



A Guide to the

MALAYSIAN IP SYSTEM

**Henry
Goh&Co**

PATENT, TRADEMARK & DESIGN AGENTS

MALAYSIA

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**MALAYSIAN
IP SYSTEM**

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MALAYSIA

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Introduction

Malaysia's intellectual property laws have been declared to follow the requirements of the WTO's TRIPs Agreement. Among other international agreements, Malaysia is a member of the Paris Convention, the Berne Convention, the Patent Cooperation Treaty and the Madrid Protocol. Malaysia is also expected to join the Budapest Treaty and the Hague Agreement in due course.

The administration of patents, trademarks, geographical indications, industrial designs, integrated circuit layout-designs and copyright is carried out by the Malaysian Intellectual Property Corporation, better known simply as MyIPO. MyIPO is a corporate body under the Ministry of Domestic Trade and Consumer Affairs. It is fully autonomous in its administration and finance. On the other hand, the administration of plant variety protection falls under the Crop Quality Control Division of the Ministry of Agriculture.

Malaysia's modern and comprehensive set of IP laws and their administrative offices are backed up by an established Government policy to promote the awareness, registration and enforcement of intellectual property rights among the Malaysian business and trading community. There are also a number of local organizations of IP professionals that actively engage with IP owners and MyIPO to bring about positive changes. Continuing efforts on all sides in developing the Malaysian IP system are encouraging 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 The earlier system of re-registering United Kingdom patents has been repealed.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 microorganisms, 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/IB/306 – notification of the recording of a change (if any); and
- f) Form PCT/IB/308 (Second Notice) – communication of application to designated offices which apply 30-month time limit.

It is not necessary to submit item b) to MyIPO, if an English language specification that meets local formality requirements has been made publicly available by WIPO.

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 requires 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.

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 as well as formal requirements. There is no examination for inventive step and unity of invention. 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.

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 applications whose examination request was 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. When the examiner recommends that an application be refused, the applicant may request a hearing.

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.

MICROORGANISM DEPOSIT

Malaysia has yet to accede to the Budapest Treaty. Thus, there is presently no provision in the Malaysian Patents Act for the recognition of microorganism/biological sample deposits made at International Depository Authorities under the Budapest Treaty. In order to fulfill the necessary disclosure requirement, the applicant will be required to execute a Statutory Declaration confirming that they will provide any person requesting a sample

of the microorganism/biological material disclosed in the patent application, with a declaration, addressed to the depositing authority, authorizing the depositing authority to furnish a sample of the relevant microorganism/biological material to the person. This Statutory Declaration is not a filing requirement. It can be submitted during prosecution, either voluntarily or upon the request of an examiner during substantive examination.

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 the term for requesting examination or deferment are generally not extendible. Most other time limits can be extended, 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. Under current MyIPO practice, the term for responding to a substantive examination – adverse report may only be extended once and for not more than six months beyond the regular response deadline. The grant of any extension is at the Registrar's discretion.

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.

PATENT PROSECUTION HIGHWAY [PPH] PROGRAMS

PPH Pilot Programs (JPO, EPO, CNIPA)

The PPH is an available option to expedite prosecution of Malaysian patent applications. As of 01 July 2018, the Intellectual Property Corporation of Malaysia (MyIPO) has PPH agreements with three foreign patent offices, namely, the Japan Patent Office (JPO), the European Patent Office (EPO) and the China National Intellectual Property Authority (CNIPA).

Under the PPH, a patent applicant may request accelerated examination by MyIPO based on favourable examination results of a corresponding JP, EP, CN or PCT application (reference application) by the JPO, EPO or CNIPA (first Patent Office).

In order to qualify for processing under the PPH, the following conditions must be met:

- The Malaysian application and the reference application must correspond (priority relationship or common PCT application).
- One or more claims of the reference application have been indicated as allowable by the first Patent Office, either in a JP, EP or CN application or in the first Patent Office's capacity as a Search or Examination Authority under the PCT.
- The claims presented in the Malaysian application for examination sufficiently correspond to such allowed claims.
- Normal examination has been requested (previously or with PPH request).
- If the examination request was filed previously, examination has not yet started.

The following needs to be provided for submission when requesting PPH:

- All relevant office actions issued or, where applicable, the latest office action containing the allowable claims, or the Written Opinion or IPRP issued for a PCT-based request.
- The claims deemed allowable by the first Patent Office.
- Any non-patent prior art references cited by the first Patent Office.
- English translations of the above documents, where applicable.
- Documents and their translations do not need to be submitted if available via the Advanced Industrial Property Network (AIPN), Dossier Access System (DAS) or WIPO's Patentscope database. In that case, the applicant need only provide a list of documents to be retrieved.
- Machine translations are admissible. MyIPO may request an accurate translation if the machine translation is insufficient.
- If the reference application has not been published, the documents must be submitted with the PPH request.

After the PPH request is filed, MyIPO will review the request and issue a decision (to accept or reject) on the request within two weeks.

If accepted, the Malaysian application will be allocated to an Examiner for examination. Any office action will be issued within three months. The applicant must respond within two months.

Provided the application as filed with the PPH request, or as amended in response to the office action, meets all requirements, the application will proceed to grant. A final decision on grant should be obtainable within six months of submitting the PPH request.

The PPH program is bi-directional in nature so that examination at the JPO, EPO or CNIPA can also be accelerated based on favourable examination by MyIPO of a corresponding Malaysian application.

ASPEC Program

The ASEAN Patent Examination Cooperation (ASPEC) program is a regional patent cooperation project between the IP offices of the ASEAN member states of Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand, and Viet Nam.

The purpose of this program is to share search and examination results between the participating offices to allow applicants in participating countries to obtain corresponding patents faster and more efficiently. The program potentially reduces duplication of the search and examination work done, thereby saving time and effort as well as improving patent quality.

Under the ASPEC program, any of the participating offices may consider the search and examination reports of a corresponding application from another participating office that it receives from the applicant with a request for processing under ASPEC. The prosecution and administrative processes will then be advanced out of turn until grant.

The essential requirements for requesting processing under the ASPEC program are as follow:

- The two applications must correspond in terms of a priority relationship between the applications or a common PCT application.
- A copy of the search report and examination report of the application filed with the other participating office must be submitted, together the claims covered by those reports.
- At least one of those claims must have been determined as allowable.
- All documents should be filed in English, or otherwise accompanied by verified English translations.
- No official fee is payable.

Although the ASPEC program has not been used that extensively, it is potentially of benefit to applicants that have filed corresponding applications in multiple ASEAN countries, and the claims have been accepted as patentable in one of those countries.

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 applications whose examination request was filed before 15 February 2011, an official fee is payable for obtaining the patent certificate.

Effective 01 June 2016, if an application proceeds directly to allowance without the issuance of any examination report, the following shall apply. The applicant is allowed a term of two months for the filing of any voluntary amendment and a term of three months for the filing of any voluntary divisional application. These terms run from the mailing date of the clear report and are not extendible. The grant of the patent will be held in abeyance pending their expiry, unless the applicant specifically informs MyIPO to proceed immediately with grant.

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.

POST-GRANT AMENDMENT

Post-grant amendments are permissible for the purpose of correcting a clerical error or an obvious mistake or for any other reason acceptable to the Registrar. The acceptance of any such amendment is at the Registrar's discretion.

The patent must not be the subject of Court proceedings at the time of amendment. The amendment also may not broaden the scope of protection conferred at the time of grant nor go beyond the disclosure of the original patent specification.

Upon filing, the amendment will be forwarded to a senior patent examiner for consideration. Although there is no substantive re-examination, if any objections are raised by the examiner the applicant will be given an opportunity to respond.

If approved, the amendment will be made available for public inspection by MyIPO. A notice that the patent has been amended post-grant will also be inserted into the Patent Register.

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.

Trademark

Trademark in Malaysia is governed by the Trademarks Act 2019 (TMA 2019) and Trademarks Regulations 2019; which came into effect on 27 December 2019 and repealed the Trade Marks Act 1976 and Trade Marks Regulations 1997.

The country is also a member of various trademark-related treaties, including:

- Protocol Relating to the Madrid Agreement concerning the International Registration of Marks - since 27 December 2019
- Nice Agreement concerning the International Classification of Goods and Services - since 28 September 2007
- Paris Convention for the Protection of Industrial Property - since 01 January 1989
- World Trade Organization (WTO) – Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS) since 01 January 1995.

REGISTRABLE TRADEMARKS

TMA 2019 provides that any person who claims to be the bona fide proprietor of a trademark may apply for the registration of the trademark if:

- the person is using or intends to use the trademark in the course of trade; or
- the person has authorised or intends to authorise another person to use the trademark in the course of trade.

The Act has expanded the types of trademark recognized for registration to be more than just word, logo, numbers, name, signature, letter, etc. and to include shape of goods or their packaging, colour, sound, scent, hologram, positioning marks and sequence of motion or any combination thereof; provided that they must be signs capable of being represented graphically.

In addition to certification marks, collective marks are protected and they are defined under the Act as “a sign distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.”

FILING REQUIREMENTS

Minimum documentation requirements for filing a trademark application are:

- one clear specimen of the trademark in JPEG format. For non-traditional trademark, one clear representation in a relevant graphically represented format or material.
- A list of goods or services for which protection is sought (according to the latest Nice International Classification), in Word format.
- Full name and street address of applicant (and State of Incorporation, where applicable).
- Priority application number, date and country of filing (if applicable).
- If the trademark contains non-Roman character(s) or non-English word(s), to indicate the language and provide its simple English translation and transliteration. Translation document is not required.

No supporting document like power of attorney or statutory declaration is required from the applicant. However, the application form has a section for Declaration where the agent has to satisfy himself to the truth that Applicant is the bona fide proprietor of the trademark whose registration is applied for, that the application is made in good faith and that he is / they are entitled to be registered as the proprietor of the trademark. The instructing client must confirm that these are all true so that the authorised agent may proceed to sign for, and file, the application.

To reduce cost, paperwork and formality examination time, multiple classes may be designated within a single application, replacing the need to file one application per mark, per class. There is also corresponding allowance for division and merger of applications so that trademark owners can better manage their portfolio.

Series of trademarks i.e. a single application consisting of not more than six representations of mark, resembling each other in material particulars, may be filed.

The application date of a trademark in Malaysia shall be its filing date, regardless of the priority claimed from a Paris Convention application. Any such priority date is limited in purpose for determining the precedence of rights during examination.

EXAMINATION

Expedited examination is kept possible under TMA 2019 but it is not available for certification and collective marks, and most non-traditional marks like colour, sound, scent, hologram, positioning and sequence of motion. The number of grounds justifying expedited examination have been reduced to (i) national or public interest, (ii) there are on-going infringement proceedings or evidence of potential infringement and (iii) registration is a condition to obtain monetary benefits from the government or institutions recognized by the Registrar.

The Registrar shall carry out examination of a trademark application, including a search of earlier or well-known trademarks (relative grounds of Section 24) and to the extent he considers necessary.

Under the absolute grounds in Section 23 of TMA 2019, marks that shall be refused by the Registrar include the following:

- trademarks devoid of any distinctive character
- trademarks consisting exclusively of signs which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin, other characteristics of goods or services
- signs consisting exclusively of a shape resulting from the nature of the goods themselves, necessary to obtain a technical result or shape giving substantial value to the goods
- trademarks that are of such a nature as to deceive or mislead the public as to the nature, quality or geographical origin of the goods or services

In the pursuit of expediency, an applicant will now only be allowed one strike when the Registrar raises a provisional refusal of the application. The applicant has the opportunity to make representations, amend the application or furnish evidence or information within such period as specified in the written notice from the Registrar. If the Registrar maintains the refusal following the applicant's one-off submissions, he will issue a total provisional refusal where the applicant is forced to appeal to the High Court if he is to avail himself of another round of argument.

OPPOSITION

The TMA 2019 and its accompanying Regulations provide for a robust opposition proceeding, involving back-and-forth exchange of information and documents between the parties and for the Registrar.

- It begins with the opponent filing its grounds and notice of opposition within two months of the publication of a trademark.
- The applicant must file a counter statement within two months of receiving the notice.
- Within two months of the receipt of the statement, the opponent must file their evidence by way of statutory declaration in support of the opposition.
- Two months thereafter, it will be the applicant's turn to file their statutory declaration in reply and to support the opposed mark.
- The opponent then has a choice of filing a further evidence-in-reply, strictly in reply to the applicant's declaration. Thereafter, no further evidence may be filed by either side, except by leave of the Registrar.
- Upon completion of evidence, the Registrar will request both parties to file written submissions. The Registrar is entitled to make an order to either refuse to register the trademark; or to register the trademark subject to such conditions or amendments he may think fit. The decision of the Registrar is subject to appeal to the High Court.

In each stage of the opposition proceedings, there is strict control by the Registrar over how long the applicable deadline can be extended to minimise any delay or abuse of proceedings. To avoid miscommunication, there is also a statutory requirement for a party to file an affidavit of service to the Registrar within fourteen days of serving a copy of the relevant documents to the other party.

TMA 2019 even allows for continuation of the opposition by a successor-in-title to the trademark in proceedings originally commenced by its predecessor. The Registrar can defer any opposition proceedings upon request by the opposition parties, provided it falls under prescribed circumstances.

REGISTRATION

Upon successful registration, only a sealed notification will be issued by the Registrar. If the registered proprietor would like a certificate of registration, a request with prescribed fee would have to be submitted. The presumption (with exceptions) that a registration is valid and conclusive will kick in sooner now, at five years after registration. Renewal of a multiple class registration can be selective but the class(es) that will not be renewed must be removed by way of filing a division.

RIGHT TRANSFERS

A registered trademark is accorded due legal recognition under TMA 2019 as a personal or movable property and thus may be the subject of a security interest in the same manner as any other such property. Together with other registrable transactions such as assignment of a trademark, security interest, placing a charge or a court order for transfer of ownership, it must be noted that these transactions are not enforceable against another conflicting interest unless these transactions have been recorded with MyIPO. The only statutory exception would be for trademark licences, where its registration will remain non-mandatory as per the current position. However, should it be recorded with MyIPO, the public shall be deemed to have notice of the licence.

Licences would be effective so long as they are put down in writing and signed by the licensor. Exclusive licence and sub-licensing are expressly recognized; with new rights of an exclusive licence being introduced as distinct from those of non-exclusive licensees. Even losses suffered by a licensee shall be taken into account by the court in infringement proceedings.

REMOVAL FROM THE REGISTER

Besides voluntary cancellation by the proprietor himself, registered proprietors should be aware that their registrations could be challenged in various manners under TMA 2019. A registered trademark could be revoked by the Registrar within twelve months from the date of its registration, on the basis that it was a wrongful grant. More importantly, the registration could be revoked by the court (on application by an aggrieved person), under different prescribed circumstances including three years of non-use from the date of issuance of the notification of registration, or suspended use for a continuous three years without proper reasons.

A registered trademark can also be invalidated by the court (on application by an aggrieved person) based on absolute or relative grounds under the Act, fraud or misrepresentation in the procurement of the registration.

ENFORCEMENT

In general, both registered and unregistered trademarks are protected here. Most enforcement of trademark rights are litigated in the IP-specialised High Court in Kuala Lumpur. Unregistered trademarks are protected under common law rights, especially in the tort of passing off. In fact even during the examination of a trademark, the Registrar shall refuse, under relative grounds of Section 24(4), to register it if the mark's use in Malaysia is prevented by virtue of any rule of law protecting an unregistered trademark or other sign used in the course of trade including under the law of passing off.

Section 159 of TMA 2019 specifically provides that nothing in the Act shall be deemed to affect the right of action against any person for passing off goods or services as those of another person or the remedies in respect of the goods or services. The same section however provides that no person shall be entitled to initiate any action to prevent or to recover damages for the infringement of an unregistered trademark. In other words, trademark infringement action is reserved for those marks that have attained registration.

The scope of trademark infringement and its exemptions has been substantially expanded by the new statute. There could now be infringement even in the use of a similar mark on similar (as opposed to being identical) goods or services to those registered by the plaintiff. Liability will stick to secondary users who know or have reasons to believe that such use is without authorization of the trademark proprietor.

It is an actionable offence under TMA 2019 to threaten infringement without basis, although a mere notification that a trademark is registered does not constitute a threat. An aggrieved person may seek a declaration from the court that the threats are unjustified, damages for loss suffered from the threat and injunct against any continuation of such threat. This will curtail any errant intimidation from persons who have no business enforcing trademark rights.

Many of the criminal offences, penalties and enforcement provisions in relation to counterfeit trademarks under the Trade Descriptions Act 2011 have been ported over to the TMA 2019. Most notably, after the amendment of both these statutes, there is no longer any need to obtain a Trade Description Order (TDO) to act against a counterfeit trademark that is not identical to the registered mark. Instead, the Registrar's verification whether there are confusing similarities shall be prima facie evidence in such legal proceedings.

Geographical Indication

A geographical indication (GI) is an indication to identify any goods as originating from a particular country, territory, region or locality, and where there is a given quality, reputation or characteristics to those goods that is attributable to that geographical origin. A GI is commonly used on not only natural or agricultural products, but also including products of industry and handicrafts.

GI protection in Malaysia is governed by the Geographical Indications Act 2000 (hereafter “the Act”) and the Geographical Indications Regulations 2001, as amended.

QUALIFICATION

Section 4 of the Act provides that certain GIs may not qualify for protection in Malaysia. They include GIs that are contrary to public order or morality; GIs that have ceased to be protected in the country or territory of origin; and those that have fallen into disuse in the country or territory of origin.

Registration of a GI in Malaysia is prima facie evidence that the GI meets the legal definition and is valid. Nonetheless, the Act also provides protection regardless of whether a GI is registered under the Act.

APPLICATION PROCESS

The rightful applicant of a GI is either a producer of the goods, a competent authority or a trade organization or association. If the applicant resides or has its principal place of business outside Malaysia, a Malaysia-based agent should be appointed as address for service. A system of registration of local agents was introduced in July 2013.

The information required as part of the application process includes identification and capacity of the applicant, the GI and the goods to which it applies, a Statutory Declaration affirming the applicant as bona fide, a summary of the characteristics and quality of the goods, a map of the geographical area and any other supporting documents.

OPPOSITION

Similar to trademarks, there is a two-month statutory period from the date of advertisement for any interested person to oppose the registration of a GI if there are valid reasons to do so. Possible grounds of opposition include those exemptions highlighted above under Section 4 of the Act.

REGISTRATION

A GI registration is valid and enforceable for 10 years from the application date. It can be renewed indefinitely but the Registrar may require additional particulars to be furnished in order to be satisfied that the GI has not fallen into disuse or ceased to be protected in the country or territory of origin.

Once a GI is registered, only producers carrying on stipulated activities in the geographical area specified in the Register shall have the right to use the registered GI in accordance with the quality, reputation and characteristics specified in the Register.

PROCEEDINGS FOR UNLAWFUL USE

Any interested person may institute proceedings in the Court to seek injunction, damages or other legal remedy against unlawful use of a GI. This includes use that misleads the public as to the geographical origin of the goods or use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention.

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, such 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 things 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 external visual 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

Effective 01 July 2013, Malaysian industrial design law has a worldwide novelty standard, in that the design must not have been disclosed to the public anywhere (whether in Malaysia or elsewhere) 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 registration, is also novelty defeating.

Public disclosure of the design 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”.

Industrial design registrations with filing date prior to 01 July 2013 are subject to a local novelty standard, in that the design must not have been prior disclosed to the public anywhere in Malaysia.

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, each design is protected separately.

As of 01 January 2007, MyIPO 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. In addition, each design in a multiple application is treated as a separate application during the course of prosecution, and upon registration will be treated as a separate registration with an individual certificate issued.

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 filing requirements 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) full name and address of the author;
- d) information on how the applicant has derived the right to the design from the author (normally by way of assignment, employment or other agreement);
- e) one set of representations of the design (drawings or photographs, each representation not exceeding 12.5cm by 9cm);

- f) statement of novelty;
- g) name of article;
- h) the class and sub-class of the International Design Classification;
- i) designation of view(s) to be published upon registration;
- j) details of any priority claim (the country, filing date and serial number of the priority application); and
- k) priority document and its certified English translation.

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 (e) above, note that drawings are generally preferable, as photographic representations often invoke formality objection.

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 views to be published in the Official Journal upon registration.

The application is first assigned a design application number (or series of numbers for a multiple design application) and a filing date by MyIPO. 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 six to twelve months of filing the application. The application is then published in the Official Journal. There are no provisions for opposition proceedings.

An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within twelve months of its filing date shall be deemed to be withdrawn.

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, MyIPO uses the priority date as the base date for the calculation of the registration term and the due dates of renewal payments. The application can be renewed for four further five year periods, giving a maximum term of 25 years.

Each renewal fee may be paid at any time prior to the expiry date of the current period of registration. It is also possible to make a late payment, not more than six 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 Official Journal. 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, MyIPO announced that UK registered designs granted before 01 September 1999 will be allowed to be renewed in Malaysia, for the full 25-year term. Effective 15 February 2012, the renewal of any UK registered design for a fourth or fifth 5-year period is subject to the payment of an official fee. Prior to that date, no official fee had been prescribed.

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; or
- registration of the design was procured by unlawful means.

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

Integrated Circuit Layout-Designs

The protection of layout-designs (or topographies) of integrated circuits in Malaysia is governed by the Layout-Designs of Integrated Circuits Act 2000 (hereafter "the Act") which came into force on 15 August 2000. Layout-designs are specifically excluded from the definition of a design that can be registered under the Industrial Designs Act 1996.

DEFINITIONS

As defined in the Act:

- "integrated circuit" means a product, whether in its final form or in an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in and on, or in or on, a piece of material and which is intended to perform an electronic function; and
- "layout-design" means the three-dimensional disposition, however expressed, of the elements of an integrated circuit and some or all of the interconnections of the integrated circuit or such a three-dimensional disposition prepared for an integrated circuit intended for manufacture.

QUALIFICATION FOR PROTECTION

There is no registration system. As such, no official fees are payable. A layout-design is protected automatically, provided the following conditions are met:

- the layout-design is original, in the sense of being the result of the creator's own intellectual effort and not being commonplace at the time of its creation;
- the layout-design has been fixed in material form - this includes any form of storage from which reproduction is possible - or incorporated into an integrated circuit; and
- the right holder was a qualifying person at the time the layout-design was created.

A qualifying person means a natural or legal person who is:

- a national of, domiciled or ordinarily resident in, or
- incorporated in, or
- has a real and effective industrial or commercial establishment for the creation of layout-designs, or for the production of integrated circuits in

Malaysia or any member country of the World Trade Organization (WTO).

The Governments of such countries also qualify to be the right holders of layout-designs.

TERM OF PROTECTION

A layout-design is protected for a period of 10 years from the date of its first commercial exploitation anywhere in the world, except that the term of protection shall not exceed a period of 15 years from the date the layout-design was created.

RIGHTS CONFERRED

The right holder of a protected layout-design has the right to:

- reproduce, and authorize the reproduction of, all or a substantial part of the protected layout-design, whether by incorporation into an integrated circuit or otherwise; and
- commercially exploit, and to authorize the commercial exploitation of, the protected layout-design, an integrated circuit in which the protected layout-design is incorporated, or an article that contains such an integrated circuit - commercial exploitation includes selling, letting for hire, or otherwise distributing by way of trade, and importation for these purposes.

INFRINGEMENT

Generally, it is an infringement of the rights of the right holder to do in Malaysia any of the acts referred to in the immediately preceding section, without the right holder's consent. However, there is no infringement where the act in question is done innocently, meaning the person concerned did not know, and could not reasonably be expected to have known that a copy of the protected layout-design, an integrated circuit in which it is incorporated, and/or an article in which such an integrated circuit was contained, was/were unauthorized.

ACTION AND REMEDIES FOR INFRINGEMENT

A right holder is entitled to bring an action in the High Court in the event of an infringement of his rights in a protected layout-design. The Court may grant an injunction, as well as make an order for damages or an account of profits, or such other relief as the Court considers fit.

No damages shall be awarded against a defendant who, at the time of committing an act of infringement, was not aware and had no grounds for suspecting that the act constituted an infringement.

In an action to enforce the rights of a right holder, unless the defendant puts the matter in issue, there shall be a presumption that the layout-design is protected and that the plaintiff is the right holder.

Copyright

The governance of copyright in Malaysia is provided for by the Copyright Act 1987 (hereafter “the Act”). Malaysia has been a member of the Berne Convention since 1990 and thus the local law and requirements for this branch of intellectual property law have evolved and developed to harmoniously align with other convention countries.

Categories of work recognized in Malaysia include literary, artistic and musical works. A book, manual, song, drawing, sculpture, film, sound recording and computer source codes are all examples of works that can be protected by copyright. Protection is accorded for the form of expression in a piece of work, regardless of the work’s quality.

QUALIFICATION

An interpretation of Section 10 of the Act provides the various manners in which a work may qualify for copyright protection in Malaysia:

- Status of Author: the author must be a citizen or permanent resident of Malaysia, or of any Berne Convention member country, at the time the work was made; or

- First Publication: the work must be first made available to the public in Malaysia, or in any Berne Convention member country; or if the work is first made available to the public elsewhere, it must be subsequently made available within 30 days to the public in Malaysia or in any Berne Convention member country; or
- Place of Making: the work (other than published editions) must be made in Malaysia or the work (other than sound recordings, broadcasts and published editions) is made in any Berne Convention member country.

OWNERSHIP

Copyright entitles the owner to control the doing of various acts in relation to the created work and to prevent or restrict any use without consent.

The general rule is the author of a created work would also be its copyright owner. However, there are circumstances where the author and owner are distinct from each other, such as where the author was commissioned to create the work, or where the work was created in the course of the author's employment. In such instances, copyright vests in the commissioner or employer, subject to any agreement to the contrary between the author and the other party.

COPYRIGHT SUBSISTENCE AND PROOF OF OWNERSHIP

Protection is conferred as-of-right to any original work produced with sufficient skill and effort and expressed in material form.

Although formal registration is not mandatory to secure protection, it is highly advisable that the creation of the work and its ownership are properly documented. This could be in the form of a simple copyright claim notification with the symbol ©, accompanied by the ownership details and year of publication.

As further evidentiary aid (especially in a copyright infringement suit), Section 42 of the Act allows a person to affirm an affidavit or statutory declaration, stating that copyright subsists in a true copy of the work annexed to the affidavit and that he is the owner of the copyright. The facts stated therein can be used as prima facie evidence in any proceedings under the Act, subject to further proof or disproof.

VOLUNTARY NOTIFICATION

To take proof of copyright one step further, Malaysia implemented the Copyright (Voluntary Notification) Regulations 2012 and added Section 26A into the Act.

Copyright stakeholders can voluntarily notify the Copyright Controller of their claims and deposit a copy of an eligible work with MyIPO for recording in the Register of Copyright. The rightful applicant under the Regulations is the author, owner, assignee or licensee of the copyrighted work. A representative may make such notification if the applicant is not a citizen or permanent resident of Malaysia.

A notification shall contain particulars such as details of the copyright owner and author, a Statutory Declaration to assert the applicant's locus standi, a copy of the work, the date and place of its first publication, and accompanied by the prescribed fee. The work must be titled and if it is in a language other than the national language (Bahasa Malaysia) or English, the name of that language and its translation must be provided. As the Controller does not take it upon himself to verify the claims made therein, accuracy of the information entered into the Register is dependent on the information provided by the applicant.

One requirement is that the copy of the work submitted must be clear and of durable quality to the satisfaction of the Controller. Either hard or electronic copies are permitted for submission, depending on the nature of the work in question. The official fees payable depend on the manner in which the work is deposited.

Once the notification is successfully recorded, the applicant may request for a proper certificate by paying the prescribed fee. Such a certificate shall be considered prima facie evidence in all Malaysian courts.

RIGHTS CONFERRED

A copyright owner has the exclusive rights to control in Malaysia the reproduction, communication, performance, distribution and commercial rental of his work. The copyright owner is entitled to assign or license any of these rights. However, these rights are subject to statutory exceptions including fair dealing in private study, non-profit research, review, reporting of current events, and private and domestic use.

Moral rights of the author are concurrently protected in that he has the right to be identified as the author of the work, and he can object to any act or treatment towards his work that might reasonably be regarded as adversely affecting the author's integrity or reputation.

TERM OF PROTECTION

In Malaysia, the protection period for literary, musical or artistic works published during the author's lifetime is for the life of the author and another 50 years after his death. On the other hand, for any work published after the author's death, the protection term shall be 50 years from the date of publication of the work.

INFRINGEMENT

Copyright is infringed when a person (other than the owner or licensee) commits or authorizes any act relating to the rights that are exclusive to the copyright owner. Indirect infringement is also prohibited under the Act, including the importation of any article into Malaysia for the purposes of trade or financial gain, where the person knows or ought reasonably to have known that the making of the article was done without the consent or licence of the copyright owner. There is also infringement in circumventing or causing any circumvention of any effective technological measures that are used to restrict unauthorized acts.

These acts of infringement are actionable by way of a civil suit in the High Court. Reliefs that may be granted include damages, an account of profits and an injunction.

OFFENCES

Other than civil remedies, certain infringing acts attract criminal liability. These include making an infringing copy for sale or hire, importing, selling, letting for hire or distributing any infringing copy, possession other than for private use, and operating an audiovisual recording device in a screening room. The penalties include a substantial fine for each infringing copy and/or imprisonment not exceeding five years. For subsequent offences, both the fine and imprisonment are doubled. Power and responsibility for criminal enforcement lie with the Enforcement Unit of the Ministry of Domestic Trade and Consumer Affairs.

Plant Variety Protection

Plant breeder's rights are protected in Malaysia by the filing of new plant variety applications under the Protection of New Plant Varieties Act 2004 (hereafter "PNPV Act"). Presently, Malaysia has yet to accede to the International Union for the Protection of New Varieties of Plants (UPOV).

REGISTRABILITY

It is intended for the PNPV Act 2004 to ultimately offer protection for all crops. However, for the time being, protection is limited to a priority list of 25 crops divided amongst ornamental crops, fruits, industrial crops, cereal crops and forest plantation species. The processing of application for plant varieties other than those listed in the priority list is subject to the availability of technical expertise and technical data and at the discretion of the Plant Variety Protection Registration Office (PVPRO).

In order to qualify for registration under the PNPV Act, the plant variety needs to firstly meet the novelty requirement.

A plant variety will be considered new if the new variety and/or material propagated or harvested from the new variety has not been commercialized or sold either earlier than one year in Malaysia or four years in other countries, prior to the filing date.

For varieties of trees and vines that have been prior commercialized outside of Malaysia, the novelty term is six years prior to filing.

Additionally, plant varieties will also need to meet the standard DUS requirement i.e. distinct (clearly distinguishable from any other plant variety), uniform (sufficiently uniform in the relevant characteristics) and stable (relevant characteristics remain stable after repeated propagation).

A lower standard of registrability is imposed on plant varieties that are bred or discovered and developed by a farmer, local community or indigenous people. Such varieties will only need to be new, distinct and identifiable to qualify for registration.

NON-REGISTRABLE VARIETIES

An application for registration will not be approved for any plant variety that is either contrary to public order or morality; or where there are reasonable grounds to believe that the cultivation, reproduction or use of that plant variety may negatively impact the environment.

FILING REQUIREMENTS

The minimum filing requirements for a Malaysian plant variety application are:

- a) the name, address and nationality of applicant;
- b) specification of method by which the variety was developed;
- c) supporting documents and/or information relating to distinguishing characteristics of variety;

- d) proposed denomination for variety;
- e) information relating to the source of genetic material or immediate parental lines of variety;
- f) supporting documents relating to compliance with any law regulating access to genetic or biological resources;
- g) supporting documents relating to compliance with any law regulating activities involving genetically modified organisms (if the variety involves genetic modification); and
- h) prior written consent of the authority representing a local community or indigenous people (if the variety is developed from traditional varieties).

When filing a new Malaysian plant variety application on the basis of a corresponding foreign application, a copy of the registration certificate, certified as true by the foreign Plant Variety Protection Office (together with a verified English translation, if the document is in a non-English language) is required. If available, it is also advisable to submit a list of all corresponding foreign applications together with their status.

EXAMINATION

After filing, the application will undergo preliminary examination for novelty, suitability of the proposed denomination and whether the plant variety applied for falls under the definition of a non-registrable variety.

Upon successful completion of preliminary examination, a notice will be issued by the PVPRO. Thereafter, the applicant will need to request for substantive examination within 30 days of receipt of the notice from the PVPRO.

During substantive examination, the variety will undergo DUS examination which can be conducted by the PVPRO based on any of the following methods:

- a) growing test;
- b) on-site inspection; and
- c) document examination.

The growing test is conducted at the PVPRO's DUS Test Station or in any other appropriate site ascertained by the examiner. The on-site inspection is carried out by the examiner in the applicant's premises.

Generally, where corresponding foreign applications have been filed, DUS examination will normally be conducted based on document examination i.e. the PVPRO will consider the DUS test reports issued by the foreign Plant Variety Protection Authority.

The details of the plant variety will be published by the PVPRO in the Government Gazette upon completion of substantive examination.

OPPOSITION

Any interested party may oppose the registration of a new plant variety within three months of its publication in the Government Gazette. The opposition procedure is conducted before the PVPRO.

The registration of a new plant variety can be opposed on the following grounds:

- a) the person opposing the registration of the new plant variety is entitled to the breeder's rights of that variety;
- b) the application for registration of the new plant variety and grant of breeder's rights does not comply with the requirements of the PNPV Act;
- c) the application for registration of the new plant variety and grant of breeder's rights is contrary to public order or morality;
- d) the application for registration of the new plant variety and grant of breeder's rights may produce a negative impact on the environment.

REGISTRATION

If no opposition is filed, the application will be approved for registration and the applicant will be notified.

The applicant is then required to deposit a sample of the seeds or other propagating material of the plant variety with the PVPRO within three months of notification of approval.

The quantity of the samples to be deposited is as follows:

- a) seeds – 1000 seeds or 10 grams, whichever is suitable; or
- b) other propagating materials – 10 plants.

The certificate of registration will be issued by the PVPRO once the relevant samples have been deposited. The denomination and registration of the new plant variety will be recorded in the Register of New Plant Varieties and published in the Government Gazette.

DURATION AND RENEWAL

A registered plant variety will have a maximum term of 20 years calculated from the filing date of the application. For varieties of trees and vines, the maximum term of protection is 25 years from the filing date.

The maximum term of protection for registered plant varieties bred or discovered and developed by a farmer, local community or indigenous people is 15 years.

Annual renewal fees are payable after registration.

INFRINGEMENT

The exclusive breeder's rights granted under the PNPV Act are the right to produce or reproduce, condition for the purpose of propagation, offer for sale, sell, export, import, and stock the material for the purpose of propagation, offering for sale, selling, exporting, importing.

These exclusive rights extend to the following:

- a) propagated/harvested material entirely or partly derived from unauthorized propagating;
- b) varieties not clearly distinguishable from the registered variety; and
- c) production of varieties that require repeated use of the registered variety.

Any unauthorized exploitation of the variety will constitute infringement of the exclusive breeder's rights accorded under the PNPV Act.

Applicants are encouraged to provide molecular data in the form of a DNA fingerprint of the protected variety along with the protocols and primers used for the DNA fingerprinting to the PVPRO during substantive examination. This information will aid in safeguarding the interest of rights holders in the event of infringement.

Infringement proceedings must be instituted before the High Court. Such proceedings must be instituted by the rights holder within five years from the date the infringement was discovered or could have reasonably been discovered by the rights holder.

INVALIDATION

Any interested party can institute invalidation proceedings before the High Court.

The grounds on which invalidation of a registered plant variety may be sought are as follows:

- a) the rights holder has furnished false or misleading information/statement to the PVPRO in respect of the application for registration of the new plant variety;
- b) the rights holder has not complied with the requirements of the PNPV Act; or
- c) the breeder's right does not belong to the person to whom it was granted.

REVOCACTION

The PVPRO may revoke the breeder's right granted if:

- a) the rights holder fails to provide the information, facilities or propagating material deemed necessary for maintenance of the deposited samples, when requested;
- b) the rights holder fails to pay the relevant fees to keep his rights in force;
- c) the registered variety fails to demonstrate continuously the characteristics for which the registration was made and granted;
- d) the rights holder contravenes any of the terms and conditions imposed on him as owner; or
- e) the rights holder uses or caused to be used the deposited samples without the prior written permission of the PVPRO.

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