

INTELLECTUAL PROPERTY PROTECTION IN MALAYSIA – WHAT YOU NEED TO KNOW





	PATENT	UTILITY INNOVATION	TRADEMARK	INDUSTRIAL DESIGN
General Definition	An idea when put into practice forms a solution to a problem in any field of technology	An innovation in relation to a new product or process, or any novel improvement and is part of an invention	Generally the word “mark” denotes “a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof. Trademark - a mark that is used or proposed to be used in relation to goods or services	An external/physical outlook of an article.
Subject Matter	A patentable subject matter should meet the following requirement(s): 1. Novel -not anticipated by	A utility innovation must be new/novel, and industrial applicable however without having to fulfil the requirement for inventive step as in	A trade mark is considered as registrable if it falls within the following:	Following the above definition, the article having new features configuration or shape which are

	<p>prior art ¹</p> <p>2. Involves Inventive Step – not obvious to a person skilled in the art</p> <p>3. Industrial Applicability – can be made or used in any kind of industry</p> <p>Non-patentable subject matter:</p> <p><i>Discoveries, scientific theories and mathematical methods;</i></p> <p><i>Plant² or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living micro-organisms;</i></p> <p><i>Microbiological processes and the products of such</i></p>	<p>Patents.</p>	<p>name of an individual, company or firm represented in a special or particular manner;</p> <p>the signature of the applicant for registration;</p> <p>an invented word(s);</p> <p>a word that does not have any direct reference to the character or</p> <p>quality of the goods or services and is not in its ordinary meaning;</p> <p>geographical name or surname; or</p>	<p>appealing to the eye; said features are not dictated solely by function.</p> <p>Non-registrable designs:</p> <p>1.A method and principle of construction</p> <p>2.Features and configurations dictated solely by function;</p> <p>3.Features and configurations which are dependent on the appearance of another article to</p>
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	<p><i>microbiological processes;</i></p> <p><i>Schemes, rules or methods for doing business, performing purely mental acts or playing games; and</i></p> <p><i>Methods for the treatment of the human or animal body by surgery or therapy, and diagnostic methods practiced on the human or animal body.</i></p>		any other distinctive mark.	<p>form an integral part;</p> <p>4.An integrated part of a circuit⁵</p>
Grace Period for Disclosure prior to filing	12 months from first date of disclosure	12 months from first date of disclosure	None	Absolute newness – should not be disclosed in any part of the world prior to the priority date/earliest filing date
Claim Priority ⁶	12 months from the first date of filing	12 months from the first date of filing	6 months from the first date of filing	6 months from the first date of filing

<p>Requirement(s) for filing an application (filed with the Intellectual Property Corporation of Malaysia - MyIPO)</p>	<p>Basic filing requirement (s) to secure a filing date:</p> <ol style="list-style-type: none"> 1. Specification 2. Drawing(s) if any 3. Inventor's details 4. Applicant's details 5. Priority details if any 	<p>Basic filing requirement (s) to secure a filing date:</p> <ol style="list-style-type: none"> 1.Specification 2.Drawing(s) if any 3.Inventor's details 4.Applicant's details 5.Priority details if any 	<p>Basic filing requirement (s) to secure a filing date:</p> <ol style="list-style-type: none"> 1.Clear print(s) for black and white mark or colour mark 2.List of goods and services 3.Statutory Declaration from the applicant – to affirm that they are the bonafide proprietors of the respective mark 4. Priority details if any <p>Upon filed applicant is allowed to insert "TM" symbol to the trade mark as filed.</p>	<p>Basic filing requirement (s) to secure a filing date:</p> <ol style="list-style-type: none"> 1.Representations of article 2.Author's details 3.Applicant's details 4.Statement of novelty 5.Priority details
<p>Major Prosecution Events</p>	<p>Request for Examination³ – 24 months from the date</p>	<p>Request for Examination – 24 months from the</p>	<p>Search & Examination – 12 to 18 months</p>	<p>Examination and Publication of selected view(s) of</p>

	<p>of filing</p> <p>Payment of Grant Fee – within 3 months from the date of allowance</p> <p>Renewal of Patents - annually</p>	<p>date of filing</p> <p>Payment of Grant Fee – within 3 months from the date of allowance</p> <p>Renewal of Patents – 10 to 15 years from filing date dependant on the presenting evidence on industrial use</p>	<p>from date of filing</p> <p>Advertisement of trade mark</p> <p>Certification of trade mark</p> <p>Renewal – 10 years from date of application</p>	<p>the article</p>
Average time for grant	24 to 36 months after filing of Request for Examination	24 to 36 months after filing of Request for Examination	12 to 36 months from Search & Examination	12 to 24 months
Term of Protection ⁴	15 years from date of grant or 20 years from date of filing whichever is longer	15 years from date of grant or 20 years from date of filing whichever is longer	10 years from date of registration	5 years from date of application, extendable to a period of 15 years.
			Owner is allowed to insert “R” symbol to the registered trade	Owner shall have the rights to assign and transmit the

			<p>mark</p> <p>Owner shall exercise control over the use of the trade mark in relation to the goods and services</p>	<p>design of article and said registered design is considered as personal property.</p>
<p>Example</p>	<p>First fountain pen received a patent grant in 1867:</p>  <p>At present there are at least 2,171 inventions in relation to fountain pen filed worldwide.</p>	<p>For instance, a fountain pen comprises a rod-like member whereby one end of the rod-like member is formed with a nib for which the ink will flow through.</p> <p>Inventor A has decided to improve this version of fountain pen whereby he has formed a nib on both ends of the rod-like member of the pen.</p>	 	 <p>The scope of protection therefore covers the ornamental design of the chair as shown above.</p>

		Such improvement will not qualify for a patent protection because of obviousness – to add another nib however it will be eligible for Utility Innovation protection as it is considered as new and has industrial applicability.		
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1 Prior art – any form of disclosure/everything disclosed or made to be known to the public anywhere in the world

2 Plant varieties – protected under the Plant Variety Act in Malaysia

3 Request for Examination – Examiner will conduct further searches, and assess patentability

4 During the term of protection – owner is allowed to exploit, assign or transmit the patent and to conclude licence contracts; whereby exploitation of a patent invention defines making, importing, offering for sale, selling or using the product and stocking such product.

5 Integrated part of a circuit is protected under Layout-Designs of Integrated Circuits Act 2000

6 if priority is claimed, the date of the first application is considered as the “effective filing date” for subsequent filings within the stipulated claiming priority period