00	1,100.00
5A	5A	Request for modified substantive examination	600.00	640.00
5B	5B	Request for deferment of filing of request for examination or provision of information	Nil	Nil
5C	5C	Request for certified copies or extracts	70.00	80.00
5D	5D	Request to amend register	70.00	80.00
5E	5E	Request for reinstatement of lapsed patent	130.00	140.00
5F	5F	Request for licence to exploit patented invention	Nil	Nil
5G	5G	Request to convert application for patent into application for certificate of utility innovation or <i>vice versa</i>	260.00	290.00
5H	5H	Request for approval of expedited examination	200.00	250.00
5I	5I	Request for Expedited examination	2,000.00	2,200.00
6	6	Application for recording of assignment or transmission	130.00	140.00
7	7	Application for entry in Register that any person may obtain a licence	70.00	80.00
8	8	Application for cancellation of entry in Register that any person may obtain a licence	70.00	80.00

9	9	Request for recording of particulars of licence contract in Register	130.00	140.00
10	10	Request for recording expiry or termination of licence contract in Register	100.00	110.00
11	11	Application for compulsory licence	100.00	110.00
12	12	Request for amendment of decision	100.00	110.00
13	13	Request for cancellation of compulsory licence	100.00	110.00
14	14	Application for grant of certificate of utility innovation	130.00	140.00
15	15	Application to extend term of certificate for utility innovation	130.00	140.00
16	16	Request to amend application for grant of patent	70.00	80.00
16A	16A	Request to amend patent	70.00	80.00
17	17	Appointment or change of patent agent	70.00	80.00
18	18	Application for registration of patent agent	2,600.00	2,670.00
18A	18A	Application for registration as candidate for examination	130.00	140.00
18B	18B	Application to re-sit examination	130.00	140.00
19	19	Application for renewal of registration of patent agent	550.00	590.00
20	20	Furnishment of address for service	130.00	140.00
21	21	Request for extension of time	260.00	290.00
22	22	Statement justifying the applicant's rights to the patent/certificate	70.00	80.00

APPENDIX 11

SCHEDULE OF FORMS AND FEES

PART 11

Item	Matter/Proceeding	E-Filing Fees (RM)	Manual Fees (RM)
1.	Copy of patent	40.00	40.00
2.	Copy of search report	30.00	30.00
3.	Examination of register	15.00 per hour	15.00 per hour
4.	Certified copies or extract from Register	15.00 per page	15.00 per page
5.	Copy or extract from Register	3.00 per page	3.00 per page
6.	Fee for public inspection of information relating to patent application	30.00 per hour	30.00 per hour
7.	Certified copies or extract of any information :-		
	(a) for first five pages	100.00 per page	100.00 per page
	(b) for every additional page	3.00 per page	3.00 per page
8.	Annual fee for patent :		
	a) for second year after grant of patent	260.00	290.00
	b) for third year after grant of patent	330.00	360.00
	c) for fourth year after grant of patent	390.00	420.00
	d) for fifth year after grant of patent	460.00	490.00
	e) for sixth year after grant of patent	520.00	560.00
	f) for seventh year after grant of patent	600.00	640.00
	g) for eighth year after grant of patent	650.00	690.00
	h) for ninth year after grant of patent	720.00	760.00
	i) for tenth year after grant of patent	780.00	820.00

	j) for eleventh year after grant of patent	850.00	890.00
	k) for twelfth year after grant of patent	900.00	940.00
	l) for thirteenth year after grant of patent	1,050.00	1,100.00
	m) for fourteenth year after grant of patent	1,200.00	1,250.00
	n) for fifteenth year after grant of patent	1,300.00	1,350.00
	o) for sixteenth year after grant of patent	1,600.00	1,660.00
	p) for seventeenth year after grant of patent	1,850.00	1,900.00
	q) for eighteenth year after grant of patent	2,100.00	2,200.00
	r) for nineteenth year after grant of patent	2,400.00	2,500.00
	s) for twentieth year after grant of patent	2,600.00	2,700.00
9.	Surcharge for reinstatement	100 % of fee for year concerned	100 % of fee for year concerned
10.	Surrender of compulsory licence	80.00	90.00
11.	Surrender of patent	80.00	90.00
12.	Annual fee for certificate for utility innovation :		
	(a) for third year after grant of certificate		
	(b) for fourth year after grant of certificate	160.00	170.00
	(c) for fifth year after grant of certificate	210.00	240.00
	(d) for sixth year after grant of certificate	210.00	240.00
	(e) for seventh year after grant of certificate	260.00	290.00
	(f) for eighth year after grant of certificate	260.00	290.00
	(g) for ninth year after grant of certificate	320.00	350.00
	(h) for tenth year after grant of certificate	320.00	350.00
	(i) for eleventh year after grant of certificate	370.00	400.00
	(j) for twelfth year after grant of certificate	520.00	560.00
	(k) for thirteenth year after grant of certificate	780.00	820.00
	(l) for fourteenth year after grant of certificate	910.00	950.00

	(m) for fifteenth year after grant of certificate	1,050.00	1,100.00
	(n) for sixteenth year after grant of certificate	1,300.00	1,350.00
	(o) for seventeenth year after grant of certificate	1,450.00	1,500.00
	(p) for eighteenth year after grant of certificate	1,600.00	1,650.00
	(q) for nineteenth year after grant of certificate	1,700.00	1,750.00
	(r) for twentieth year after grant of certificate	1,850.00	1,900.00
		1,950.00	2,000.00
13.	Holding of hearing	130.00	140.00
14.	Certificate of grant of a patent	Nil	Nil
15.	Certificate for a utility innovation	Nil	Nil
15A.	Examination fee	130.00 per subject	140.00 per subject
16	Appeal against examination results	260.00 per subject	290.00 per subject
17	Extension of time (for every month or part of a month)	70.00	80.00
18	Surcharge for late payment of annual fee	100 % of fee for year concerned	100 % of fee for year concerned
19	Public search through computer	30.00	30.00
20	Computer print-out (Bibliography data)	10.00	10.00
21	Permitted information (upon request)		
	(a) for less than 10 pages	130.00	140.00
	(b) for the subsequent pages	7.00	7.00
22	Fee for preparing international application	3.00 per page	3.00 per page

APPENDIX 11

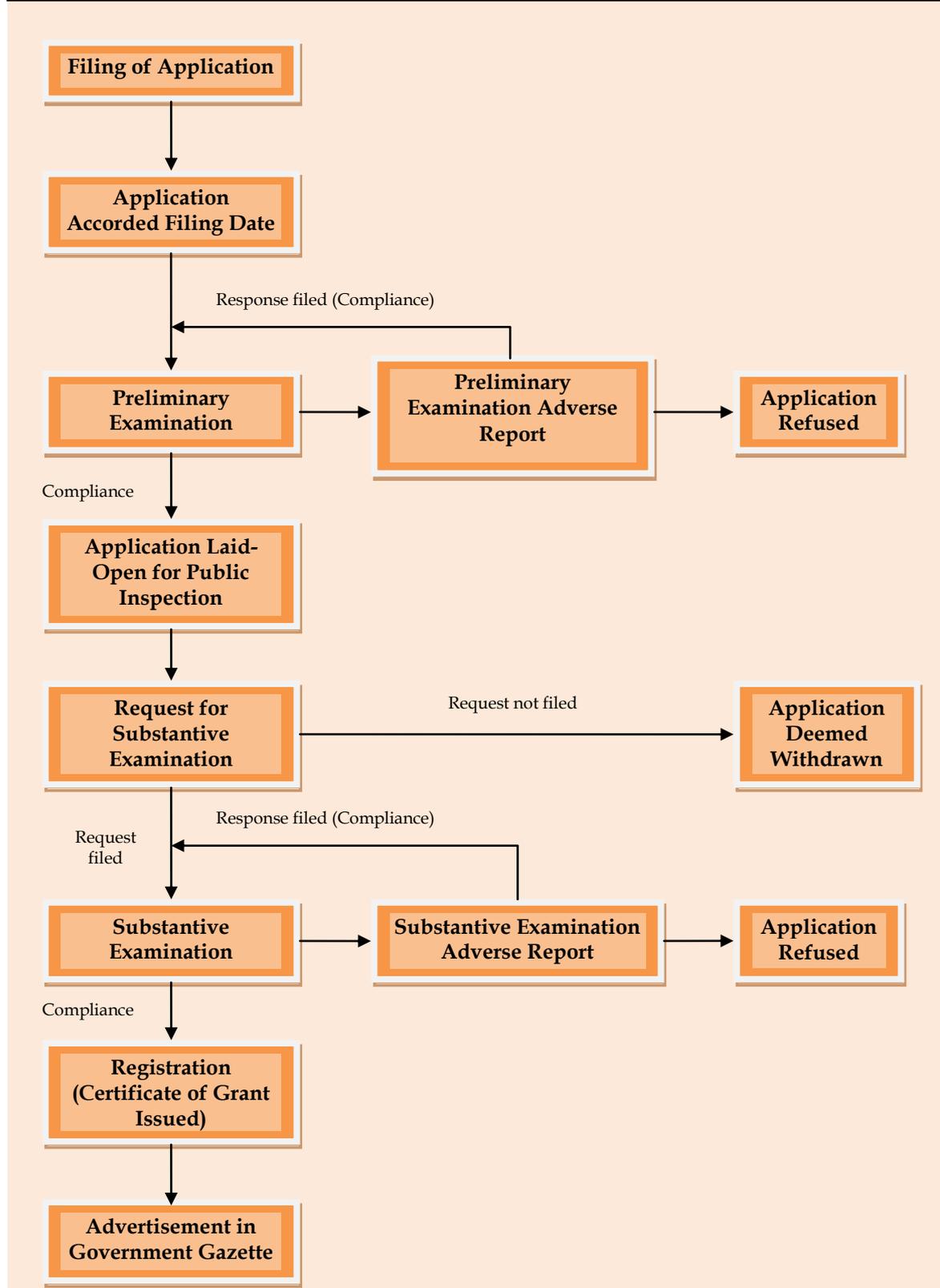
SCHEDULE OF FORMS AND FEES

PART 111

Item	Matter/Proceeding	E-Filing Fees (RM)	Manual Fees (RM)
1.	Transmittal fee under Rules 14 and 19 of the Regulations under the Treaty : (a) for the first 30 sheets (b) for each sheet in excess 30 sheets (per sheet)	500.00 60.00	550.00 70.00
2.	Fee for the late furnished of transliteration for the purposes of international search	25% of the international filing fee prescribed under the Treaty	25% of the international filing fee prescribed under the Treaty
3.	Fee for the late furnished of transliteration for the purposes of international publication	25% of the international filing fee prescribed under the Treaty	25% of the international filing fee prescribed under the Treaty
4.	Late payment fee under Rule 16 bis.2 of the Regulations under the Treaty	(i) 50% of the amount unpaid fees ; or (ii) an amount equal to the transmittal fee ; whichever is the higher provided that the amount of late payment fees shall not exceed 50% of the international filing fee prescribed under the Treaty	
5.	Fee for complying with National requirement in response to the invitation	130.00	140.00

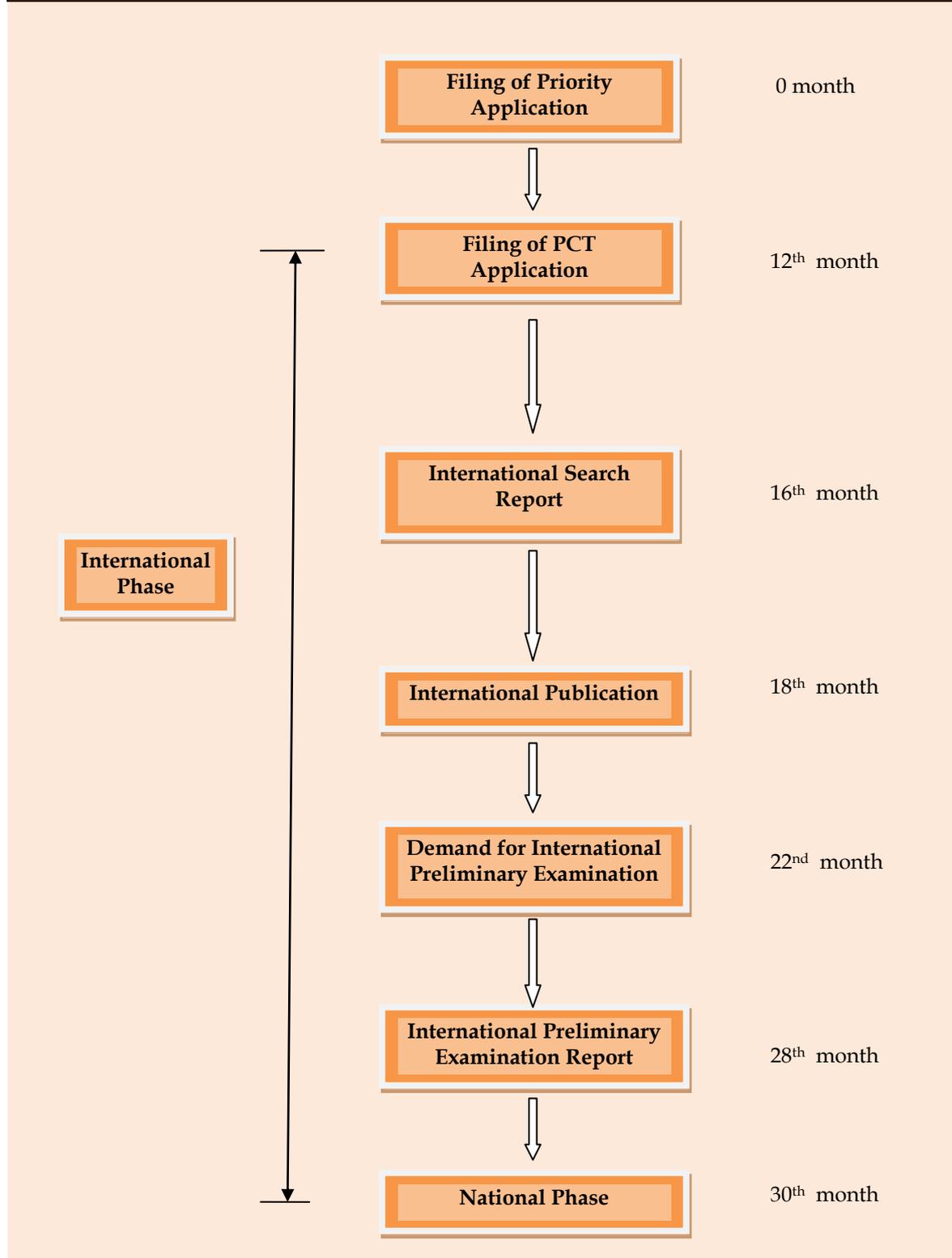
APPENDIX 111

**FLOWCHART OF PATENT REGISTRATION PROCEDURE
IN MALAYSIA**



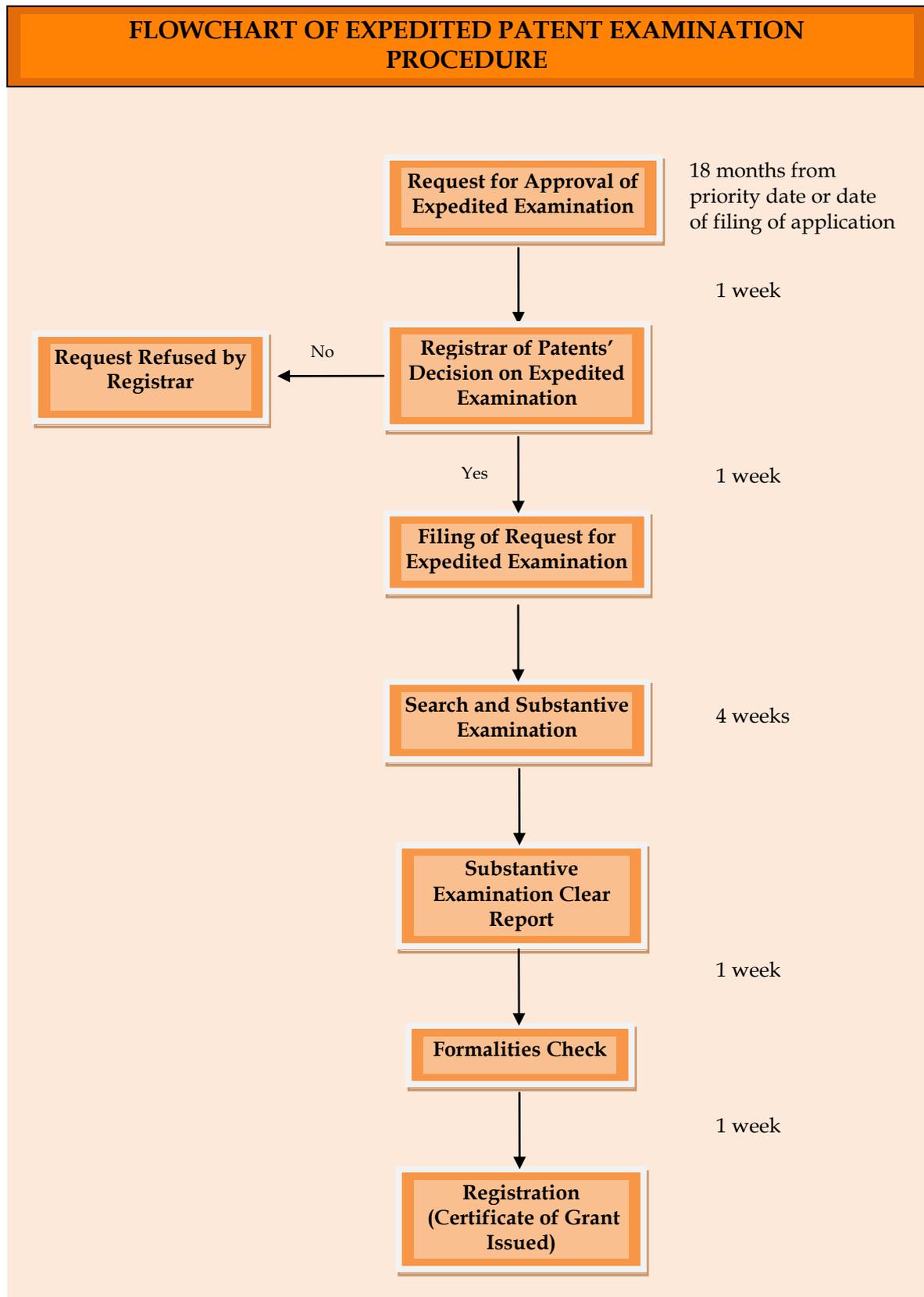
APPENDIX 1V

FLOWCHART OF PATENT COOPERATION TREATY APPLICATION PROCEDURE



APPENDIX V

FLOWCHART OF EXPEDITED PATENT EXAMINATION PROCEDURE



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REFERENCE

The author acknowledges reference to the following sources in the preparation of this booklet:

- Patents Act 1983
- Patents Regulations 1986
- Resources made available by the Intellectual Property Corporation of Malaysia

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