

MALAYSIA

An Introduction to Patent, Trademark & Industrial Design



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Malaysia-Patents, Trademarks & Industrial Designs

INTRODUCTION

Malaysia's Intellectual Property (IP) laws have been declared to be in conformance with the requirements of the WTO's TRIPs Agreement. This followed the progressive introduction of new laws, notably the Industrial Designs Act 1996, Geographical Indications Act 2000 and Layout-Designs of Integrated Circuits Act 2000, coupled with amendments to its existing laws, for example in regard to patent term and the protection of well-known marks.

The modern and comprehensive set of Malaysian IP laws is backed up by a determination on the part of the Government to promote the registration and enforcement of intellectual property. These aims are greatly assisted by an active and strengthened Enforcement Division that regularly investigates and raids shops and factories harbouring infringing and counterfeit articles, as well as a well-established court system that is largely modeled on the world-respected British system.

In March 2003, the Patent, Trademark and Industrial Design Registries and Copyright Unit were brought under a newly-formed body known as the Malaysian Intellectual Property Corporation (MIPC, or PHIM in the national language acronym). MIPC's website is at www.mipc.gov.my. MIPC is fully autonomous in its administration and finance. Within months of its formation, MIPC had recruited and started training substantial numbers of new staff at all levels, including additional patent and trademark examiners.

A sea-change occurred that has seen dramatic increases in the numbers of applications being examined and registered, in addition to a much more responsive and customer-oriented organization. Regular dialogue sessions are held between MIPC and local IP professionals and rights owners to discuss and resolve practice issues. These dialogue sessions have led to significant and beneficial changes in official practice.

The Government and MIPC have also taken up the challenge of promoting greater awareness of the importance of IP among the Malaysian business and trading community, for example, by holding nationwide roadshows and even extending to television advertising of the value of patenting new inventions. Continuing efforts on all sides in developing the Malaysian IP system augur well for both local and foreign interests.

In 2005, MIPC adopted the new brand name of MyIPO,

Malaysian Patent System

INTRODUCTION

Patent protection in Malaysia is governed by the Patents Act 1983 which came into force on 1st October 1986. The earlier system of re-registering United Kingdom patents has been repealed.

The substantive patentability requirements of novelty, inventive step and industrial application broadly follow those which apply under the European Patent Convention. One notable exception, however, is the provision of a grace period under which any disclosure originating from the applicant and occurring no more than one year before the Malaysian filing date, is disregarded for novelty purposes.

Malaysia is a member of the Paris Convention and the World Trade Organization. Malaysia plans to accede to the Patent Cooperation Treaty (PCT) and the necessary amendments to the Patents Act have already been passed by Parliament. For the moment, however, patent protection is obtainable only by filing a direct national application with Malaysia's Patent Registration Office.

FILING REQUIREMENTS

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 in English 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) state of incorporation/nationality of the applicant;
- f) an abstract of the invention;

- g) the serial number of any priority application and the symbol of the International Patent Classification (IPC) allocated to it (if available);
- 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.

These additional items e) through j) may, however, be filed later during formality and substantive examination. Only the provision of the priority serial number has an early time limit; this is three months from the Malaysian filing date. There is no requirement or provision for the filing of an assignment from inventor to applicant.

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

Malaysian patent applications are not published. Publication occurs only upon grant. The official file is kept secret during the pendency of an application. Only limited bibliographic information is available to third parties prior to grant. The position on publication will change when the amendments to the Patents Act relating to Malaysia joining the PCT are brought into force. At that time, the details of the application, including the specification and any amendments made to it will normally be made available for public inspection after 18 months from the priority date.

MAINTENANCE FEES

There are no maintenance fees payable on pending Malaysian patent applications.

EXAMINATION

A request for substantive examination must be filed within two years of the Malaysian filing date. There are two options: normal substantive examination and modified substantive examination. The latter is intended to be a simpler and cheaper option, but in reality it seems this is often not the case.

Under normal substantive examination, the Patent Registration Office 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 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; the serial numbers of any patents granted on those applications; and the available search and examination reports of those applications including such reports prepared under the PCT. Certified English translations are required for any documents not in English.

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, but there is no examination for inventive step and the number of formal requirements checked is supposed to be less than under normal examination. In practice, however, it appears that applications are examined to essentially the same extent under both types of examination.

DEFERMENT OF EXAMINATION

The filing of a request for normal substantive examination may be deferred by up to one year on the ground that the supporting information and documents are not yet available. The filing of a request for modified substantive examination may be deferred by up to two years on the ground that the foreign patent on which the examination will be based has not yet been granted or the required certified copy is not yet available. Deferment must be requested within two years of the Malaysian filing date.

PROSECUTION AND GRANT PROCEDURE

Malaysian patent applications are examined generally in filing date order. Filing a request for examination early will not necessarily result in earlier examination. However, applications undergoing modified substantive examination are processed in a separate stream from those subject to normal examination, and may be examined and granted earlier. 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 three months and this can be extended if necessary. Upon allowance, the applicant must pay an official fee in order to have the patent granted.

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.

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 the three-month response term of the examination report containing that objection. A voluntary divisional application, on the other hand, may only be filed up to the end of the three-month response term of the first examination report received.

EXTENSIONS OF TIME

The 12-month convention priority period and (apart from deferment) the term for requesting examination are generally not extendable. Most other time limits can be extended at least once, 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.

DURATION AND RENEWAL FEES

The duration of a Malaysian patent depends on its filing date. If the filing date is prior to 1st August 2001 and the application was pending or granted and in force as of the 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 1st August 2001, the duration is 20 years calculated from the filing date.

An annual renewal fee must be paid in order to keep the patent in force and 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. 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.

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.

UTILITY INNOVATIONS

The Malaysian patent system includes provision for the grant of utility innovation certificates. A utility innovation must be new and industrially applicable, but there is no requirement for an inventive step. The term of protection, the filing requirements and prosecution procedure are basically the same as for patents. A utility innovation certificate may only have one claim and renewal beyond 10 and 15 years from the filing date is dependent on presenting evidence of commercial or industrial use in Malaysia or a satisfactory explanation of non-use.

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 products 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) 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
- 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.

Prepared By: Dave A. Wyatt

Malaysian Trademark System

Trademark protection in Malaysia is governed by the Trademarks Act 1976 and the Trademarks Regulations 1997.

Malaysia is a signatory to the Paris Convention and also a signatory to the TRIPs Agreement.

REGISTRABLE TRADEMARKS

Section 3 of the Trademarks Act 1976 gives a wide definition of the word “mark” to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

The same Section also gives a definition to the word “trademark” which is a mark that is used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right to the trademark.

From the above, it can be seen that there is subtle distinction between the two definitions. A mark only becomes a trademark if it is used (or proposed to be used) in a business or trade for goods or services, and the mark that is used must be for the purpose of indicating a connection between the goods and the proprietor of the mark.

What marks are registrable as trademarks? The answer is found in Section 10 of the Act which provides that the mark must satisfy one of the following essential particulars:

- the name of an individual, company or firm represented in a special or particular manner
- the signature of the Applicant for registration
- an invented word(s)
- a word that does not have any direct reference to the character or quality of the goods or services and is not in its ordinary meaning a geographical name or surname
- any other distinctive mark

Note that only one of these essential particulars needs to be fulfilled in order to have the mark registered. Nevertheless, it must be noted that Malaysia still does not have any provision for registration of non visually perceptible marks such as sound and smell marks.

FLING REQUIREMENTS

Minimum documentation requirements for filing a trademark application in Malaysia are:

- a) One clear print for a black-and-white mark; 15 prints for a colour mark.
- b) A list of goods or services. All terms used to specify the goods or services should closely follow the Nice International Classification.
- c) The full name and address of the applicant, body description of company, country/state of incorporation.
- d) A Statutory Declaration from the applicant affirming that they are the bona fide proprietors of the mark and that the application is made in good faith. The declaration has to be signed before a Commissioner for Oaths (for local declarant) or before a Notary Public (if signed abroad).
- e) For marks that contain non-English words, a certified transliteration and translation will be required.
- f) If convention priority is claimed, a certified copy of the priority application is required with a certified English translation where documents are not in English.

EXAMINATION OF MARKS

Once a trademark application is filed, it will be checked to see whether the mark applied for satisfies the requirements of registration as provided in the Trademarks Act 1976. This procedure is called “Search and Examination” and under normal circumstances is usually completed between 12 - 18 months from the date of filing.

When the mark is examined and if there are no objections issued by the Examining Officer, the mark is allowed to proceed to the next stage called the advertisement stage. The mark would then be registered subject to any Opposition following its publication in the Government Gazette. In most circumstances, marks are allowed to proceed when any one of the essential particulars referred to above is fulfilled and there were no conflicts between the mark applied for and any earlier registered marks.

On the other hand, if the mark does not satisfy one of the 5 essential particulars enumerated above or if the Examining Officer finds there is a conflict with a prior registration or application, an initial objection letter will be issued to the Applicant setting out the grounds of objection. The Applicant is then invited to respond to the objection letter within two months from the date of the objection letter. It is possible to request for an extension of time within which to reply upon the payment of extension fees, but the Registrar normally only allows up to three requests for extensions.

In addition to the above, other grounds of refusal include:

- a) that the use of the mark or part of the mark is likely to deceive or cause confusion to the public or would be contrary to law
- b) the mark contains or comprises any scandalous or offensive matter
- c) that the mark is identical with or so nearly resembles a mark which is well known in Malaysia for the same goods or services of another proprietor
- d) that the mark contains or consists of a geographical indication with respect to the goods not originating in the territory indicated
- e) that the mark is for wine or spirits and contains or consists of a geographical indication identifying wines or spirits not originating in the place indicated by the geographical indication in question.

Other types of objections are minimal in nature such as requesting for amendments to limit the specification of goods, request for clarification of certain aspects of the marks applied for or a request for a translation of the mark if it was filed in a language other than the National or English languages.

In replying to any objections raised by the Examining Officer, the normal practice would be for the Applicant or the Applicant's agent to file a considered reply in writing, more commonly known as "submissions". If the mark is considered to be not distinctive, the Applicant may adduce evidence of use of the mark by way of filing a Statutory Declaration showing that the mark has become distinctive in usage. In other circumstances, evidence of registration in jurisdictions similar to Malaysia such as the United Kingdom, Singapore and/or Australia would be helpful, but are not legally binding on the Registrar.

With regard to conflicting marks, the Applicant must show that the mark applied for may be distinguished from earlier registrations or prior applications such that there is no or little likelihood of confusion and/or deception between the two marks arising from the public.

One of two things may happen when a submission is received from the Applicant or his agent. The mark will either be allowed to the advertisement stage or the objections will be maintained. If the latter happens, the Applicant may either file a second round of submission or request for a Hearing before the Registrar. If the second submission is rejected, the mark is automatically refused. However, if the Hearing route is chosen by the Applicant and the objections are still maintained after the Hearing is conducted, the Applicant has a right of an appeal to the Court.

CERTIFICATION TRADEMARKS

A Certification trademark is a special trademark, different from other trademarks, in that the Registered Proprietor must not trade in the goods himself. As a matter of fact, certification marks are filed for by organizations, associations, guilds and other institutions who have definite rules and standards governing the use of such marks. Certification relates to source, origin, material used, mode of manufacture, quality and similar traits.

Certification trademarks must basically be capable of distinguishing the goods or services so certified from non-certified goods or services. An application for a certification mark requires a set of the rules governing use of the mark.

RENEWAL

A trademark application once registered is valid for 10 years from the date of application. It may be renewed every ten years thereafter with payment of a renewal fee. Where the renewal date lapses, an application for late renewal may be filed for with payment of an additional fee. The registration will accordingly be renewed without removing the mark from the Register.

If no timely renewal application is made by the expiration date, the trademark is gazetted and thereafter will be removed from the Register for non-payment of the renewal fee. Once removed, restoration may be allowed at the discretion of the Registrar subject to a restoration fee as well as a penalty fee within one year from the date of expiration.

RECTIFICATION OF THE REGISTER

Rectification of an entry in the Register may be made by the registered proprietor or by an aggrieved person. An application for rectification may be made in respect of:

1. a non-insertion in or omission from the register of any entry;
2. an entry made in the Register without sufficient cause;
3. any entry wrongfully remaining on the Register; for instance a mark the use of which is likely to deceive or cause confusion to the public or would be contrary to law; or one which contains offensive or scandalous matter.
4. any error or defect in any entry in the register.

A registered trademark may also be removed from the Register by an aggrieved person on the ground that the mark was registered without any genuine intention to use the said mark and there has been no such use; or there has been no bona fide use of the mark in Malaysia for at least three years prior to one month before the date of application to remove it.

Rectification proceedings can only be instituted in the High Court.

REGISTERED USER

A registered proprietor who allows any person to use his trademark, by lawful contract on all or any of the goods or services the mark is registered for, must apply for that person to be entered on the Register as a registered user whether with or without any conditions or restrictions. However, it is a condition of registration that the proprietor shall retain and exercise control over the use of the trademark and over the quality of the goods or services provided by the registered user in connection with that trademark.

The permitted use of a registered trademark by a registered user shall be deemed to be use by the registered proprietor, even if he never uses the mark himself. And thus it insulates the said proprietor from any action of cancellation of the mark from the Register on the ground of his non-use.

The registration of a person as registered user may be:

1. varied by the Registrar on the application in the prescribed manner of the registered proprietor with respect to the goods or services for which or with respect to any conditions or restrictions subject to which the registration has effect;
2. extended by the Registrar on the application in writing of the registered proprietor for such period as the Registrar thinks fit;
3. cancelled by the Registrar on the application of the registered proprietor.

The Registrar may at any time cancel the registration of a person as registered user of a trademark for any goods or services in respect of which the mark is no longer registered.

INFRINGEMENT OF REGISTERED MARKS

Upon registration of the trademark, the Registered Proprietor is granted the exclusive use of the trademark in relation to the registered goods or services. The Malaysian Trademarks Act 1976 provides for two types of infringement, which are:

- the unauthorized use of a mark which is identical and/or highly similar to the registered mark in respect of the same goods or services such that it will likely deceive and/or confuse the public; and
- the unauthorized use of the mark which is identical and/or highly similar to the registered mark such that it imports a reference to the registered proprietor.

From the above, it can be seen that the Registered Proprietor may institute a civil legal action against any party that is infringing their trademark.

As far as unregistered trademark rights are concerned, the law allows a cause of action called passing off (or may be referred to as unfair competition) if there is a party that is misappropriating the unregistered mark. The burden of proof for a trademark infringement action is easier to prove than burden for a passing off action.

For trademark infringement, the necessary ingredients would be for the Registered Proprietor to show the following:

- a) The trademark is registered;
- b) The trademark, whether identical or confusingly similar, has been used by the offender as a trademark;
- c) That the offender's use of the trademark is on goods registered.

As for passing off, the burden of proving the said cause of action is more tedious. It involves showing substantial evidence of use of the trademark in order to prove reputation and goodwill of the business in connection with the trademark used.

The usual reliefs prayed in an infringement action are:

- a) an injunction restraining further infringement of the registered mark
- b) an order for delivery up of products bearing the offending mark for destruction
- c) damages in respect of past infringement, or at the Plaintiff's option, an account of profits
- d) a Declaration that the Defendant has infringed.

It is to be noted that under Section 70B of the Trademarks Act 1976, a Proprietor of a well known trademark is entitled to protection and restrain by injunction, the use in Malaysia in the course of trade and without the Proprietor's consent, of a mark which is identical or where an essential part of it is identical or nearly resembles the well known mark in respect of the same goods or services, where the use is likely to deceive or cause confusion. Further, a well known trademark will be protected whether or not its Proprietor carries on business or has any goodwill in Malaysia. Note however, that any bona fide use of a trademark that is identical to or incorporating a well known mark before the commencement of this section, which is 1 August 2001, will not be affected by this provision.

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Malaysian Industrial Design System

INTRODUCTION

Industrial design protection in Malaysia is governed by the Industrial Designs Act 1996 which entered into force on 1st 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 1st 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; with said 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 designs 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 separate legislation)
- 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 visual external 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

Malaysian industrial design law has a local novelty standard, in that the design must not have been disclosed to the public anywhere in Malaysia 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 grant, is also novelty defeating.

However, public disclosure of the design in Malaysia six months prior to the filing date of an industrial design application shall not be prejudicial to the novelty of the design, provided the disclosure was made:

- in an official or officially recognized exhibition, or
- as a result of disclosure 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 which are common variants used in the trade”.

The applicant is required to include a “statement of novelty” in the registered design application. As the monopoly protection is for the external visual appearance of the entire article, the usual statement of novelty is in the form

“the novelty resides in the features of shape or configuration of the article as shown in the drawings” or, “the novelty resides in the features of pattern or ornament of the article as shown in the drawings”.

If the applicant wishes to draw the attention of the Court 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.

MULTIPLE INDUSTRIAL DESIGN APPLICATIONS

Multiple industrial design applications are 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 multiple design applications, there is a reduction of the official filing and renewal fees by 50% for designs other than the first design. Each design is protected separately.

INDUSTRIAL DESIGN APPLICATIONS FOR SETS OF ARTICLES

It is also possible to file a single industrial design application for a “set of articles” in Malaysia.

“Set of articles” is taken to mean 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.

INDUSTRIAL DESIGN FILING REQUIREMENTS

The minimum filing requirements for obtaining a filing date 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) Six sets of representations of the design (drawings or photographs; each representation not exceeding 12.5cm by 9cm)
- d) Name of article and statement of novelty
- e) Details of any priority claim i.e. at least the country and filing date.

Additional formal requirements that can be filed after the filing date of the application are:

- f) Full name and address of the author
- g) Information on how the applicant has derived the right to the design from the author (normally by way of assignment, employment or other agreement)
- h) International Design Classification
- i) Serial number of the priority application
- j) Copy and certified English translation (if necessary) of the priority document.

However, additional costs will be incurred in filing any of items (f), (h) or (i) late, due to the need to amend the application form.

INDUSTRIAL DESIGN 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 representations. The application is first assigned a design application number and a filing date by the Malaysian Industrial Design Registry.

The application documents and drawings are then checked for compliance with the formality 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.

Once the application is in order, a registration certificate is normally issued between seven months to one year of filing the application. The application is then published in the Government Gazette. There are no provisions for opposition proceedings.

TERM OF PROTECTION 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, the Industrial Design Registry uses the priority date as the base date for the calculation of the registration term and date of renewal payments. The application can be renewed for two further five year periods, giving a maximum term of 15 years.

The renewal fee may be paid up to 6 months prior to the expiry date of the current period of registration. It is also possible to make a late payment, not later than 6 months after the expiry date, subject to a late payment penalty fee.

TERM OF PROTECTION AND RENEWAL OF UNITED KINGDOM REGISTERED DESIGNS IN MALAYSIA

Any UK registered design granted and in force prior to 1st 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.

The Malaysian Industrial Design Registry has determined that UK registered designs will only be allowed to be renewed for up to a maximum term of 15 years, consistent with that available to local registrations filed under Malaysia's design law.

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

- 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.

There is no provisional protection for pending Malaysian industrial design applications.

Infringement proceedings must be taken by the owner of the design within five years of the act(s) of infringement.

REVOCAION

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/novel
- registration of the design was procured by unlawful means.

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

Prepared By: Oon Yen Yen

Please note that the information contained in this booklet is presented in good faith for general information and does not constitute legal advice. Kindly contact us should you have any specific questions. Statement of the law as at July 1, 2005.