



LAWS OF MALAYSIA

Act A1264

PATENTS (AMENDMENT) ACT 2006

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LAWS OF MALAYSIA**Act A1264****PATENTS (AMENDMENT) ACT 2006**

An Act to amend Patents Act 1983.

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ENACTED by the Parliament of Malaysia as follows:

Short title and commencement

1. (1) This Act may be cited as the Patents (Amendment) Act 2006.

(2) This Act comes into operation on a date to be appointed by the Minister by notification in the *Gazette*.

New section 35B

2. The Patents Act 1983 [*Act 291*], which is referred to as the “principal Act” in this Act, is amended by inserting after section 35A the following section:

“Applicant or Patent Registration Office may request for international search

35B. (1) Any applicant who files an application, other than an international application, for the grant of a patent with the Patent Registration Office may request that an international search be carried out on such application by the International Searching Authority which is specified under subsection 78L(1).

(2) The Patent Registration Office may subject an application, other than an international application, for the grant of a patent filed with it to an international search to be carried out by the International Searching Authority which is specified under subsection 78L(1).

(3) Where a search is carried out on an application pursuant to subsection (1) or (2), the description and claims contained in the application shall be presented in the languages specified by the International Searching Authority and the search fees as specified by the International Searching Authority shall be paid by the applicant either to the International Searching Authority directly or via the Patent Registration Office.”.

Amendment of section 78A

3. Section 78A of the principal Act is amended—

(a) by inserting after the definition of “national phase” the following definitions:

‘ “State” means a state which is a party to the Treaty;

“patent” includes utility innovation;’;

(b) in the national language text, by inserting a semicolon at the end of the definition of “permohonan antarabangsa”;

(c) in the English text, by substituting for the full stop at the end of the definition of “international application” a semicolon; and

(d) by substituting for the semicolon at the end of the definition of “Treaty” a full stop.

Amendment of section 78D

4. Section 78D of the principal Act is amended by substituting for the words “or utility innovation under Part VI” the words “under Parts IVA and VI”.

Amendment of section 78F

5. Section 78F of the principal Act is amended by substituting for the word “Any” the words “Subject to section 23A, any”.

Amendment of section 78G

6. Section 78G of the principal Act is amended—

(a) in subsection (1), by inserting after the word “abstract” the words “in the form as specified in the Treaty”;

(b) by inserting after subsection (1) the following subsection:

“(1A) An international application shall be filed in the English language.”;

(c) by inserting after subsection (2) the following subsection:

“(2A) An international application which has been accorded an international filing date shall have the effect of a patent application under this Act if the application designates Malaysia for the purpose of obtaining a patent under this Act and the international filing date shall be considered to be the filing date for the purposes of Parts IVA and VI.”; and

(d) by deleting subsection (3).

Deletion of section 78H

7. Section 78H of the principal Act is deleted.

Deletion of section 78I

8. Section 78I of the principal Act is deleted.

Deletion of section 78J

9. Section 78J of the principal Act is deleted.

Amendment of section 78K

10. Section 78K of the principal Act is amended by deleting the words “and its rules”.

New section 78KA

11. The principal Act is amended by inserting after section 78K the following section:

“Fees

78KA. An international application shall be subject to the fees as specified in the Treaty and other prescribed fees.”.

Amendment of section 78M

12. Subsection 78M(2) of the principal Act is amended by substituting for the words “the prescribed form and paying the prescribed fee” the words “accordance with the Treaty”.

Substitution of section 78O

13. The principal Act is amended by substituting for section 78O the following section:

“Entering the national phase

78O. (1) Where in an international application, the applicant designates Malaysia for the purpose of obtaining a patent under this Act, the applicant shall, before the expiration of thirty months from the priority date—

- (a) submit to the Patent Registration Office a copy of the international application in the English language; and
- (b) pay the prescribed fee.

(2) The Patent Registration Office shall not examine the international application submitted under subsection (1) prior to the expiration of thirty months from the priority date.

(3) Notwithstanding subsection (2), the Patent Registration Office may, on the request of the applicant, examine an international application prior to the expiration of thirty months from the priority date, if the applicant has—

- (a) submitted to the Patent Registration Office a copy of the international application in the English language; and

(b) paid the prescribed fee under subsection (1).

(4) If the applicant does not comply with the requirements of subsection (1), the international application shall be considered to be withdrawn for the purposes of this Act and the Registrar shall notify the applicant that his international application is considered to have been withdrawn.

(5) Any application which has entered the national phase shall comply with the requirements of this Act.”.

New section 78oA

14. The principal Act is amended by inserting after section 78o the following section:

“Reinstatement

78oA. (1) Where an international application is considered to be withdrawn under section 78o, the applicant may, in writing, apply to the Patent Registration Office to have the international application reinstated by—

- (a) submitting to the Patent Registration Office a copy of the international application in the English language and paying the prescribed fee under subsection 78o(1);
- (b) submitting a written statement stating the reasons for the failure to comply with subsection 78o(1) and a declaration or other evidence in support of the reasons for such failure; and
- (c) paying the prescribed fee.

(2) The application under subsection (1) shall be made within whichever of the following period expires first:

- (a) two months from the date of removal of the cause of the failure to meet the time limit provided in subsection 78o(1); or
- (b) twelve months from the date of the expiration of the time limit provided in subsection 78o(1).

(3) Where the Patent Registration Office is satisfied that the failure by the applicant to comply with the requirements of subsection 78o(1) was unintentional, the Patent Registration Office shall reinstate the rights of the applicant with respect to the international application.

(4) Where the Patent Registration Office is not satisfied that the failure by the applicant to comply with the requirements of subsection 78o(1) was unintentional, the Patent Registration Office shall notify the applicant that it intends to refuse the application and give an opportunity to the applicant to make a written representation on the intended refusal within fourteen days from the date of the notice.

(5) After considering any representation made by the applicant under subsection (4), the Patent Registration Office shall decide whether to reinstate the international application or to refuse the application for reinstatement and notify the applicant of its decision.”.

Deletion of section 78p

15. Section 78p of the principal Act is deleted.

Amendment of section 78q

16. Section 78q of the principal Act is amended—

(a) by substituting for subsection (1) the following subsection:

“(1) Where—

(a) a foreign receiving office has—

(i) refused to accord a filing date to an international application;

(ii) declared that the international application is considered withdrawn; or

(iii) declared that the designation of Malaysia is considered withdrawn; or

(b) the International Bureau has declared that an international application is considered withdrawn because it has not received a record copy of the international application within the time specified under the Treaty; and

(c) copies of any document in the international application have been sent to the Patent Registration Office,

the applicant may request the Patent Registration Office to review the justification of the refusal or declaration under the Treaty.”; and

(b) by deleting subsection (3).