



A Guide to the
**MALAYSIAN
IP SYSTEM**

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& Co. Sdn. Bhd.

PATENT, TRADEMARK & DESIGN AGENTS

MALAYSIA

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**MALAYSIAN
IP SYSTEM**

Please note that the information contained in this booklet is presented in good faith for general information and does not constitute legal advice. Kindly contact us should you have any specific questions. Based on the law as at 15 February 2011.

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MALAYSIA

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Introduction

Malaysia's Intellectual Property (IP) laws have been declared to be in conformance with the requirements of the WTO's TRIPs Agreement. By way of further development of the legal regime, the Patent Cooperation Treaty (PCT) entered into force for Malaysia on 16 August 2006 and accession to the Madrid Protocol on the international registration of marks is under consideration. Moreover, the country's modern and comprehensive set of IP laws is backed up by a determination on the part of the Government to promote the registration and enforcement of intellectual property rights.

Since March 2003, the administration of Patent, Trade Mark, Industrial Design and Copyright has been carried out by a newly-formed body known as the Malaysian Intellectual Property Corporation, which later adopted the brand name MyIPO. MyIPO's website is at www.myipo.gov.my. MyIPO is fully autonomous in its administration and finance. Within months of its formation, MyIPO had recruited and started training substantial numbers of new staff at all levels, including additional patent and trade mark examiners. This change brought dramatic increases in the numbers of applications being examined and registered, in addition to a much more responsive and customer-oriented organization. Regular dialogue sessions between MyIPO and local IP professionals and rights owners have led to significant and beneficial changes in official practice.

The Government and MyIPO have also taken up the challenge of promoting greater awareness of the importance of IP among the Malaysian business and trading community by organising regular seminars as well as an annual National IP Day event. An active and strengthened Enforcement Division regularly investigates and raids shops and factories harbouring infringing and counterfeit articles. Continuing efforts on all sides in developing the Malaysian IP system augur well for both local and foreign interests.

Patent

Patent protection in Malaysia is governed by the Patents Act 1983 which came into force on 01 October 1986. The earlier system of re-registering United Kingdom patents has been repealed.

Malaysia is a member of the Paris Convention and the World Trade Organization. The Patent Cooperation Treaty (PCT) entered into force for Malaysia (country code: MY) on 16 August 2006. Patent protection is thus obtainable in Malaysia by way of either entering the national phase of a PCT application or filing a direct national application.

PATENTABILITY

An invention is defined as an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.

Malaysia adopts a first-to-file system with novelty generally assessed on an absolute basis. Thus, apart from limited exceptions, prior art consists of everything disclosed to the public, anywhere in the world, in any way before the priority date of an application. The content of the patent granted on an earlier-filed Malaysian application (that was not prior-published) is also citable for the purposes of novelty, although not inventive step.

A novelty grace period of 12 months preceding the Malaysian filing date is available in respect of prior disclosure due to acts committed by, or in abuse of the rights of, the applicant or his predecessor in title.

Inventive step is assessed based on obviousness to a person having ordinary skill in the art.

An invention is considered capable of industrial application if it can be made or used in any kind of industry.

NON-PATENTABLE INVENTIONS

Inventions consisting of any of the following are expressly excluded from patentability:

- 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 micro-organisms, microbiological processes and the products of such microbiological processes;
- c) schemes, rules or methods for doing business, performing purely mental acts or playing games; and
- 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.

Nevertheless, the exclusion (d) above is without prejudice to the patentability of a novel medical use of any known substance or composition. In practice, claims of first and second medical use category are normally accepted during prosecution.

FILING REQUIREMENTS – DIRECT NATIONAL APPLICATION

The minimum requirements for securing a filing date (and priority date) of a Malaysian patent application are:

- a) the name and address of the applicant;
- b) the name and address of the inventor;
- c) a specification comprising a description, claims and any necessary drawings; and
- d) the country and filing date of any earlier application whose priority is claimed.

It is preferable, although not essential, to file the following additional information and documents with the initial application:

- e) the serial number of any priority application and the symbol of the International Patent Classification (IPC) allocated to it (if available);
- f) the state of incorporation/nationality of the applicant;
- g) an abstract of the invention;
- h) an Appointment of Agent form signed by the applicant; and
- i) 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.

The provision of the priority serial number, under item e), is due three months from the Malaysian filing date. The other items (f) through (i) may be filed later, if necessary, during the preliminary examination that occurs soon after filing the application. An adverse preliminary examination report has a three-month response term. There is no requirement or provision for the filing of an assignment from inventor to applicant.

The official languages for a Malaysian patent application are English and the national language, Bahasa Malaysia. In practice, nearly all applications are currently filed in English.

FILING REQUIREMENTS – PCT NATIONAL PHASE APPLICATION

The term for entering the Malaysian national phase of a PCT application is 30 months from the earliest priority date. This term applies irrespective of whether a Demand for international preliminary examination under Chapter II PCT has been filed. The official language for national phase entry is English. No other language has been prescribed.

The minimum requirements are:

- a) the details of the PCT application (suitably, the bibliographic page as published by WIPO);
- b) one copy of the PCT specification as published (in or translated to English);
- c) one copy of any amendments filed in the international phase (in or translated to English);
- d) Form PCT/RO/101 – the Request (in or translated to English);
- e) Form PCT/1B/306 – notification of the recording of a change (if any); and
- f) Form PCT/1B/308 (Second Notice) – communication of application to designated offices which apply 30-month time limit.

It is preferable, although not essential, to file the following additional information and documents with the initial application:

- g) an Appointment of Agent form signed by the applicant; and
- h) 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.

The additional items (g) and (h) may be filed later, if necessary, during the preliminary examination that occurs soon after filing the application. An adverse preliminary examination report has a three-month response term. There is no requirement or provision for the filing of an assignment from inventor to applicant.

REINSTATEMENT INTO PCT NATIONAL PHASE

An applicant that unintentionally fails to meet the requirements for national phase entry within the regular 30-month term may apply for reinstatement. Apart from completing the regular national phase entry requirements, the applicant must pay a surcharge for each month of lateness and submit

- (i) a written statement of reasons; and
- (ii) a declaration or other evidence in support of the request for reinstatement.

In practice, the written statement may be prepared on our side, whereas MyIPO prefers a Statutory Declaration from the applicant or their attorney for the requirement (ii).

The maximum term for seeking reinstatement is

- (i) two months from the date of removal of the cause of the failure to meet the 30-month deadline or
- (ii) 12 months from the 30-month deadline,

whichever expires first.

PRIORITY DOCUMENTS

Unless requested by an examiner, there is no requirement to file a certified copy of any priority application or a translation thereof.

PUBLICATION AND PROVISIONAL PROTECTION

Malaysian patent applications are not published in printed form. However, the details of the application, including the specification and any amendments made to it are made available for public inspection after 18 months from the earliest priority date. The making available for public inspection of a pending application confers a so-called provisional protection under which, upon grant, the patentee may claim compensation for unauthorized use of the invention prior to grant. The international publication of a PCT application that designates Malaysia has equivalent effect in terms of provisional protection.

MAINTENANCE FEES

There are no maintenance fees payable on pending Malaysian patent applications.

EXAMINATION

A request for substantive examination must be filed within eighteen months of the Malaysian filing date for a direct national application, and within four years of the international filing date for a PCT national phase application. For direct national applications filed before 15 February 2011, the term for requesting substantive examination is two years from the Malaysian filing date.

There are two options: normal substantive examination and modified substantive examination.

Under normal substantive examination, MyIPO will conduct its own search and substantive examination of the application, assisted whenever possible by the results of any search and examination of the same invention in recognized foreign jurisdictions. For this purpose, the request for normal substantive examination must be accompanied by

- (i) the filing details of all related patent applications made in Australia, the United Kingdom, the European Patent Office, Japan, Korea, the United States and under the PCT;
- (ii) the serial numbers of any patents granted on those applications; and
- (iii) any available search and examination results of those applications including reports prepared under the PCT.

Certified English translations are required for any documents not in English. In current practice, an examiner will proceed to conduct normal examination without waiting for the above information or materials to be submitted. A deliberate failure to comply with the requirement may render the patent liable to invalidation. The requirement is not an ongoing one, but an examiner may call for further information or documents to be filed in the course of the examination.

A request for modified substantive examination may only be filed when a corresponding Australian, European, United Kingdom, Japanese, Korean or United States patent has been granted for the same invention. The request for modified substantive examination must be accompanied by a certified copy of the foreign patent relied on and, if the patent is not in English, a certified translation thereof into English. The description, claims and drawings of the Malaysian application must also be brought into substantial agreement with those of the granted foreign patent.

Under modified substantive examination, the application undergoes a simplified examination process. The application is checked for novelty, statutory subject-matter and compliance with the specification of the foreign patent relied on, but there is no examination for inventive step and the number of formal requirements checked is supposed to be less than under normal examination. In practice, however, it appears that applications are examined to essentially the same extent under both types of examination. Furthermore, modified examination can only be based on a single foreign patent.

DEFERMENT OF EXAMINATION

The filing of a request for normal substantive examination may be deferred on the ground that the supporting information and documents are not yet available.

It is also possible to request normal examination and defer the submission of supporting information on corresponding foreign applications. In practice, this will not necessarily delay the start of the examination.

The filing of a request for modified substantive examination may be deferred on the ground that the foreign patent on which the examination will be based has not yet been granted or the required certified copy of it is not yet available.

Deferment must be applied for within the regular term for requesting examination. Effective 16 August 2006, the maximum period of deferment is five years from the Malaysian filing date or international filing date.

An applicant that is unable to file a request for modified examination within the deferment period, for example because a relevant foreign patent has not been granted, is permitted to file a late request for normal examination. The time limit for such a request is three months from expiry of the modified examination deferment period.

EXPEDITED EXAMINATION

Since 15 February 2011, there are formal provisions for requesting expedition of examination of a patent application. There is no time limit for requesting expedition provided the application has already been laid open to public inspection and a request for examination has been submitted. Justification for the expedited examination is required in the form of a Statutory Declaration. A non-refundable official fee is payable.

The grounds on which expedited examination may be considered are:

- 1) national or public interest;
- 2) evidence of potential infringement or ongoing infringement proceedings;
- 3) registration is a condition to obtaining monetary grants from the Government or institutions recognized by the Registrar;
- 4) the invention has already been commercialized or the applicant intends to do so within two years of requesting expedition;
- 5) the invention relates to green technologies that will enhance the quality of the environment or conservation of energy sources; or
- 6) other reasonable grounds.

Upon approval of the request by MyIPO, the applicant must pay a further, substantial official fee for the expedited examination.

The applicant can expect an office action within four weeks of paying the expedition fee. A term of three weeks is given for response and no extension of time will be allowed. If no response is filed within this shortened timeframe, the application will revert from fast track to normal track.

PROSECUTION PROCEDURE

Malaysian patent applications are examined generally in filing date order. Filing a request for examination early will not necessarily result in earlier examination. In the case of normal substantive examination, applicants are usually encouraged or required by an examiner to amend their application for substantial conformity to any corresponding foreign patent granted in one of the above-mentioned countries. The term for response to an examination report is two months. For certain applications filed before 15 February 2011, the regular response term is three months. If no response is filed in time, or the response does not satisfy the examiner, the application may be refused.

VOLUNTARY AMENDMENT

A voluntary amendment of the specification may be filed at any time during the pendency of an application. No new matter can be added.

DIVISIONAL APPLICATIONS

If an objection of a lack of unity of invention is raised by an examiner during prosecution, the applicant may file a divisional application within a term of three months from the mailing date of the examination report containing that objection. A voluntary divisional application, on the other hand, may only be filed up to the end of a term of three months from the mailing date of the first examination report received.

EXTENSIONS OF TIME

The 12-month convention priority period, 30-month PCT national phase entry term, and (apart from deferment) the term for requesting examination are generally not extendible. Most other time limits can be extended at least once, upon payment of prescribed official fees. The latter include a fixed fee for each extension requested and a variable fee depending on the number of months of extension sought. The grant of any extension is at the Registrar's discretion.

GRANT PROCEDURE

Upon successful completion of the substantive examination, a clear examination report will be issued. The application will normally proceed to grant shortly after issuance of this clear report. For certain applications filed prior to 15 February 2011, an official fee is payable for obtaining the patent certificate.

DURATION AND RENEWAL

The duration of a Malaysian patent depends on its filing date. If the filing date is prior to 01 August 2001 and the application was pending or granted and in force as of that date, the duration is 15 years calculated from the date of grant or 20 years calculated from the filing date, whichever expires later. If the filing date is on or after 01 August 2001, the duration is 20 years calculated from the filing date in the case of a direct national application and from the international filing date in the case of a PCT national phase application.

An annual renewal fee must be paid in order to keep the patent in force. The base date for renewal fee deadlines is the date of grant for both 15- and 20-year term patents. There are no back renewal fees payable on grant. The first renewal fee for a patent is due one year from the date of grant. Each renewal fee may be paid up to six months late, subject to a surcharge of 100% of the regular official fee. There are currently no provisions for patent term extension.

An Appointment of Agent form is required when a renewal fee is first paid by a new agent. If not filed with the renewal payment, an official letter will be issued that requires the Appointment of Agent form to be filed before the renewal is processed. Since 15 February 2011, an official fee is payable upon filing the Appointment of Agent form.

REINSTATEMENT OF LAPSED PATENT

If a patent lapses unintentionally, the owner may apply for its reinstatement within two years of publication of a notice of the lapsing in the Government Gazette. The condition for reinstatement is that the non-payment of the annual fee was due to accident, mistake or other unforeseeable circumstances.

UTILITY INNOVATION CERTIFICATES

The Malaysian patent system includes provision for the grant of utility innovation certificates. A utility innovation is defined 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. There is no requirement for an inventive step.

The filing requirements and prosecution procedure are basically the same as for patents. A utility innovation certificate may only have one claim and its maximum term is 20 years from the filing date. However, renewal beyond 10 and 15 years from the filing date is dependent on completing an extension procedure that includes presenting evidence of commercial or industrial use in Malaysia, or a satisfactory explanation of non-use.

INFRINGEMENT

The exclusive rights of the patent owner are to exploit the patented invention; assign or transmit the patent; and conclude licence contracts.

Infringement occurs when unauthorized exploitation of the patented invention takes place. However, there is no contributory (or indirect) infringement of a Malaysian patent.

Infringement proceedings must be taken by the patent owner within five years of the act(s) of infringement (two years in the case of a utility innovation certificate).

For a patent granted in respect of a product, infringement consists of:

- i) making, importing, offering for sale, selling or using the product; and
- ii) stocking such product for the purpose of offering for sale, selling or using.

For a patent granted in respect of a process, infringement consists of using the process; and doing any of the acts set out under (i) and (ii) above in respect of a product obtained directly by means of the process.

The patent right extends only to acts done for industrial or commercial purposes. Among other exclusions, the patent rights 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.

INVALIDATION

An aggrieved person may seek invalidation of a granted Malaysian patent by way of application to the High Court, on any of the following grounds:

- a) the claimed invention is not patentable;
- b) the description or claims do not comply with the Patents Regulations;
- c) any drawings necessary for understanding the claimed invention were not furnished;
- d) the right to the patent does not belong to the person to whom the patent was granted; and
- e) incomplete or incorrect information (on corresponding foreign cases) has been deliberately provided or caused to be provided in connection with a request for normal substantive examination.

Any declaration of invalidity may be partial or full, and is effective back to the date of grant. The patent is therefore treated as never granted to the extent it is declared invalid.

Trade Mark

Trade mark protection in Malaysia is governed by the Trade Marks Act 1976 and the Trade Marks Regulations 1997.

The Trade Marks (Amendment) Regulations 2011 came into effect on 15 February 2011; affecting new applications filed on or after this date and trade marks already registered as at this same date.

Malaysia is a signatory to the Paris Convention and is also bound by the TRIPs Agreement.

REGISTRABLE TRADE MARKS

Section 3 of the Trade Marks Act 1976 gives a wide definition of the word “mark” to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

The same Section also gives a definition to “trade mark” as a mark that is used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right to the trade mark.

From the above, it can be seen that there is subtle distinction between the two definitions. A mark only becomes a trade mark if it is used (or proposed to be used) in a business or trade for goods or services, and the mark that is used must be for the purpose of indicating a connection between the goods and the proprietor of the mark.

What marks are registrable as trade marks? The answer is found in Section 10 of the Act which provides that the mark must satisfy at least one of the following essential particulars:

- the name of an individual, company or firm represented in a special or particular manner;
- the signature of the applicant for registration;
- an invented word(s);
- a word that does not have any direct reference to the character or quality of the goods or services and is not in its ordinary meaning a geographical name or surname; or
- any other distinctive mark.

FILING REQUIREMENTS

Minimum documentation requirements for filing a trade mark application in Malaysia are:

- a) one clear print for a black-and-white mark; 15 prints for a colour mark in PDF, TIFF or JPEG format;
- b) a list of goods or services. All terms used to specify the goods or services should closely follow the latest edition of Nice International Classification;
- c) the full name and address of the applicant, body description of company, country/state of incorporation;
- d) a Statutory Declaration from the applicant affirming that they are the bona fide proprietors of the mark and that the application is made in good faith. The declaration has to be signed before a Commissioner for Oaths (for local declarant) or before a Notary Public (if signed abroad);
- e) for marks that contain non-English words, a certified transliteration and translation will be required; and
- f) if convention priority is claimed, a certified copy of the priority application is required with a certified English translation where documents are not in English.

EXAMINATION OF MARKS

Once a trade mark application is filed, it will be searched and examined to determine whether the mark satisfies the requirements of registration as provided in the Trade Marks Act 1976. Under normal circumstances, this process is usually completed within 12 - 18 months from the date of filing.

During examination, if there are no objections issued by the Examining Officer, the mark will be allowed to proceed to the next stage called the advertisement stage. The mark would then be registered subject to any opposition following its publication in the Government Gazette.

On the other hand, if the mark does not satisfy one of the 5 essential particulars enumerated above (refer Page 24) or if the Examining Officer finds there is a conflict with a prior registration or application, an initial objection letter will be issued to the applicant setting out the grounds of objection. The applicant is then invited to respond to the objection letter within two months from the date of the objection letter. It is possible to request for an extension of time within which to reply upon the payment of extension fees, but the grant of extension is subject to the Registrar's discretion.

In addition to the above, other grounds of refusal include:

- a) that the use of the mark or part of the mark is likely to deceive or cause confusion to the public or would be contrary to law;
- b) the mark contains or comprises any scandalous or offensive matter;
- c) that the mark is identical with or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;
- d) that the mark contains or consists of a geographical indication with respect to goods not originating in the territory indicated;

- e) that the mark is for wine or spirits and contains or consists of a geographical indication identifying wines or spirits not originating in the place indicated by the geographical indication in question.

Other types of objections are minimal in nature, such as requesting for amendments to limit the specification of goods, request for clarification of certain aspects of the marks applied for or a request for a translation of the mark if it was filed in a language other than the National or English languages.

In replying to any objections raised by the Examining Officer, the normal practice would be for the applicant or the applicant's agent to file a considered reply in writing, more commonly known as "submissions". If the mark is considered to be not distinctive, the applicant may adduce evidence of use of the mark by way of filing a Statutory Declaration showing that the mark has become distinctive through use. In other circumstances, evidence of registration in jurisdictions similar to Malaysia such as the United Kingdom, Singapore and/or Australia would be helpful, but is not legally binding on the Registrar.

With regard to conflicting marks, the applicant must show that the mark applied for may be distinguished from earlier registrations or prior applications such that there is no or little likelihood of confusion and/or deception between the two marks arising from the public.

One of two things may happen when a submission is received from the applicant or his agent. The mark will either be allowed to the advertisement stage or the objections will be maintained. If the latter happens, the applicant may request for a Hearing

before the Registrar. If the objections are still maintained after the Hearing is conducted, the applicant has a right of an appeal to the High Court.

EXPEDITED EXAMINATION

In addition to the normal track examination highlighted above, with the new Trade Marks (Amendment) Regulations 2011 effective 15 February 2011, there are formal provisions for requesting expedition of normal examination provided the request is filed within four (4) months from the initial trade mark application date. This must be in the form of a reasoned request for expedition and an official fee is payable. The grounds on which expedited examination may be considered are:

- a) national or public interest;
- b) evidence of potential infringement or ongoing infringement proceedings;
- c) registration is a condition to obtaining monetary benefits from the Government or institutions recognized by the Registrar; or
- d) other reasonable grounds.

Upon approval of the request by MyIPO, another substantial official fee is immediately payable to commence expedited examination.

It should be noted that what is expedited is the timeframe within which the mark gets examined, because the application is still subject to the normal and remaining stages leading up to registration.

CERTIFICATION TRADE MARKS

A certification trade mark is a special trade mark different from other trade marks, in that the registered proprietor must not trade in the goods himself. As a matter of fact, certification marks are filed for by organizations, associations, guilds and other institutions who have definite rules and standards governing the use of such marks. Certification relates to source, origin, material used, mode of manufacture, quality and similar traits.

Certification trade marks must basically be capable of distinguishing the goods or services so certified from non-certified goods or services. An application for a certification mark requires a set of the rules governing use of the mark.

RENEWAL

A trade mark application once registered is valid for 10 years from the date of application. It may be renewed every ten years thereafter with payment of a renewal fee. Where the renewal date lapses, an application for late renewal may be filed for with payment of an additional fee. The registration will accordingly be renewed without removing the mark from the Register.

If no timely renewal application is made by the expiration date, the trade mark is gazetted and thereafter will be removed from the Register for non-payment of the renewal fee. Once removed, restoration may be allowed at the discretion of the Registrar subject to a restoration fee as well as a penalty fee within one year from the date of expiration.

RECTIFICATION OF THE REGISTER

Rectification of an entry in the Register may be sought by the registered proprietor or by an aggrieved person. An application for rectification may be made in respect of:

- 1) a non-insertion in or omission from the Register of any entry;
- 2) an entry made in the Register without sufficient cause;
- 3) any entry wrongfully remaining on the Register; for instance a mark the use of which is likely to deceive or cause confusion to the public or would be contrary to law; or one which contains offensive or scandalous matter;
- 4) any error or defect in any entry in the Register.

A registered trade mark may also be removed from the Register upon application by an aggrieved person on the ground that the mark was registered without any genuine intention to use the said mark and there has been no such use; or there has been no bona fide use of the mark in Malaysia for at least three years prior to one month before the date of application to remove it. Rectification proceedings can only be instituted in the High Court.

REGISTERED USER

A registered proprietor who allows any person to use his trade mark, by lawful contract on all or any of the goods or services the mark is registered for, must apply for that person to be entered on the Register as a registered user whether with or without any conditions or restrictions. However, it is a condition of registration that the proprietor shall retain and exercise control over the use of the trade mark and over the quality of the goods or services provided by the registered user in connection with that trade mark.

The permitted use of a registered trade mark by a registered user shall be deemed to be use by the registered proprietor, even if he never uses the mark himself. And thus it insulates the said proprietor from any action of cancellation of the mark from the Register on the ground of his non-use.

The registration of a person as registered user may be:

- 1) varied by the Registrar on the application in the prescribed manner of the registered proprietor with respect to the goods or services for which or with respect to any conditions or restrictions subject to which the registration has effect;
- 2) extended by the Registrar on the application in writing of the registered proprietor for such period as the Registrar thinks fit; or
- 3) cancelled by the Registrar on the application of the registered proprietor.

The Registrar may at any time cancel the registration of a person as registered user of a trade mark for any goods or services in respect of which the mark is no longer registered.

At the expiration of the trade mark registration, a fresh registered user application must accompany the application for renewal of that trade mark registration if the registered user is to continue using the mark thereafter.

INFRINGEMENT OF REGISTERED MARKS

Upon registration of the trade mark, the registered proprietor is granted the exclusive rights to use the trade mark in relation to the registered goods or services. The Malaysian Trade Marks Act 1976 provides for two types of infringement, which are:

- the unauthorized use of a mark which is identical and/or highly similar to the registered mark in respect of the same goods or services such that it will likely deceive and/or confuse the public; and
- the unauthorized use of the mark which is identical and/or highly similar to the registered mark such that it imports a reference to the registered proprietor.

From the above, it can be seen that the registered proprietor may institute a civil legal action against any party that is infringing their trade mark.

As far as unregistered trade mark rights are concerned, the law allows a cause of action under the tort of passing-off if there is a party that is misappropriating the unregistered mark. The burden of proof for a trade mark infringement action is easier to discharge than the burden for a passing-off action.

For trade mark infringement, the necessary ingredients would be for the registered proprietor to show the following:

- a) the trade mark is registered;
- b) the infringing trade mark, whether identical or confusingly similar, has been used by the offender as a trade mark;
- c) that the offender's use of the trade mark is in respect of the registered goods or services.

As for passing-off, the burden of proof is higher. It involves showing substantial evidence of use of the trade mark in order to prove reputation and goodwill of the business in connection with the trade mark used, misrepresentation and likelihood of damage.

The usual reliefs prayed in an infringement action are:

- a) an injunction restraining further infringement of the registered mark;
- b) an order for delivery up of products bearing the offending mark for destruction;
- c) damages in respect of past infringement, or at the Plaintiff's option, an account of profits; or
- d) a Declaration that the Defendant has infringed.

It is to be noted that under Section 70B of the Trade Marks Act 1976, a proprietor of a well-known trade mark is entitled to protection and to restrain by injunction, the use in Malaysia in the course of trade and without the proprietor's consent, of a mark which is identical or where an essential part of it is identical or nearly resembles the well-known mark in respect of the same goods or services, where the use is likely to deceive or cause confusion. Further, a well-known trade mark will be protected whether or not its proprietor carries on business or has any goodwill in Malaysia. Note however, that any bona fide use of a trade mark that is identical to or incorporating a well-known mark before the commencement of this section, which is 01 August 2001, will not be affected by this provision.

Industrial Design

Industrial design protection in Malaysia is governed by the Industrial Designs Act 1996 which entered into force on 01 September 1999. Prior to this date, industrial designs were protected in Malaysia by registering the design in the United Kingdom. This system was repealed when the Malaysian Industrial Designs Act came into force.

It is however possible to maintain the protection of any UK registered design granted and in force prior to 01 September 1999, in Malaysia, through renewal of the UK design in Malaysia.

Malaysia is a member of the Paris Convention and the World Trade Organization.

REGISTRABLE INDUSTRIAL DESIGNS

An industrial design is defined as features of shape, configuration, pattern or ornament applied to an article by any industrial process or means; with said features appealing to and being judged by the eye in the finished article. An article means any article of manufacture or handicraft and includes any part of such article or handicraft that is made and sold separately.

Some designs are considered not registrable under Malaysian industrial design law and these include:

- a method or principle of construction;
- features of shape or configuration of an article which are dictated solely by function;
- features of shape or configuration of an article which are dependent on the appearance of another article of which the article is intended by the author of the design to form an integral part;
- an integrated circuit or part of an integrated circuit (protected under the Layout-Designs of Integrated Circuits Act 2000); and
- designs that are contrary to public order and morality.

It is important to note that the protection registered is for the external visual appearance of the article to which the design has been applied.

It is only possible to protect a single visual external appearance of the article. It is therefore not permissible to use patent type claims or patent type descriptions of the article in an attempt to claim more than one visual appearance of the article.

The protection is for the whole of the article, which embodies the design. It is not possible to register a design for part of an article unless that part is normally made and sold separately.

NOVELTY REQUIREMENTS

Malaysian industrial design law has a local novelty standard, in that the design must not have been disclosed to the public anywhere in Malaysia before the priority date or the date of application for registration in Malaysia, in respect of the same article or any other article. Disclosure of a design identical or similar (differing only in immaterial details or features commonly used in the relevant trade) to the applied for design in a domestic application having an earlier priority date and that has proceeded to grant, is also novelty defeating.

Internet publication of a design may constitute disclosure in Malaysia and thus, could possibly jeopardize the validity of a Malaysian registered design. However, the effect of internet publication on local novelty has yet to be determined by the Court.

Public disclosure of the design in Malaysia six months prior to the filing date of an industrial design application is not prejudicial to the novelty of the design, provided the disclosure was made:

- in an official or officially recognized exhibition; or
- by a person other than the applicant or his predecessor in title as a result of an unlawful act committed by that other person.

The degree of newness required to satisfy the requirements of the registered design legislation is not particularly high. When comparing an alleged new design with an earlier design, the alleged new design is not new if it differs from the earlier published design only in “immaterial details”, or in “features commonly used in the relevant trade”.

STATEMENT OF NOVELTY

The applicant is required to include a “statement of novelty” in the registered design application. As the monopoly protection is for the visual appearance of the entire article, the usual statement of novelty is in the form “the novelty resides in the features of shape and configuration of the article as shown in the representations” or, “the novelty resides in the features of pattern and ornament of the article as shown in the representations”.

If the applicant wishes to draw attention to a particular feature of novelty, then the statement of novelty may, for example, be in the form “the novelty resides in the shape or configuration of the article as shown in solid line in the representations”. It is not advisable to use patent type claims or patent type descriptions as a statement of novelty, as this may be construed to be a claim for a method or principle of construction or a plurality of different designs.

As mentioned above, Malaysian industrial design law does not provide for partial design registration and as such, registrations should generally be in respect of the whole article. If novelty resides in part of an article, then this may be reflected in the Statement of Novelty. It is anticipated that in an infringement action, emphasis would be given to the aspects of the design for which the applicant has claimed novelty.

MULTIPLE APPLICATION

A multiple industrial design application is possible in Malaysia provided the designs belong to the same class of the International Design Classification (Locarno Classification). The different designs may have different authors and priority claims but the applicant cannot differ. By filing a multiple design application, there is a reduction of the official filing and renewal fees by 50% for designs other than the first design. Each design is protected separately.

As of 01 January 2007, the Malaysian Industrial Design Registry has implemented a new numbering system for Malaysian design applications filed on and after that date.

The new numbering system consists of a prefix portion (two-digit year indicator – five-digit sequential number) followed by a four-digit suffix portion that differentiates between a single design and a multiple design application and at the same time shows the individual design number and total number of designs filed for each application.

Particularly, for multiple design applications, separate registration numbers will now be allocated for each design in a multiple design application. As previously, an individual certificate is issued for each design of a multiple registration.

SET OF ARTICLES

It is also possible to file a single industrial design application for a “set of articles” in Malaysia.

A “set of articles” means a number of articles that are of the same general character and are ordinarily on sale together or intended to be used together. The same industrial design must be applied to each article in the “set of articles”.

An example of a “set of articles” for the purposes of a Malaysian design application is a cutlery set comprising forks, spoons, knives etc. bearing the same flower pattern thereon. Each article of a set is protected separately; in other words an act of infringement does not require the complete set to be copied.

FILING REQUIREMENTS

The minimum filing requirements for obtaining a filing date of an industrial design application in Malaysia are:

- a) full name, address and state of incorporation/nationality of the applicant;
- b) Appointment of Agent Form (ID Form 10) signed by the applicant (no notarization or legalization of the Form is required);
- c) six sets of representations of the design (drawings or photographs; each representation not exceeding 12.5cm by 9cm);
- d) name of article and statement of novelty; and
- e) details of any priority claim i.e. at least the country and filing date.

With regards to item (b) above, if the Appointment of Agent form is not available for filing with the application, current practice requires that an extension of time be requested. Alternatively, a certified copy of the signed form can be submitted initially, provided the original follows later.

With regards to item (c) above, note that drawings are generally preferable, as photographic representations often invoke formality objection.

Additional formal requirements that can be filed after the filing date of the application are:

- f) full name and address of the author;
- g) information on how the applicant has derived the right to the design from the author (normally by way of assignment, employment or other agreement);
- h) International Design Classification;
- i) serial number of the priority application;
- j) copy and certified English translation (if necessary) of the priority document; and
- k) copy of Assignment document (if applicant differs from that of priority application).

However, additional costs will be incurred in filing any of items (f), (h) or (i) late, due to the need to amend the application form.

APPLICATION PROCEDURE

The documentation requirements are listed above. There is an official filing fee payable for each design application as well as official publication fees that depend on the number of representations. The application is first assigned a design application number (or series of numbers for a multiple design application) and a filing date by the Malaysian Industrial Design Registry. The application documents and representations are then checked for compliance with the formal requirements.

There is no search or substantive examination of the application. However, in practice, objections of a substantive nature (for example, as to whether there is a design within the legal definition) are raised from time to time.

Due to the above-mentioned new numbering system for multiple design applications, a separate request to amend an application now needs to be filed for each design in a multiple design application. The official fee for amendment must also be paid individually for each design being amended.

Once the application is in order, a registration certificate is normally issued between seven months to one year of filing the application. The application is then published in the Government Gazette. There are no provisions for opposition proceedings.

DURATION AND RENEWAL

The initial term of registration for a Malaysian design is 5 years from the filing date of the application for registration. In practice, the Industrial Design Registry uses the priority date as the base date for the calculation of the registration term and date of renewal payments. The application can be renewed for two further five year periods, giving a maximum term of 15 years.

The renewal fee may be paid up to 6 months prior to the expiry date of the current period of registration. It is also possible to make a late payment, not more than 6 months after the expiry date, subject to a late payment penalty fee.

RESTORATION

If an industrial design registration lapses unintentionally, the owner may apply for its restoration within one year of publication of a notice of the lapsing in the Government Gazette. The condition for restoration is that the failure to renew the registration was due to an accident or mistake. There are provisions for an interested party to oppose the proposed restoration.

UNITED KINGDOM REGISTERED DESIGNS

Any UK registered design granted and in force prior to 01 September 1999 can also continue to be protected in Malaysia subject to the filing of applications for renewal in Malaysia with renewal payments due at 5-year periods from the priority date of the UK registration.

In June 2006, the Malaysian Industrial Design Registry announced that UK registered designs granted before 01 September 1999 will be allowed to be renewed in Malaysia, for the full 25-year term.

INFRINGEMENT

Under Malaysian industrial design law, without the licence or consent of the design owner, it is an infringement to:

- apply the registered industrial design or any fraudulent or obvious imitation of it to any article in respect of which the design is registered;
- import into Malaysia any article to which the industrial design or any fraudulent or obvious imitation of it has been applied, for sale or for use for the purposes of trade or business; or
- sell, or offer or stock for sale, or hire, or offer or stock for hire, any article to which the industrial design or any fraudulent or obvious imitation of it has been applied.

Infringement proceedings must be taken by the owner of the design within five years of the act(s) of infringement.

REVOCACTION

Any person may apply to the High Court for the revocation of the registration of an industrial design.

The grounds for revocation of a registered design are as follows:

- the design is not new/novel; or
- registration of the design was procured by unlawful means.

There are also provisions for any aggrieved person to seek rectification of the Register.

Apart from Malaysia, Brunei and Singapore, Patent and Trade Mark filing is also available in collaboration with Associates of Henry Goh & Co Sdn Bhd in the following countries:

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