

# MALAYSIA – PATENTS

## KEY POINTS

- Patentability Criteria – Qualification, Novelty, Inventive Step, Industrially Applicable
- Acts & Regulations – governed by the Patents Act 1983 and the Patents Regulations 1986
- Non-patentable inventions –
  - discoveries, scientific theories and mathematical methods
  - plant/animal varieties or essentially biological processes for the production of plants and animals, other than man-made living organisms, micro-biological processes and the product of such micro-organism processes
  - schemes, rules or methods for doing business, performing purely mental acts or playing games
  - methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practiced on the human or animal body
- Utility innovation system is also available – no necessity to satisfy the test of inventive step, and contains only one (1) claim
- Malaysia is also party to the Patent Cooperation Treaty (PCT), hence filing of patents via the PCT national phase route is also available

## DURATION

### Patents

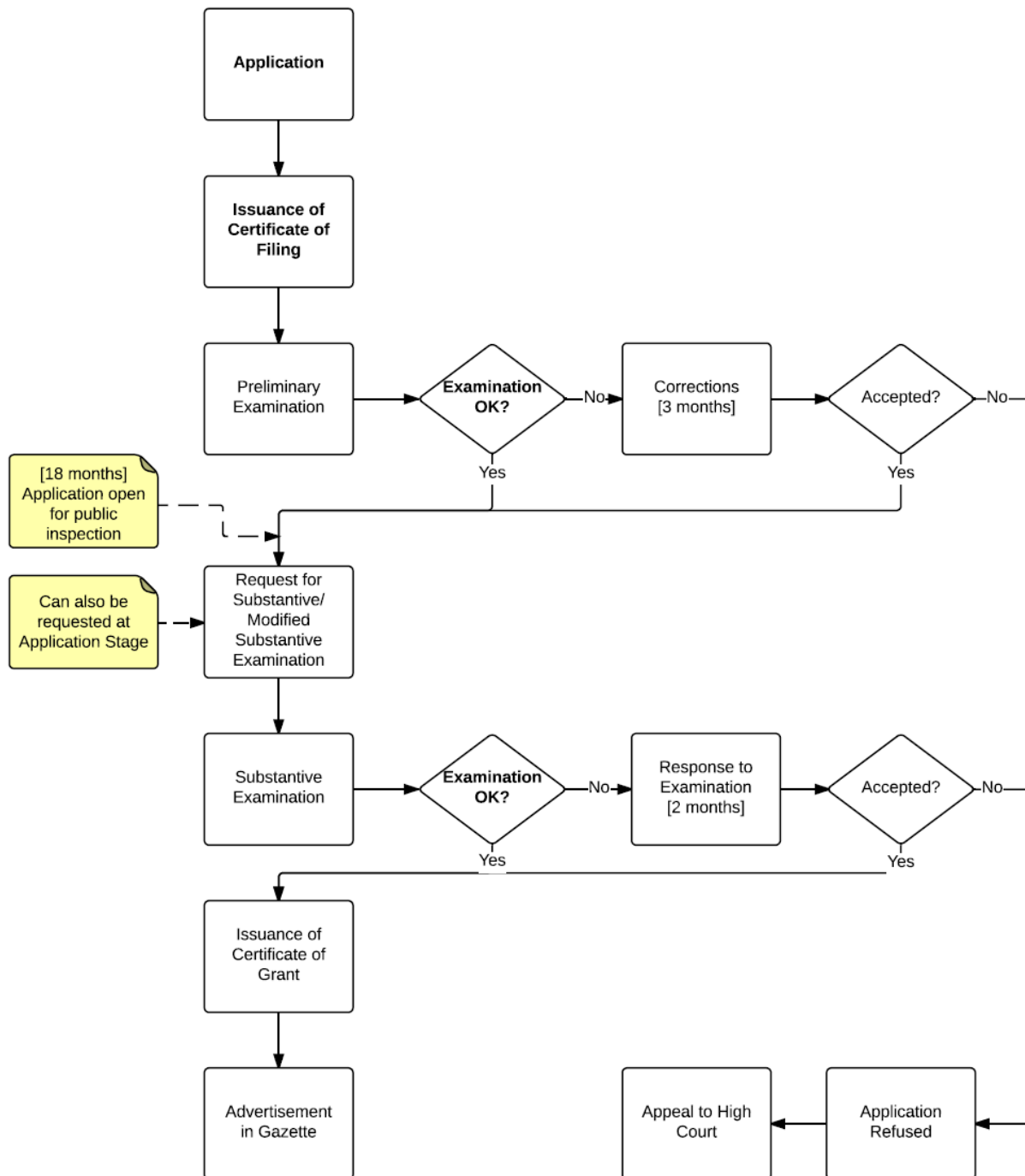
Upon grant, a patent is protected up to a maximum period of twenty (20) years from the date of filing, upon payment of annuities on a yearly basis.

### Utility Innovations

Upon grant, a utility innovation has an initial duration of protection of 10 years from the filing date, upon payment of annuities on a yearly basis. The Applicant may before the expiration of the period of 10 years, apply for an extension for an additional period of 5 years and may, before the expiration of the second period of 5 years, apply for an extension for a further period of 5 years, thus allowing a maximum duration of 20 years from the filing date.

## PROCEDURE FLOWCHART

A brief flowchart depicting the procedures for the registration of patents (via national route) is as follows:-



## COSTINGS & FILING REQUIREMENTS

We append hereunder our rates for filing a new patent application via the routes of Paris Convention, Utility Innovation (which is identical to petty patent or utility models) and PCT national phase.

Please note that the above quotes are premised on the present professional and official rates as well as the current exchange rate, which may be changed without prior notice, although we will endeavor to keep you informed of such changes.

### Convention Patent Application

The initial costs of filing an application having 1 priority and 10 claims are:

Application	USD (Electronic Filing)
<b>Professional Fees</b>	
-Filing application with first 10 claims	382
- Claiming 1 priority application	60
-Filing Statement of Applicant's right	50
- Formality Correction of Specification	109
- Subsequent Filing of Documents (if signed Form 17 & Statement Justifying Applicant's Right to the Invention not filed – see below)	77
<b>Official Fees</b>	
-Filing application with first 10 claims	75
-Filing Patents Form No. 17	20
-Filing Statement of Applicant's Right	20
Disbursements	36
Bank Charges	10
Service Tax – 6%	43.44
<b>TOTAL:</b>	<b>882.44*</b>

*\*Please note that the official fee is slightly higher, as shown above, if the documents have to be filed manually for any reason beyond our control.*

Additional Items	USD
Each claim after the 10 <sup>th</sup> claim	18.72
Each priority claim	63.60
Each subsequent filing of documents (per occasion)	82

General details of what is required for filing the application in Malaysia is summarised below. Please note that the minimum required documents for securing an official filing date are marked with asterisks (\*):

1.     \*Applicant:
  - 1.1   Applicant's name
  - 1.2   Applicant's address
  - 1.3   Applicant's nationality or state of incorporation.
  
2.     \*Inventor(s):
  - 2.1   Inventor's name
  - 2.2   Inventor's address
  
3.     \*Patent Specification & Drawings:  
 We will require a copy of the specification in the English language, which will be used for filing in Malaysia. If the specification is not filed in English. Please let us have a sworn English translation of the same. Kindly also provide us with a copy of the specification in MSWord format.
 

***NOTE: Please note that filing the drawings after the application has been lodged IS NOT RECOMMENDED as the drawings could be considered "new materials" and the official filing date would then be revised to the date that the missing drawings are received by the Patent Office. The new filing date may fall outside the priority period, if any, or after novelty-destroying disclosure has been made.***
  
4.     \*Priority particulars (if any):
  - 4.1   Country or territory
  - 4.2   Application number
  - 4.3   Date of filing
 Certified copy of the priority application is not required at the time of filing unless later requested by the Registrar.
  
5.     Information on devolution of rights to the invention from the inventor to the Applicant (e.g. by virtue of assignment or employment). The document evidencing the devolution of rights such as the deed of assignment is **not** required unless later requested by the Intellectual Property Office.
  
6.     Agent Appointment Form (Patents Form No. 17) signed by the Applicant. This is the only document requiring signature. **No notarization or legalization required.** An editable softcopy in MS-Word is **enclosed** herewith as a file attachment.

Please be advised that if the documents (5) and (6) are not filed simultaneously with the application, the Registrar will issue a Preliminary Examination – Adverse Report, requesting the Applicant to submit the outstanding documents within 3 months from the date of issuance of the report.

### **Utility Innovation Application**

Please note that the filing of a utility innovation application (which is identical to petty patent or utility models) is about the same as that for the patent application except for the following:

- for utility innovation application, only 1 claim is allowable and the official fees for filing the application is slightly lower.
- utility innovation has lower requirements in that it will only need to fulfil the requirements of novelty and industrial applicability but does not have to involve an inventive step, which is a requirement for patent application.

The initial costs of filing a utility innovation application, with no priority claim are:

Application	USD (Electronic Filing)
<b>Professional Fees</b>	
-Filing application with first 10 claims	382
-Filing Statement of Applicant's right	50
- Formality Correction of Specification	109
- Subsequent Filing of Documents (if signed Form 17 & Statement Justifying Applicant's Right to the Invention not filed – see below)	77
<b>Official Fees</b>	
-Filing an application	40
-Filing Patents Form No. 17	20
-Filing Statement of Applicant's Right	20
Disbursements	36
Bank Charges	10
Service Tax – 6%	39.84
<b>TOTAL:</b>	<b>783.84*</b>

*\*Please note that the official fee is slightly higher, as shown above, if the documents have to be filed manually for any reason beyond our control.*

Additional Items	USD
Each priority claim	63.60
Each subsequent filing of documents (per occasion)	82

The required information and documents are the same as that for the filing of a convention patent application.

## PCT National Phase Application

The initial costs of filing an application having 1 priority and 10 claims are:

Application	USD (Electronic Filing)
<b>Professional Fees</b>	
-Filing application with first 10 claims	382
- Claiming 1 priority application	60
-Filing Statement of Applicant's right	50
- Formality Correction of Specification	109
- Subsequent Filing of Documents (if signed Form 17 & Statement Justifying Applicant's Right to the Invention not filed – see below)	77
<b>Official Fees</b>	
-Filing application with first 10 claims	75
-Filing Patents Form No. 17	20
-Filing Statement of Applicant's Right	20
Disbursements	36
Bank Charges	10
Service Tax – 6%	43.44
<b>TOTAL:</b>	<b>882.44*</b>

*\*Please note that the official fee is slightly higher, as shown above, if the documents have to be filed manually for any reason beyond our control.*

Additional Items	USD
Each claim after the 10 <sup>th</sup> claim	18.72
Each priority claim	63.60
Each subsequent filing of documents (per occasion)	82

General details of what is required for filing the application in Malaysia is summarised below. Please note that the minimum required documents for securing an official filing date are marked with asterisks (\*):

1. \*PCT Request Form - this document is required to be submitted during the national phase entry. If the PCT application is not filed in the English language, we will require a copy of the sworn English translation of the PCT request form.
2. Information on devolution of rights to the invention from the inventor to the Applicant (e.g. by virtue of an assignment or by employment of the inventor).

3. Agent Appointment Form (Patents Form No. 17) signed by the Applicant. This is the only document requiring signature. No notarization or legalization required. An editable softcopy in MS-Word is attached herewith as a file attachment.
4. \*Editable copy of specification and claims - kindly forward a copy of the specification in MSWord format to us, as we may need to make necessary corrections before entering the application into Malaysia to avoid receiving an Adverse Formalities Report. If the PCT application is not filed in the English language, we will require a copy of the sworn English translation of the specification.

Also, where documents are not originally in English, please be advised that we would require a copy of the verification signed by the translator confirming that the English translations of the specification and the PCT Request Form is accurate for filing. We will be therefore relying on you to provide us with the verification.

Please be advised that if the documents (2) and (3) are not filed simultaneously with the application, the Registrar will issue a Preliminary Examination – Adverse Report, requesting the Applicant to submit the outstanding documents within 3 months from the date of issuance of the report.

### **Substantive Examination**

At the substantive examination stage (which is due within 18 months from the filing date of a convention patent application or 4 years from the international filing date of a national phase application) the options for examination and the relevant costs are:

<b>NORMAL SUBSTANTIVE EXAMINATION</b>	<b>USD</b> (Electronic Filing)
Professional Fees	273
Official Fees	272
Disbursements	36
Bank Charges	10
Service Tax – 6%	19.14
<b>TOTAL:</b>	<b>610.14*</b>

*\*Please note that the above official fee reflects filing of the prescribed fee via electronic filing. Kindly be advised that the official fee is higher if the fee has to be paid manually for any reason beyond our control.*

<b>MODIFIED SUBSTANTIVE EXAMINATION</b>	<b>USD</b> (Electronic Filing)
Professional Fees	273
Official Fees	172
Disbursements	36
Bank Charges	10
Service Tax – 6%	19.14
<b>TOTAL:</b>	<b>510.14</b>

	[excluding costs for amendments & excess claims]
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DEFERMENT OF SUBSTANTIVE EXAMINATION	USD (Electronic Filing)
Professional Fees	218
Disbursements	36
Bank Charges	10
Service Tax – 6%	15.84
<b>TOTAL:</b>	<b>279.84*</b>

Kindly note that these figures do not include costs for responding to office actions of a technical nature which might be raised by the Examiner. A response may cost anywhere from **USD 218** onwards depending on the extent of the objections and technical complexity of the matter.

### Allowance and Grant

Upon allowance and grant, the issuance costs are:

Issuance	USD
Professional Fees -reporting allowance -receiving and forwarding Certificate of Grant	273
-General disbursements -Courier charges -Bank charges -Service Tax – 6%	36 [depending] 10 19.14
<b>TOTAL:</b>	<b>338.14 excluding courier</b>

On average, it takes about 5 years from application to grant and the patent term is 20 years from the date of filing.



## **Renewal**

The renewal fees are only payable once the application is granted, and the costs are:

<b>Renewal</b>	<b>USD</b>
Professional Fees	175
Official Fees	Depending on the year of renewal
Disbursements	36
Bank charges	10
Service Tax – 6%	13.26