

MALAYSIA

PATENT HANDBOOK

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Disclaimer: This IP HANDBOOK is intended to provide general guidelines only and not advice with regard to specific cases. The information given is non-exhaustive. Please also note that the relevant law and its interpretation are subject to change. You should contact us for advice specific to your own situation. Whilst every effort has been made to ensure the accuracy of the information, Pintas IP Group shall not be responsible for any inaccuracies or omissions, however caused therein. Nor can any responsibility be accepted for any loss or damage to any company or person as a result of actions taken or not taken on the basis of the content of this handbook.

In Malaysia, patent protection is obtainable by way of either entering the national phase of a Patent Cooperation Treaty (PCT) application or filing a direct national application.

Legislation

Patents Act 1983 (Act 291), Patents Regulations 1986

Patentability Criteria

A patent has to fulfill the following conditions in order to claim protection.

- it is new
- it involves an inventive step
- it is industrially applicable

Non-Patentable Subject Matter

An invention is not patentable if it contains the following:

- discoveries, scientific theories and mathematical methods;
- plant or animal varieties or essentially biological processes for the production of plant or animals;
- schemes, rules or methods for doing business, performing mental acts, and
- methods for the treatment of the human or animal body by surgery or therapy, and diagnostic methods practiced on the human or animal body.

Utility Innovations

The Malaysian patent system also provides for the grant of utility innovation certificates. A utility innovation must fulfill the criteria of novelty and industrial applicability (but not inventiveness). A utility innovation certificate may only have one claim and subject to evidence of commercial/industrial use in Malaysia, enjoys the same duration of protection like a patent.

Membership

√ - Paris Convention

√ - PCT

Malaysia is a member of the Paris Convention since 1989, whereby applications from convention countries will be subject to the same priority date in Malaysia. The application for priority has to be made within twelve months of the first application in a convention country.

Malaysia is also a member of the PCT since 2006. An applicant who has made an international patent application may file and/or prosecute the patent application during its national phase entry into Malaysia within 30 months from the filing date of the international application or from the earliest priority date of the application if a priority is claimed.

Rule of Priority

Unless requested by an Examiner, there is no requirement to file a certified copy of any priority application. "First to Apply" is the rule followed by Malaysia in determining priority of patents.

Duration

For patent filed prior to 1st August 2001, the duration of protection is 15 years from the date of grant or 20 years calculated from the filing date, whichever expires later. For patents filed on or after 1st August 2001, the duration is 20 years calculated from the filing date (for a direct national application) and from the international filing date (for a PCT national phase application), provided the prescribed annual fees are paid.

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Procedures

▼ Application

Every applicant is required to submit an application to the registrar of patents within 12 months of priority date.

▼ Publication

Details of the application, including the specification are made available for public inspection after 18 months from the patent filing date. Once published, the application will enjoy provisional protection under which, upon grant, the patentee may claim compensation for unauthorized use of the invention prior to grant.

▼ Substantive Examination

Every applicant has to file a request for a substantive or modified substantive examination within 18 months (for filing made before 15 Feb 2011, it was 24 months) from the patent filing date (for a non-PCT patent filing into Malaysia) and within 48 months from the international filing date (for a PCT national entry into Malaysia), wherein the registrar will refer the application to the examiner. The examiner will then submit a report after examining the application for compliance of regulations. Once the applicant makes observations on the report or amendments as the case may be the examiner will again report to the registrar who will then process the application.

▼ Registration

A patent once registered is valid for a term of 20 years and will be subject to protection subject to payment of annual renewal fees. Annuity is payable upon grant.

Filing Requirements

The following information and/or documents are required to file an application for a patent application in Malaysia:-

Direct National Application:-

- Request for the grant of a patent (PF 1):-
 - △ the name and address of the applicant;
 - △ the name and address of the inventor;
 - △ a specification comprising a description, claims and any necessary drawings; and
 - △ the country and filing particulars of basic application whose priority is claimed.
- Appointment of Patent Agent (PF 17).
- If the applicant is not the inventor, a statement explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.
- There is no requirement for the filing of an assignment from inventor to applicant.

PCT National Phase Application:-

- Form 2A;
- A copy of the PCT application in English language (i.e. request form PCT/RO/101);
- The details of the PCT application (suitably, the bibliographic page as published by WIPO);
- One copy of the PCT specification as originally filed (in or translated to English);
- One copy of any amendments filed in the international phase (in or translated to English);
- An Appointment of Agent form signed by the applicant; and
- If the applicant is not the inventor, a statement explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.

Documents To Be Furnished For Filing A Patent Application in Malaysia

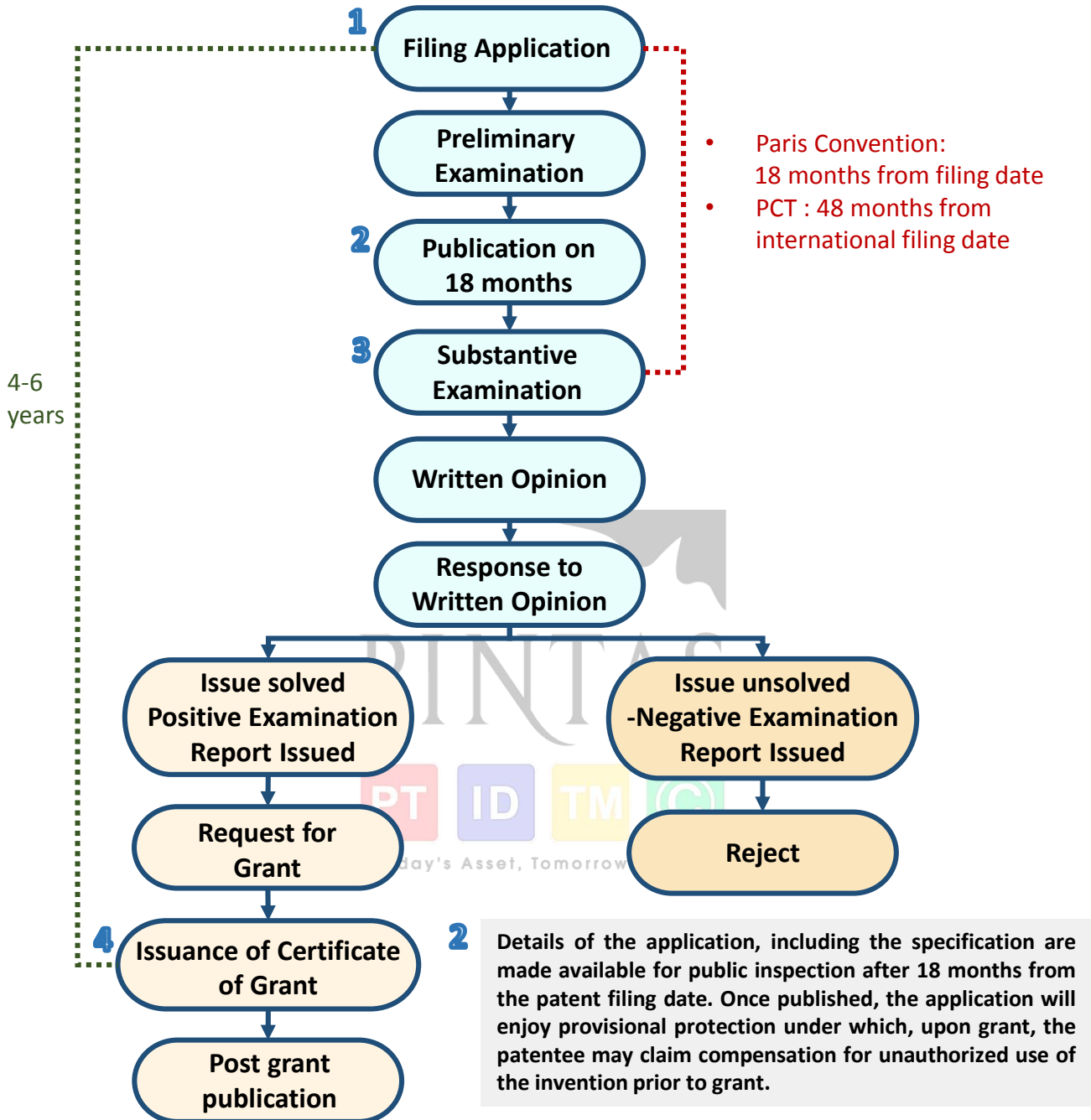
Basic Requirements		
Documents	Remarks	Time of Filing
Patent specification, claims and abstract in English	No legalization requirement	On filing date
Drawings	(If Any)	On filing date

Additional Documents for Convention Patent Application		
Documents	Remarks	Time of Filing
Priority documents	Certified copy of the basic patent application	Within 2 months from request by the Examiner
Appointment of Agent (PF17)		Within 2 months from request by the Examiner

Additional Documents for Entry of PCT National Phase in Brunei	
Documents	Time of Filing
International Preliminary Report on Patentability based on International Preliminary Search Report (Chapter I); or	On filing date
International Preliminary Report on Patentability based on International Preliminary Examination Report (Chapter II)	On filing date

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Patent Application Process In Malaysia (Substantive Examination Regime)



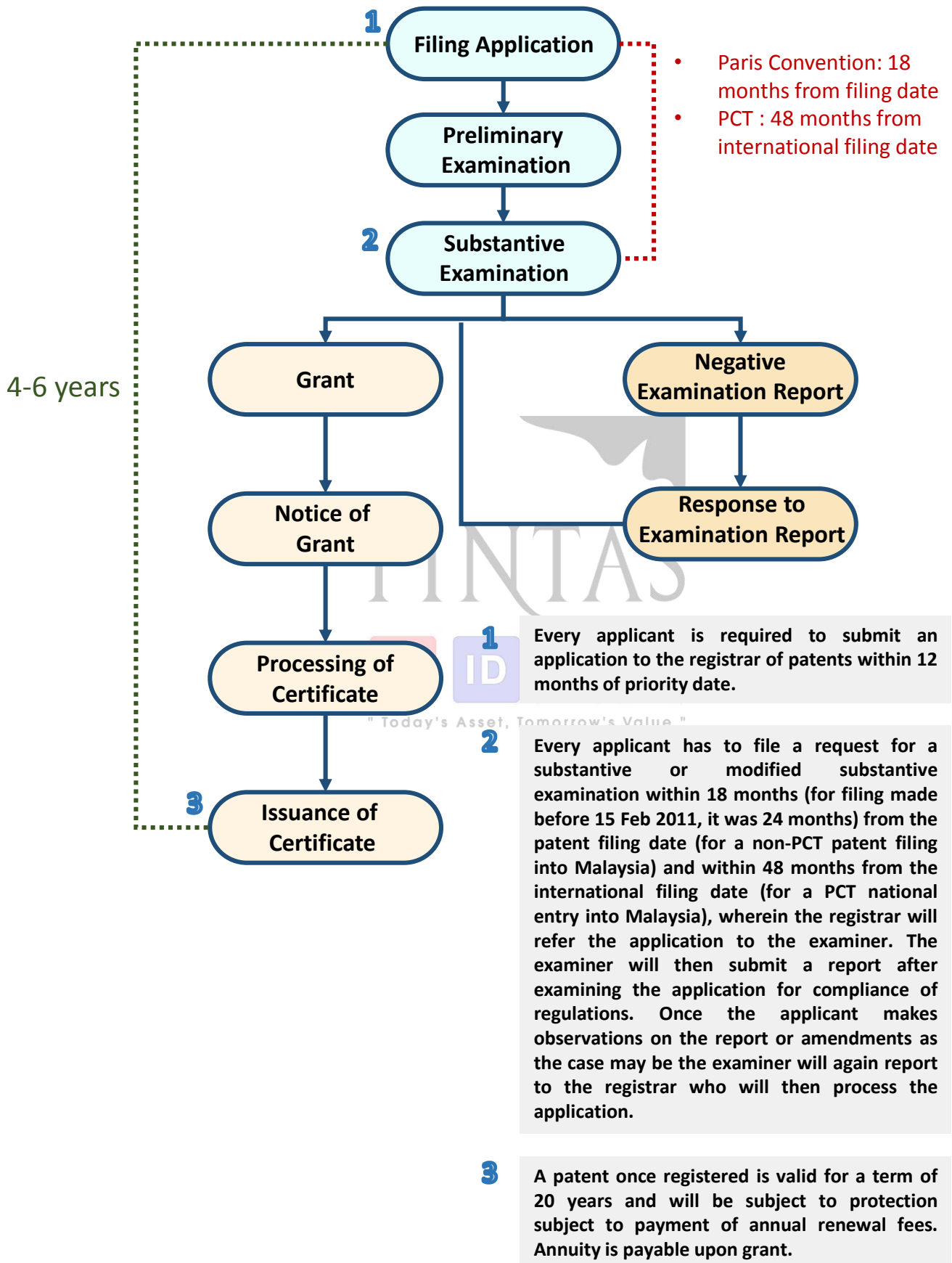
1 Every applicant is required to submit an application to the registrar of patents within 12 months of priority date.

4 A patent once registered is valid for a term of 20 years and will be subject to protection subject to payment of annual renewal fees. Annuity is payable upon grant.

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Utility Model Patent Application Process In Malaysia (Substantive Examination Regime)



**MALAYSIA
OFFICE**

Kuala Lumpur / Corporate Office

Pintas Consulting Group Sdn Bhd (461057-W)

Adds: Suite 2B-21-1, Level 21, Block 2B, Plaze Sentral,
Jalan Stesen Sentral 5, KL Sentral, 50470 Kuala Lumpur,
Malaysia.

Selangor / Correspondence Operation Office

Adds: No.19, Jalan SS 1/36, 47300 Petaling Jaya, Selangor.

Tel: +603-7876 5050

Fax: +603-7876 2678

H/P: +6012-797 5077

Email: marketing@pintas-ip.com

**SINGAPORE
OFFICE**

Pintas Pte Ltd (20010467111)

Adds: Suite 12-14, Manhattan House, 151 Chin Swee Road,
Singapore 169876.

Tel: +65-6250 2070

Fax: +65-6737 1805

H/P: +65-9747 2579

Email: pintas.sg@pintas-ip.com

**CHINA
OFFICE**

Pintas Inc (Customer Service Office)

Adds: Room1811, 18th Floor, Far East Tower,
No. 1101 Pudong Road (s) Pudong, Shanghai,
200120, China.

Tel: +86-21 32180770

Fax: +86-13 022176477

Email: pintas.china@pintas-ip.com

**USA
OFFICE**

Pintas LLC (Customer Service Office)

Adds: P.O. Box 190943, Boise, Idaho
83719-0943, United States of
America.

Tel / Fax: +1 208 899 8528

Email: pintas.usa@pintas-ip.com

**BRUNEI
OFFICE**

Pintas Consulting Group (Customer Service Office)

Adds: P.O.Box 18, Anggerek Desa Complex,
BB3780 Brunei Darussalam.

Tel: +673-873 8478

Fax: +673-245 2112

Email: pintas.brunei@pintas-ip.com