

Options for Expediting Patent Prosecution in Malaysia

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Intellectual Property (IP) is increasingly becoming a crucial catalyst of business growth in globalised and developing economies such as Malaysia. We have seen a steady growth of patent applications filed in Malaysia in the last decade which is a testament to the nation's growing and evolving IP industry. Patent prosecution in Malaysia currently takes an average of 3 to 4 years from filing to grant. The bulk of the time is attributed to the lengthy examination process. The considerable time for patent prosecution may not be ideal for many patent applicants who seek to secure patent protection. In today's fast paced and rapidly changing market, it is imperative for companies or individuals to secure competitive advantage over their competitors to ensure its survival. While patience is taught to be a valuable virtue, in the case of securing patent protection, patience may be a non-negotiable requirement.

However, it is not all doom and gloom.

In Malaysia, there are several options which applicants can take advantage of in speeding up the patent prosecution process, including:

- Patent Prosecution Highway (PPH) program
- Expedited Examination program
- Modified Substantive Examination

Subject to meeting the different requirements, these options offer a key advantage to patent applicants who are interested in securing patent protection in a shortest amount of time.

Patent Prosecution Highway (PPH) program

The PPH program is an initiative between the Intellectual Property Corporation of Malaysia (MyIPO) and the Japan Patent Office (JPO) which seeks to provide a platform to accelerate patent prosecution in Malaysia. Applicants may request for accelerated examination with MyIPO under the PPH program on a basis of a corresponding Japanese or PCT application which receives favourable examination by the JPO. For an application undergoing a normal track of examination, the average time between filing a request for examination to obtaining grant is within two to three years, assuming it is a relatively smooth application. The time may be significantly more if there are multiple objections raised during prosecution.

Under the PPH program, the prosecution time is significantly reduced to within four to five months. In other words, with this program, it is possible to obtain a grant of a patent application within four to five months provided the request for examination and PPH request are filed simultaneously with the initial filing.

In addition to the significant time reduction, the PPH program offers a very attractive benefit to applicants. There is no official fee payable to MyIPO under the PPH program.

In order to qualify for the PPH program, the following conditions must be met:

- The Malaysian application and the Japanese or PCT applications examined by the JPO must correspond – this is defined in terms of a priority relationship between the applications or a common PCT application.
- One or more claims of the Japanese or PCT application have been indicated as allowable by the JPO.
- The claims presented in the Malaysian application for examination under the PPH sufficiently correspond to such allowed claims.
- A request for normal examination has been filed with MyIPO (either previously, or with the PPH request).
- If the examination request was filed previously, MyIPO has not yet started the examination.

Expedited Examination program

Under the Expedited Examination program, the MyIPO will advance an application out of turn for examination if a filed expedited examination request is approved. In Malaysia, patent applications are generally examined in the order of the filing dates. Upon approval of an expedited examination request, the application is allowed to skip the regular queue and is examined under a fast track.

An application which undergoes normal track examination typically takes up to one year for the issuance of a first examination report. Under the expedited examination program, it is significantly reduced to only one month for the issuance of a first examination report. The applicant is given three weeks to respond to the first examination report. If the applicant fails to respond to the examination report within this timeframe, the application reverts from fast track to normal track.

To qualify for a fast track examination under this program, the applicant must meet at least one of the prescribed grounds and make payment of hefty amount of official fees. The application must also be available for public inspection. The grounds on which expedited examination may be requested are:

- National or public interest
- Evidence of potential infringement or ongoing infringement proceedings
- Registration is a condition to obtaining monetary grants from the Government or institutions recognized by the Registrar
- The invention has already been commercialized or the applicant intends to do so within 2 years of requesting expedition
- The invention relates to green technologies that will enhance the quality of the environment or conservation of energy sources
- Other reasonable grounds.

Modified Substantive Examination

Modified Substantive Examination often provides a more cost effective alternative to fast track patent prosecution without the stringent requirements and hefty official fees of the

expedited examination option. With this option, it is expected to receive a grant within six to twelve months from the date of requesting for modified examination. It is considered to be unusual to receive an examination report for this option as patentability requirements of novelty and inventive step are normally considered fulfilled by relying on an elected granted patent. This explains the shorter timeframe to receive a clear report indicative of a decision to grant.

To qualify for this option, the applicant must have a granted patent in any of these following countries: Australia, United Kingdom, United States of America, Japan, Korea or under the European Patent Convention. In addition, it is required for the specification to be amended to conform to the elected granted patent.

The request for modified examination must be accompanied by a certified true copy of the granted specification of the elected patent and if the patent is not in English, a verified English translation. Of course, the necessary amendment to bring the Malaysian specification into conformity to the elected granted patent is required to be submitted as well together with the request for modified examination.

These options available in Malaysia offer attractive benefits for all patent applicants. Picking a quote from Francis Bacon, "A wise man will make more opportunities than he finds." And, such opportunities in the form of these options are there for the taking. You would be deemed wise to do so.