

THE MALAYSIAN PATENT SYSTEM

Prior to October 1, 1986, protection of patents in Malaysia was effected under the following:

- (a) The Registration of United Kingdom patents Ordinance 1951;
- (b) The Patents Ordinance of Sarawak;
- (c) The Registration of United Kingdom Patents Ordinance of Sabah; and
- (d) The Patents (Right of Government) Act, 1967.

These Ordinances/Acts was repealed with the coming into force of the Patents Act 1983, the Patents (Amendment) Act 1986 and the Patent Regulations 1986 as amended by the Patents (Amendment) Regulations 1997. This Act gives protection to inventions which may relate to a product or a process.

❖ **Patentability Inventions**

An invention is patentable if it fulfill with three basic requirement:-

- (1) Novelty, (*i.e. newness*)
- (2) Involves an inventive step, & (*i.e. would not have been obvious to a person having ordinary skill in the art*); &
- (3) Industrial applicable (*i.e. it can be made or used in any kind of industry including agriculture*).

❖ **Non-Patentability Inventions**

Section 13(1) of the Malaysian Patent Act also provides exclusion from patentability certain inventions. They are:-

- (a) discoveries, scientific theories and mathematical methods;
- (b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living microorganisms, micro-biological process and the products of such micro-organism processes;
- (c) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (d) methods for the treatment of the human or animal body by surgery or therapy, and diagnostic methods practiced on the human or animal body:

❖ **What are the rights of a patent owner**

The right conferred by a patent is the right to exclude others from using the invention in various way.

Section 36(1) of the Patent Act 1983 provides that the owner of a patent shall have the:-

- i) Exclusive rights to exploit the patented invention,
- ii) Assign or transmit the patent, and
- iii) To conclude license contracts

Exploitation of a patented invention means:

- a.
 - (i) making, importing, offering for sale, selling or using the products;
 - (ii) stocking such product for the purpose of offering for sale, selling or using;
- b. in respect of a patent which is a process:
 - (i) using the process;
 - (ii) doing any of the acts referred to in (a) above

❖ **Patent Application and its procedures**

The process of obtaining a patent starts with the writing of the specification which describes and precisely defines the invention.

A first patent application is normally filed in the country in which the invention is made. Under sections 23A and 30A of the Patent Act 1983, the government retains the right to prohibit the publication of details of an invention, whether here or abroad for reasons of national interest or security. This provision is normally limited in its application to inventions relating to the defense industry. However, it should be aware that patent applications relating to local inventions must not be filed overseas simultaneously with filing at the Malaysian Patent Registration office, or without any filing in Malaysia, unless prior written authority is obtained from the Registrar in Malaysia.

The patent application has three basic elements:

1. application form;
2. specification; and
3. filing fee.

These three elements must all be filed together in order to secure a filing date for the application.

After filing, an application is subjected to three different types of examination, in the following order:

1. examination as to whether the requirements for a filing date are met;
2. preliminary examination as to be completeness of the documents and their suitability for reproduction later on when the patent is published; and
3. substantive examination as to whether the application relates to a patentable invention and discloses it in adequate detail and clarity.

The formal examinations (1) and (2) are performed automatically, whereas the substantive examination (3) is made only upon specific request and payment of a further official fee, within a certain time limit, (*i.e. 2 years from the filing date of the application*).

The complicated and strict legal requirements for preliminary and substantive searches and examinations before grant of a patent require a lapse of time of three to five years before such grant.

❖ **Grant**

When the Registrar is satisfied that the application complies with the requirements of the Act, he shall grant the patent.

❖ **Duration of Patent**

The period for patent protection is 20 years from the date of filing [Amend. Act 2000], subject to yearly renewal. The proprietor of the patent has the right to assign or to license the use of a patent. There are certain limited circumstances, which are consistent with international norms, where compulsory licensing, subject to payment of royalties, are issued. It should be noted that obtaining a commercially valuable patent or certificate can be a complicated process.

❖ **Infringement**

Any person who contravenes the rights of the owner of a patent is, subject to various provisions, liable to proceedings for infringement of a patent brought by the patentee or licensee in the court.

Section 60(1) of the Patents Act provides that where there is infringement, the court can award damages, an account of profits and/or an injunction, or any other legal remedy.

❖ **Offences**

The following are offences under Part XIII the Act and all are punishable by a fine not exceeding RM15,000 and/or imprisonment for up two years:

- 1) making a false entry in the Register, or making a writing purporting to be a copy of a Register entry or producing such a false writing in evidence (section 63);
- 2) falsely claiming that any product or process disposed of for value is patented or falsely representing that any article disposed of for value is subject to a patent application, provided that where a patent or patent application has existed, sufficient time has expired since the patent or application ceased to exist that it is unreasonable to be still marketing a product bearing an indication of the patent or application (section 64 and 65);
- 3) falsely representing an official connection with the Patent Registration Office (section 66); and
- 4) carrying on business, practicing, acting, etc as a patent agent without being registered under the Act (section 66A).

It is also an offence under section 80(1)(c) and (2) to fail, without lawful excuse to produce any documents requested by the Registrar. In this case, the penalty on conviction is a fine not exceeding RM2,000 and/or up to six months in jail. The importance of supplying any document asked for by the Registrar should always be remembered when a client is reluctant to disclose requested information about search and examination results in corresponding foreign patent applications.

❖ **Enforcement**

The Minister has the power to authorise any public officer to exercise certain powers including the power of arrest and the power of search with seizures etc, with a warrant and to examine witness in regard to offences under the Act.

❖ **Invalidation**

Section 56(1) & (2) of the Patents Act provides for any aggrieved person to institute Court proceedings against the Owner for invalidation of the patent on the following grounds:

- (a) that the invention was not a patentable invention within the meaning of the Act;
- (b) that the descriptions or claim does not comply with the requirement of the Regulations;
- (c) that any drawings which are necessary for the understanding of the claimed invention have not been furnishes;
- (d) that the right to the patent does not belong to the person to whom the patent was granted, or
- (e) incomplete or incorrect information has been deliberately provided by the applicant or his patent agent in relation to a request for full substantive examination.

❖ **Utility Innovation**

Apart from protection for patents, the Patent Act also grants protection to utility innovations. A utility innovation is intended to provide intellectual property rights for those incremental and lower level inventions that would not be sufficiently inventive to qualify for patent protection. It does not required to meet the test for inventive step, as with a patent, but only need to be "new" in Malaysia. You can include only one claim in your application for utility innovation, as opposed to an unlimited number of claims in a patent application.

The duration of a certificate for a utility innovation shall be 10 years from the filing date of the application [Amend. Act 2000] . It can be extended for 2 further periods of 5 years.