

MALAYSIA

Q&A

Patent, Trade Mark, Industrial Design and Copyright



Henry Goh & Co Sdn Bhd

Intellectual Property Consultants

Registered Patent, Trademark & Design Agents

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ABOUT HENRY GOH

HENRY GOH & CO was founded in 1977 by Henry H P Goh. We are one of the leading patent and trade mark firms in Malaysia, as well as the longest established.

Our clientele ranges from prominent multi-national companies to innovative individuals in all fields of commerce and industry. We act on behalf of clients from over 45 foreign countries - a track record that speaks for itself.

Expertise

We provide a full range of intellectual property rights (IPR) protection and enforcement services worldwide, particularly in

- Malaysia
- Singapore
- Brunei

We employ customised, up-to-date software to ensure that every part of our organisation responds with maximum speed and efficiency to our clients' requirements.

Our clients can be confident that we have the

- Expertise
- Knowledge
- Resources

to ensure that their intellectual property portfolio is in the best possible hands.

OUR PROFESSIONAL SERVICES

HENRY GOH & CO SDN. BHD. provides a comprehensive range of services relating to intellectual property. These services are available in Malaysia and abroad to meet the needs of the globalization of Malaysian businesses.

The services cover:

- Initial advice on protecting your new invention, trade mark or design
- Filing and prosecution of patent, trade mark and design applications on a worldwide basis
- Maintenance of intellectual property rights after registration
- Advice as to the proper course of action necessary for exploitation (including licensing and franchising) and enforcement of intellectual property rights



INTRODUCTION

Patents, Trade Marks, Industrial Designs and Copyright form the four major areas of intellectual property. Exclusive rights to each of these areas of intellectual property can be conferred on the owner to prevent competitors from enjoying the same rights. Copyright protection is conferred automatically. However, in the case of Patents, Trade Marks and Designs, it is critical to register the rights in order to enjoy their benefits.

- It is most important that you protect your intellectual property. It can become a valuable commercial tool.
- More companies are becoming knowledgeable about intellectual property rights, and are realising that they are valuable business assets. They are now including them in their business plans, marketing strategies and balance sheets.
- Intellectual property rights can be used to prevent others from copying and thereby taking advantage of your ideas or the goodwill you have developed for your products and services.
- They can be used to give you a time lead and market advantage over your competitors.
- They can be used to raise funds by selling, or licensing the rights for royalty payments.

PATENT

1.What is a Patent?

A patent for an invention is a legal right granted by the government. It allows you to stop other people from using your invention during the life of the patent.

2.What is an Invention?

Patents cover all fields of technology. Basically, an invention is something which is new and is not obvious. It must be technical, but it does not need to be complicated or high tech. An invention can be many things, including a machine, device or any kind of mechanical, electrical or electronic product, a chemical substance, a biotechnological product, or an industrial process.

Some things, although new, cannot be patented. This is usually because they are not technical or they do not have a use in industry. For example, an oil painting, a method of fortune telling and a method of selling insurance are all examples of things which cannot be patented.

3.What is meant by New?

New means that the invention must not be known previously anywhere in the world. If the invention has been published or made public in any way before the patent is applied for, then the patent right generally cannot be obtained. So, you should plan and budget for patenting early on in order that your patent application can be submitted before any publication, advertisement, sale, public demonstration or use of the invention occurs.

In Malaysia, a patent can be applied for up to one year after the first disclosure of the invention by its owner. The invention will still be treated as new and therefore patentable. However, such disclosure will normally prevent you from obtaining patents overseas.

4. What is meant by Inventive Step?

In addition to being new, an invention must involve what is known as an inventive step. This means that the invention must be something more than a trivial or obvious modification of the existing technology. It does not mean that the invention needs to be ingenious or complicated. In fact, many patentable inventions are based on simple ideas, such as small yet advantageous improvements to existing products or processes.

5. How do I obtain a Patent for an Invention?

In order to obtain a patent, it is necessary for the owner of the invention to file a formal patent application with the Patent Registry. The invention must be described and defined in a document known as the specification. The specification includes a description and drawings of working examples of the invention, as well as a set of claims that defines the invention to be protected. 18 months after filing your patent application, the specification becomes a public document - anyone can obtain a copy of it and learn about your invention. However, provided the patent is granted, you may be able to claim compensation for use of your invention by third parties while the application was pending.

Among other things, the patent application will be searched for newness and examined for inventive step by a patent examiner. Normally various objections will be raised that need to be replied to by way of amendment of the specification and/or argument. After that stage, provided the examiner is satisfied that the application meets the requirements of the Patents Act, a patent will be granted to the owner.

6. What is a Utility Innovation Certificate?

This is a registration like a patent that protects what is called a utility innovation instead of an invention. A utility innovation is a lower level invention. It must be new, but there is no requirement for inventive step. The specification is restricted to only one claim. The term of

protection is up to 20 years, but renewal after 10 years is dependent upon use in Malaysia, or satisfactory explanation of non-use.

7. Who is entitled to apply for a Patent?

Only the owner of the invention, whether an individual or a company, can apply for a patent. You can never patent someone else's invention.

8. How long does a Patent last?

Once a patent has been granted, a renewal fee must be paid to the Patent Registry every year to maintain the protection. The maximum life of the patent is 20 years from the initial filing date.

9. What Territory does a Patent cover?

A Malaysian patent has effect only in Malaysia. To obtain protection in other countries, it is necessary to apply for separate patents in those countries. There is no such thing as world patent. However, there are international agreements that allow you to defer the costly procedure of applying for patents overseas for between 12 and 30 months from your original Malaysian filing date.

10. What Protection does a granted Malaysian Patent provide?

The scope of protection is defined by the claims contained in the specification. If the claim defines a product, the patent is infringed by making, importing, selling or using the defined product in Malaysia. In the case of a process claim, the patent covers using the defined process in Malaysia, and doing in Malaysia any of the above-mentioned acts in respect of a product obtained directly by means of the process.

11. How do I enforce my Patent rights?

The Patent Registry or Police cannot enforce your patent for you. You must take action against infringers yourself by having a lawyer start proceedings in the High Court. Fortunately, most patent disputes can be settled by agreement between the parties without the need for such legal action.

12. What is the role of a Patent Agent?

A patent agent is a professional who specialises in patents. A patent agent represents you before the Patent Registry, so that you do

not need to worry about the complexities of the patenting process. Only qualified and experienced individuals are listed in the official government register of Patent Agents.

A patent agent advises on whether an invention is potentially suitable for a patent, writes the specification to meet the exacting legal requirements and to obtain the best protection for the invention, and handles technical objections raised by the Patent Registry in the process of having the patent granted.

Since patents are obtainable only on a country-by-country basis, a patent agent is also familiar with the requirements and procedures of patent filing overseas. The patent agent will work closely with foreign associates to obtain patent protection for you in other countries of interest.

He or she may also advise generally on how to use your patent once it is registered, for example by means of licensing. In addition to their expertise in patents, patent agents are knowledgeable in related areas of law such as designs, copyright and trademarks.

Professional ethics ensure that all the details of your invention that you give to a patent agent will always be treated in strictest confidence.

TRADE MARK

1. What is a trade mark?

A trade mark is used by a trader or service provider to identify his goods or services and to distinguish them from those of other traders. A trade mark could take the form of, for example, a dictionary word, an invented word, numbers, letters, a logo, a picture, a slogan or any combination of these. Some examples of well-known trade marks are KODAK for cameras, MICROSOFT for computer programs and COCA-COLA for drinks.

A registered trade mark is a legal right granted by the government. It gives the owner a statutory monopoly for the exclusive right to use the mark in relation to the goods or services for which the mark is registered.

2. Are all trade marks registrable?

Not all trade marks are registrable. In general, marks which other traders would legitimately want to use to describe their goods or services are not registrable. Thus, for example, the mark should not be descriptive of the goods, it must be “distinctive”. Examples of unregistrable marks are “PERFECT” or “THE BEST”. Other unregistrable marks include well-known surnames or the name of a large city or country.

Also, the mark should not conflict with earlier filed or registered trade marks.

3. What is a service mark?

The term service mark refers to trade marks which are used in relation to services rather than in relation to products or physical goods. Examples of services include banking, insurance, hotels, restaurants, education, computer programming, cleaning, repairing, advertising and so on.

4. Why should you register a trade mark?

It is not compulsory to register a trade mark. However, if someone is infringing your mark, and the mark is not registered, then it will be necessary to take action under the common law of “passing off”. A passing off action can be very expensive, time consuming and the outcome can be very difficult to predict.

It is normally much simpler to prove infringement of a registered trade mark. In many cases, a cease and desist letter from your trade mark agent or lawyer is all that is needed to stop the infringing act.

5. Is it necessary to conduct a pre-filing search?

Before filing a trade mark application, or starting to use a new mark, it is advisable to first make a search at the Malaysian Trade Marks Office to ensure that there are no marks identical to, or closely resembling your mark, filed or registered by others for similar goods or services. The search is best handled by Registered Trade Mark Agents, who will be able to offer professional advice on the availability and registrability of the mark.

6. How do I obtain a trade mark registration?

To obtain registration of a trade mark, it is necessary for the owner of the mark to file a formal trade mark application with the Trade Marks Office. The application will be examined by the Examiner for conflict with any earlier marks and its registrability will be determined based on various factors such as distinctiveness.

7. What is the duration of a trade mark registration?

The term or duration of a trade mark registration is initially 10 years from the date of application. Upon payment of a fee, the registration is then renewable every 10 years in perpetuity.

8. What about protection in other countries?

A trade mark registered in Malaysia is valid only in Malaysia. If you intend to export your products to other countries, you should consider applying for protection in each country in which protection is desired. However, it is possible to file a single application for a trade mark for a group of 25 countries in the European Union, by filing a European Community Trade Mark (CTM) application.

9. What can a registered trade mark agent do for you?

Registered trade mark agents possess skill and knowledge in all phases of trade mark prosecution and registration. They can advise on the registrability of your mark, conduct pre-filing searches, prepare all the necessary paperwork required to file a trade mark application, handle any objections raised by the Trade Marks Registrar and/or any oppositions raised by third parties during the process of registration. Trade mark agents also have close contacts with foreign associates for the purpose of obtaining appropriate trade mark protection in other countries.

10. What is the difference between trade marks, domain names and company names?

Trade marks should not be confused with company names or domain names.

Unlike a registered trade mark, company and domain names do not give you statutory monopoly right.

A company name merely serves to identify the owners of the business. A domain name is merely a textual address for a location on the Internet.

Many organisations now register the same mark both as a trade mark and as a domain name.

INDUSTRIAL DESIGN

1. What is an Industrial Design?

An industrial design consists of features including shape, configuration, pattern or ornament applied to an article by an industrial process. That is to say, industrial design registration protects the visual appearance of the article.

2. Name some articles the designs of which are registrable?

Furniture, toys, handphones, electronic gadgets and appliances, household utensils, bottles, cases, carpets, wallpaper and textile materials.

3. What purpose does a design registration serve?

The product you have designed may be attractive in appearance and appealing to your customers. Design registration will allow you to stop others from copying your design and profiting by it. The registered owner has the exclusive right to make or sell in Malaysia the design in relation to the article mentioned in the registration.

4. Can any Industrial Design be registered?

No. To be registrable a design must be new. This means that the design must not have been previously sold or otherwise made public in Malaysia before you file your application for registration. The design must also meet the legal definition, including having “eye appeal”.

5. Do we have Industrial Design registration in Malaysia?

Yes. Registration of Industrial Design is now available in Malaysia with the implementation of the Industrial Designs Act 1996 that came into force on September 1, 1999.

6. Who can apply to register an Industrial Design?

Only the owner of the design, whether an individual or a company, can apply for its registration. You can never register someone else's design.

7. How long does a Design registration last?

The maximum life of a Malaysian design registration is 15 years. A renewal fee must be paid after 5 and 10 years to maintain the protection.

8. What Territory does a Design registration cover?

A Malaysian design registration has effect only in Malaysia. To obtain protection in other countries, separate applications must be filed in those countries.

COPYRIGHT

1. What is copyright?

Any original work produced with sufficient skill and effort and expressed in material form is entitled to copyright. A book, manual, song, drawing, film, sound recording, computer software can all be protected by copyright.

2. What is the purpose of copyright?

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

3. What does not amount to copyright?

Copyright protection does not extend to any idea, procedure, method of operation or mathematical concept. Copyright does not subsist in any design which is registered under any written law relating to industrial design. Further, copyright in any design which is capable of being registered but which has not been so registered, ceases as soon as any article to which the design has been applied has been reproduced more than fifty times by any industrial process by the owner of the copyright or by any person under the licence of the owner.

4. Is copyright registration necessary to obtain protection in Malaysia?

No. Under Malaysian law, copyright protection is conferred in an original work once it is expressed in material form provided that:-

- a) the author is a citizen or permanent resident of Malaysia or a citizen or resident of any of the Berne Convention member countries at the time his work was made, or
- b) the work is first made available to the public in Malaysia or in any of the Berne Convention member countries, or
- c) if the work is first made available to the public elsewhere, it is subsequently made available within 30 days, to the public in Malaysia or in any of the Berne Convention member countries, or
- d) the work (other than published editions) is made in Malaysia or the work (other than sound recordings, broadcasts and published editions) is made in any of the Berne Convention member countries.

5. Is copyright protection limited to Malaysia only?

By Malaysia's accession to the Berne Convention for the protection of Artistic and Literary Works, a work that is eligible for copyright in Malaysia is accorded reciprocal protection in other member countries.

6. How long can copyright protection last?

Generally, for literary, musical or artistic works published during the author's lifetime, the protection period is for the life of the author plus fifty years after his death. However, for such works published after the death of the author, copyright shall subsist until fifty years from the publication of the work.

7. I have published a book in Malaysia last month. Do I have worldwide copyright protection?

Yes. Malaysia is a Berne Convention member country and with first publication in Malaysia, your book is protected by copyright in more than 150 Berne Convention countries.

8. I have devised a story line for a novel. Is my idea protectable under copyright law?

Copyright does not protect the mere ideas underlying a work. You should express the details of your story by having them written down, recorded or reduced to material form.

9. Our company has a play for the theatre, what copyright do we have? How can we exploit these rights?

You have a right in the literary, musical and / or artistic work and maybe even adaptation of the work. For example, you have exclusive control over the reproduction of the script of the play and the performance. If the play is recorded, you have control over the distribution of copies of the work to the public by sale or other transfer of ownership and the commercial rental to the public.

10. What is the benefit of copyrighting my work?

By virtue of having a copyright, one is able to transfer this copyright by assignment, testamentary disposition or by operation of law for monetary value just as one could for property. One could also grant licences for certain acts such as reproducing the literary or musical work, performing, showing or playing the work in public in exchange for royalty.

11. How do I prove I have copyright?

Affirm an affidavit or statutory declaration before a commissioner for oaths in respect of any of the works eligible for copyright stating that, at the time stated therein copyright subsisted in such works and annex a copy of the work.

12. Why do I need to check on licensing of copyright if I am translating a piece of work into the national language?

The owner of the copyright has the exclusive right of making or authorising a translation of his work into any language. The right to translate a work into the national language (Bahasa Malaysia) is available for only a year following the first publication of the work. If no such translation has been published by the owner, the Copyright Tribunal may, on application grant a non, exclusive licence to translate and publish the work in the national language.

13. What's new?

The Malaysian Copyright Licensing Tribunal has been set up. Among its most important functions, is that the terms of a proposed licensing scheme can be referred to the Tribunal for its decision. The Tribunal

also settles disputes between the operator of the licensing scheme and the person who requires a licence.

Live performances of a dramatic work, puppet show, musical work, reading, recital or delivery of a literature, dance, circus act, folklore dances or shows are now protected under the Malaysian copyright law and entitled to all the benefits of copyright protection.

Database copyright protection is available as long as it satisfies the requirement of selection, coordination and arrangement of the works eligible for copyright.

In 2003, criminal sanctions and punishment (in terms of fines and imprisonment) for infringement of copyright have been hardened and increased in order to deter such acts.



Since 1977

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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:

Bangladesh	Japan	Philippines	India	Laos	China
Cambodia	Korea	Sri Lanka	Nepal	Indonesia	Hong Kong
Myanmar (Trade mark only)	Taiwan	Thailand	Pakistan	Vietnam	Macau