

## **MALAYSIA PATENTS (AMENDMENT) REGULATIONS 2011** **Amendment To the Malaysian Patent Regulations**

The Malaysian Patents Office has made several amendments to the Patent Regulations 1986 with effect from 15 February 2011 via the Malaysian Patents (Amendments) Regulations 2011. These amendments and regulations were posted online on their official website.

The primary objective of the amendments is to expedite the patent examination process to reduce the patent pendency period. The present ordinary examination procedure will be improved, and a new option for an Expedited Examination Procedure is introduced.

The Expedited Examination Procedure will be provided by the addition of Regulation 27E. This option allows a patent application to be granted within 20 months from the date of priority/filing, assuming no adverse reports are issued.

The improved ordinary examination procedure will reduce the pendency period from the current 3-4 year period to 26 months (2 years 2 months), assuming no adverse reports are issued.

In addition, all official fees for all patent matters have also been revised.

E-filing services are now currently available for the online filing of patents, trademarks, industrial designs and geographical indications at the Malaysian IP Office.

Kindly take note that we anticipate regular updates from the Malaysian Patents Office on the new implementation of the amended Regulations. We will continue to keep you posted, and recommend that you review our website for updates on a regular basis.

The amendments to the Patent Regulation and details of the ordinary and expedited examination procedures are detailed below:

### **SUMMARY OF AMENDMENTS TO THE PATENT REGULATIONS**

#### ***i) Request for Substantive Examination***

- Previously made within 24 months from the filing date of the application
- New regulations require the request to be filed within **18 months** from the priority/filing date of the application

#### ***ii) Introduction of Expedited Examination***

- New regulations for expedited examination are provided by the addition of Regulation 27E
- This allows for the expedited examination of a patent, resulting in a patent application to be granted within 20 months from the date of priority/filing (assuming no adverse reports are issued)
- In order to file for expedited examination, the Applicant must justify its grounds for requesting that the patent be processed under the expedited examination process. This is to be done by way of a Statutory Declaration and Statement of Grounds. The justifications deemed acceptable by the Registrar are:-
  - It is in the national/public interest
  - There are infringement proceedings taking place or evidence showing potential infringement with regards the patent being applied
  - The Applicant has already commercialized the invention or plan to commercialize the invention within two years from the filing date of a request for expedited examination

- Grant of a patent is a condition to obtain monetary benefits from the Government or institutions recognized by the Registrar
- The invention relates to green technologies that will enhance the quality of the environment or conservation of energy resources
- Other reasonable grounds which support the request
- New procedures, documents and official fees are applicable for the expedited examination route, which are further detailed below

**iii) Timeline to submit a response to adverse examination reports**

- Previously to be made within 3 months from the date of mailing the report
- New regulations require that for ordinary substantive examination, responses are to be made within 2 months from the date of mailing the report
- Under the new expedited examination, responses must be made within 3 weeks from the date of mailing the report

**iv) Submission of the 'Statement Justifying the Applicant's Right to Apply'**

- This document was not a formal requirement under the preliminary examination
- Under the new regulations, the Statement shall be a formal requirement, and shall be submitted together with the payment of an official fee

**v) Introduction of E-Filing Services**

- The new regulations also contain provisions for e-filing services at the Intellectual Property Corporation of Malaysia
- In accordance with this, there is a discounted official fee applicable for documents that are filed using the e-filing system

**vi) Revision of All Official Fees**

- All the official fees for all patent matters have now been revised upwards

## **REVISION OF OFFICIAL FEES**

The following table highlights the revision in official fees for all patent-related matters:-

Matter	Form	Old Manual Fee (RM)	New Fee		Diff (Manual) (RM)
			E-Filing Fee (RM)	Manual Filing Fee (RM)	
Request for grant of patent	Form 1	200	260	290	90
1 <sup>st</sup> 10 claims		-	-	-	
Every additional claim		10	20	20	10
Declaration of withdrawal of application	Form 2	-	-	-	-
Entering national phase	Form 2A				
1 <sup>st</sup> 10 claims		200	260	290	90
Every additional claim		10	20	20	10
Request for reinstatement under section 78OA	Form 2A	500 per month of delay	650 per month of delay	690 per month of delay	190
Request for substantive examination	Form 5	700	950	1100	400
Request for modified substantive examination	Form 5A	450	600	640	190
Request for deferment of filing of request for examination or provision of information	Form 5B	-	-	-	-
Request for certified copies or extracts	Form 5C	50	70	80	30
Request to amend register	Form 5D	50	70	80	30
Request for reinstatement of lapsed patent	Form 5E	100	130	140	40
Request for licence to exploit patented invention	Form 5F	-	-	-	-
Request to convert application for patent into application for certificate of utility innovation or vice versa	Form 5G	200	260	290	90
Request for approval of expedited examination	Form 5H	N/A	200	250	250
Request for expedited examination	Form 5I	N/A	2000	2200	2200
Application for recording of assignment or transmission	Form 6	100	130	140	40
Application for entry in Register that any person may obtain a licence	Form 7	50	70	80	30
Application for cancellation of entry in Register that any person may obtain a licence	Form 8	50	70	80	30
Application for recording of particulars of licence contract in Register	Form 9	100	130	140	40

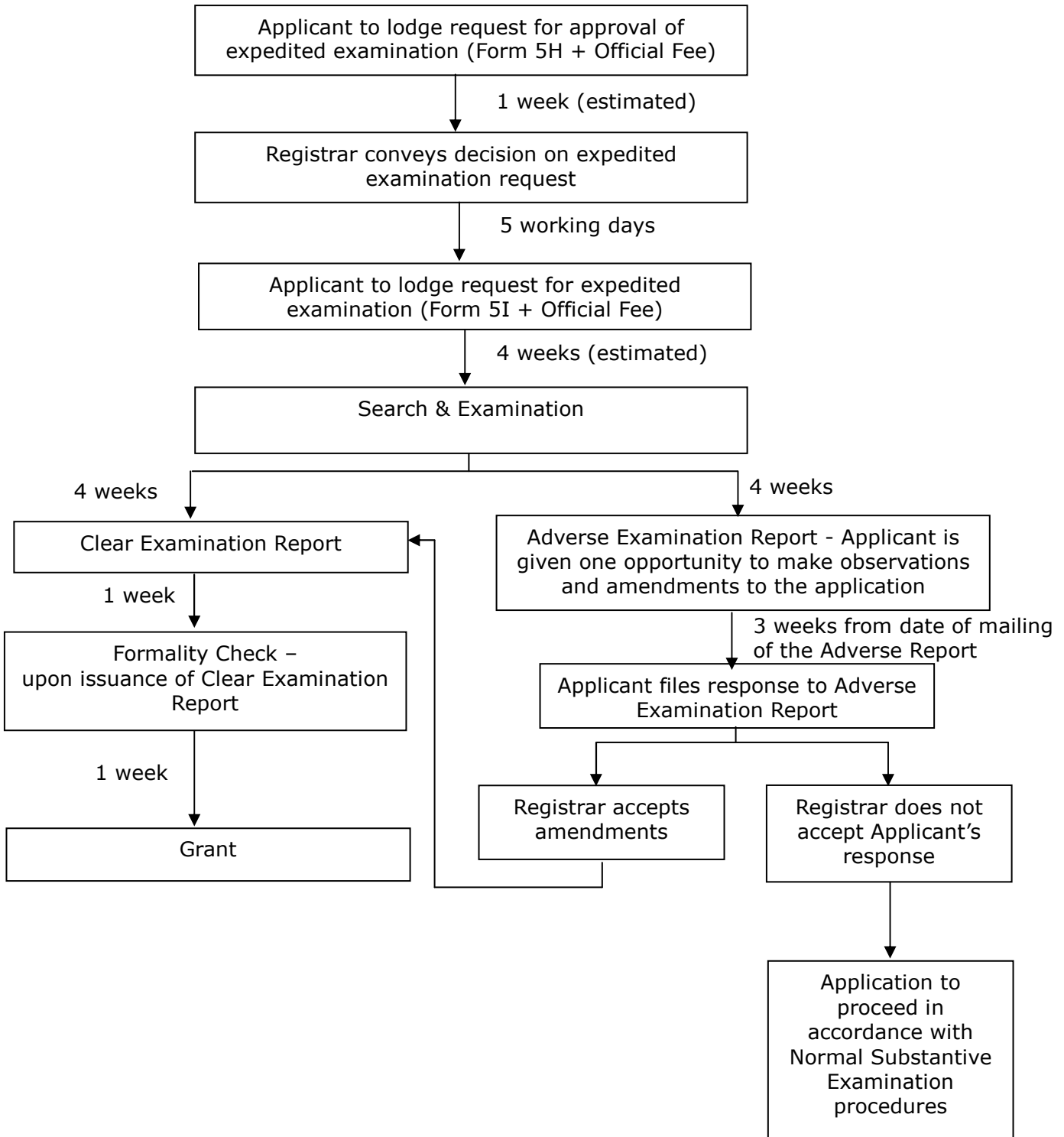
Matter	Form	Old Manual Fee (RM)	New Fee		Diff (Manual) (RM)
			E-Filing Fee (RM)	Manual Filing Fee (RM)	
Request for recording expiry or termination of licence contract in Register	Form 10	75	100	110	35
Application for compulsory licence	Form 11	75	100	110	35
Request for amendment of decision	Form 12	75	100	110	35
Request for cancellation of compulsory licence	Form 13	75	100	110	35
Application for grant of certificate of utility innovation	Form 14	100	130	140	40
Application to extend term of certificate for utility innovation	Form 15	100	130	140	40
Request to amend application for grant of patent	Form 16	50	70	80	30
Request to amend patent	Form 16A	50	70	80	30
Appointment or change of patent agent	Form 17	-	70	80	80
Application for registration of patent agent	Form 18	2000	2600	2670	670
Application for registration as candidate for examination	Form 18A	100	130	140	40
Application to re-sit examination	Form 18B	100	130	140	40
Application for renewal of registration of patent agent	Form 19	400	550	590	190
Furnishment of address for service	Form 20	100	130	140	40
Request for extension of time	Form 21	200	260	290	90
Statement justifying the applicant's right to the patent/certificate	Form 22	N/A	70	80	80
Copy of patent		30	40	40	10
Copy of search report		20	30	30	10
Examination of Register		10 per hour	15 per hour	15 per hour	5
Certified copies or extract from Register		10 per page	15 per page	15 per page	5
Copy or extract from Register		2 per page	3 per page	3 per page	1
Fee for public inspection of information relating to patent application		10 per hour	30 per hour	30 per hour	20
Certified copies or extract of any information:- - for first five pages - for every additional page		100 2	100 3	100 3	- 1

Matter	Form	Old Manual Fee (RM)	New Fee		Diff (Manual) (RM)
			E-Filing Fee (RM)	Manual Filing Fee (RM)	
Annual fee for patent					
- second year after grant		200	260	290	90
- third year after grant		250	330	360	110
- fourth year after grant		300	390	420	120
- fifth year after grant		350	460	490	140
- sixth year after grant		400	520	560	160
- seventh year after grant		450	600	640	190
- eighth year after grant		500	650	690	190
- ninth year after grant		550	720	760	210
- tenth year after grant		600	780	820	220
- eleventh year after grant		650	850	890	240
- twelfth year after grant		700	900	940	240
- thirteenth year after grant		800	1050	1100	300
- fourteenth year after grant		900	1200	1250	350
- fifteenth year after grant		1000	1300	1350	350
- sixteenth year after grant		1200	1600	1660	460
- seventeenth year after grant		1400	1850	1900	500
- eighteenth year after grant		1600	2100	2200	600
- nineteenth year after grant		1800	2400	2500	700
- twentieth year after grant		2000	2600	2700	700
Surcharge for reinstatement		100% of fee for year concerned			-
Surrender of compulsory licence		60	80	90	30
Surrender of patent		60	80	90	30
Annual fee for certificate for utility innovation:-					
- third year after grant		120	160	170	50
- fourth year after grant		160	210	240	80
- fifth year after grant		160	210	240	80
- sixth year after grant		200	260	290	90
- seventh year after grant		200	260	290	90
- eighth year after grant		240	320	350	110
- ninth year after grant		240	320	350	110
- tenth year after grant		280	370	400	120
- eleventh year after grant		400	520	560	160
- twelfth year after grant		600	780	820	220
- thirteenth year after grant		700	910	950	250
- fourteenth year after grant		800	1050	1100	300
- fifteenth year after grant		1000	1300	1350	350
- sixteenth year after grant		1100	1450	1500	400
- seventeenth year after grant		1200	1600	1650	450
- eighteenth year after grant		1300	1700	1750	450
- nineteenth year after grant		1400	1850	1900	500
- twentieth year after grant		1500	1950	2000	500
Holding of hearing		100	130	140	40
Certificate of grant of patent		150	Nil	Nil	-150
Certificate for a utility innovation		100	Nil	Nil	-100
Examination fee		100 per subject	130 per subject	140 per subject	40

Matter	Form	Old Manual Fee (RM)	New Fee		Diff (Manual) (RM)
			E-Filing Fee (RM)	Manual Filing Fee (RM)	
Appeal against examination results		200 per subject	260 per subject	290 per subject	90
Extension of time for every month of part of a month		50 per month	70 per month	80 per month	30
Surcharge for late payment of annual fee		100% of fee for year concerned			-
Public search through computer		20 per hour	30 per hour	30 per hour	10
Computer print-out (bibliography data per page)		5	10	10	5
Permitted information (upon request):- - for less than 10 pages - for the subsequent pages		100 5	130 7	140 7	40 2
Fee for preparing international application		2 per page	3 per page	3 per page	1
Transmittal fee under Rules 14 & 19 of the Regulations under the PCT - for the first 30 sheets - for each sheet in excess of 30 sheets (per sheet)		375 45	500 60	550 70	175 25
Fee for the late furnishing of transliteration for the purposes of international search		25% of the international filing fee prescribed under the Treaty			-
Fee for the late furnishing of transliteration for the purposes of international publication		25% of the international filing fee prescribed under the Treaty			-
Late payment fee under Rule 16 bis. 2 of the Regulation under Treaty		50% of the amount of unpaid fees or an amount equal to the transmittal fee			-
Fee for complying with national requirement in response to the invitation		100	130	140	40

## **EXPEDITED PATENT EXAMINATION PROCEDURE - FLOWCHART**

After 18 months from the priority date/filing date:-



**TOTAL TIME FROM FILING DATE OF THE APPLICATION TO GRANT - 20 MONTHS**  
 (assuming that the application complies with all requirements, and that no adverse reports are raised)

## **EXPEDITED PATENT EXAMINATION PROCEDURE - DETAILS**

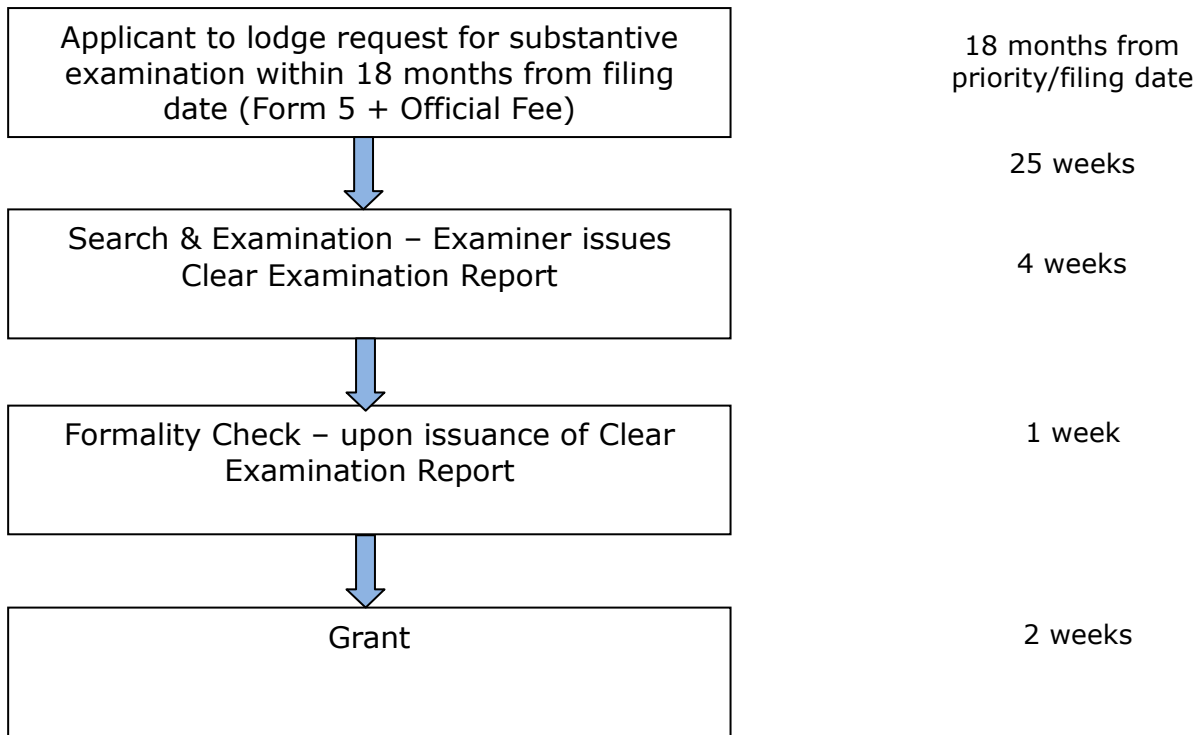
After 18 months from the priority/filing date:

	<b>PROCESS</b>	<b>TIMELINE</b>	<b>DETAILS</b>
1	<p>Applicant to lodge request for approval of Expedited Examination (Form 5H &amp; fee)</p> <p><b><u>Official fees:</u></b>                      Online filing: RM200                      Manual filing: RM250</p>	18 months from priority/filing date	<p>Request for Approval of Expedited Examination can be filed together with or after filing the Request for Substantive Examination (Form 5)</p> <p>Can be requested after 18 months from priority/filing date</p> <p>Request to be accompanied by a Statutory Declaration and Grounds of Statement</p> <p>Examples of Grounds of Statement:</p> <ul style="list-style-type: none"> <li>- National/Public interest</li> <li>- Infringement proceedings</li> <li>- Commercialization</li> <li>- To obtain fund from the government or recognized institutions</li> <li>- Green technologies</li> <li>- Any other reasonable grounds</li> </ul>
2	Registrar's decision on Expedited Examination	1 week	Registrar will evaluate the Request and Grounds of Statement given by the applicant
3	Applicant to lodge request for expedited examination (Form 5I & fee)	1 week	Applicant to file Request for Expedited Examination within 5 days from the Registrar's Notification
4	Search and Examination – Examiner issues Clear Report	4 weeks	<p>Examiner will conduct the search and examination to evaluate patentability immediately after receiving the request.</p> <p>Search and Examination Clear Report to be completed within 4 weeks from the conclusion of the Search and Examination</p>

PROCESS		TIMELINE	DETAILS
5	Formality check – upon issuance of Clear Report	1 week	<p>The Registrar will issue the Examiner's Report to the applicant</p> <p>The applicant is given 1 week to check the information on the first page (bibliography) of the patent publication</p>
6	Grant	1 week	<p>The Registrar issues the Certificate of Grant (within 1 week)</p> <p>Total pendency from filing the Request of Approval of Expedited Examination to grant: 8 weeks (2 months)</p> <p><i>Note: 8 weeks is assuming that no adverse report is issued by the Registrar</i></p>
<b>TOTAL PENDENCY</b>		<b>20 months</b>	

**IMPROVED ORDINARY PATENT EXAMINATION PROCEDURE - FLOWCHART**

After 18 months from the priority date/filing date:-



**TOTAL TIME FROM FILING DATE OF THE APPLICATION TO GRANT - 26 MONTHS**  
(assuming that the application complies with all requirements, and that no adverse reports are raised)

## **IMPROVED ORDINARY PATENT EXAMINATION PROCEDURE - DETAILS**

After 18 months from the filing date:

<b>PROCESS</b>	<b>TIMELINE</b>	<b>DETAILS</b>
1 Applicant to lodge Request for Substantive Examination within 18 months from the filing date (Form 5 & fee)  <b><u>Official fees:</u></b> Online filing: RM950 Manual filing: RM1100	18 months from filing date	To file Form 5 within 18 months from filing date
2 Search and Examination – Examiner issues Clear Report	25 weeks to conduct Search and Examination  4 weeks to issue Clear Report upon conclusion of Search and Examination	Examiner will conduct the search and examination to evaluate patentability within 25 weeks from filing the Request for Substantive Examination  Search and Examination Clear Report to be completed within 4 weeks from the conclusion of the Search and Examination
3 Formality check – upon issuance of Clear Report	1 week	The Registrar will issue the Examiner's Report to the applicant  The applicant is given 1 week to check the information on the first page (bibliography) of the patent publication.
4 Grant	2 weeks	The Registrar issues the Certificate of Grant (within 2 weeks) Total pendency from filing the Request of Approval of Expedited Examination to grant: 32 weeks (8 months)  <i>Note: 32 weeks is assuming that no adverse report is issued by the Registrar</i>
<b>TOTAL PENDENCY</b>	<b>26 months</b>	