

**MALAYSIA**  
**GUIDELINES FOR PATENT EXAMINATION MANUAL**  
**IN THE INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA**

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## CHAPTER I INTRODUCTION

1. These Guidelines give instructions as to the practice and procedure to be followed in the various aspects of the examination of Malaysian applications and patents in accordance with Patents Act and Regulations. They are addressed primarily to applicants and patent practitioners, and it is hoped that they will be of assistance to them since the success of the Malaysian patent system depends on the good co-operation between the applicants and their representatives and the Intellectual Property Corporation of Malaysia (MyIPO).

2. The Guidelines are intended to cover normal occurrences. They should therefore be considered only as general instructions. The application of the Guidelines to individual Malaysian patent applications or patents is the responsibility of the examining staff and they may depart from these instructions in exceptional cases. Nevertheless, the parties can expect MyIPO to act as a general rule in accordance with the Guidelines until such time as they are revised. It should be noted also that the Guidelines do not constitute legal provisions. For the ultimate authority on practice in MyIPO, it is necessary to refer firstly to the Patents Act and Regulations.

3. The applicant should bear in mind that the drafting of the description, claims, abstract and drawings of an application is the responsibility of the applicant or his authorised representative. He must, of course, operate within the law. The examiner should not, therefore, undertake any drafting or redrafting himself, and although it is permissible for him to make suggestions as to how a specific objection may be overcome he should never, expressly or impliedly, indicate that a particular amendment would guarantee the validity of the patent. That is a matter entirely for the Court.

## **CHAPTER II CONTENT OF AN APPLICATION**

### **1. General**

The contents of an application are set out in Regulation 5. The application must contain:

- (a) a request for the grant of a Malaysian patent;
- (b) a description;
- (c) a claim or claims;
- (d) a drawing or drawings, where required; and
- (e) an abstract.

This Chapter deals with all these requirements, in so far as they are the concern of the examiner. The format of patent application specification can be referred to Appendix A.

### **2. The request for Grant**

**2.1** The request must be made on Form 1 (for patent) or Form 14 (for Utility Innovations) and must include a title.

**2.2** The title should clearly and concisely indicate the subject matter of the invention and should exclude all fancy names. In other words it must be brief and specific to the invention and not include fancy names, which do not define the technical subject with which the invention is concerned. Overlong titles and vague titles such as "chemical process" or "electric circuit" are objectionable since they do not give an adequate indication of the technical designation of the invention.

### **3. Description**

**3.1** The description should start with the same title as appears in the request for grant. Following amendment of the title of the description during examination, it is necessary to make corresponding amendments to the Request form. The applicant should be required to file the first page of Request Form with amended title.

Regulation 12(1)(a)

**3.2** The description should specify the technical field to which the invention relates. This places the invention in its proper setting.

**3.3** The description should indicate any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art;  
identification of documents reflecting such art, especially patent specifications,

should preferably be included. This applies in particular to the background art corresponding to the "prior art" portion of an independent claim or claims drafted in accordance with Regulation 13(6) (see III, 2.2).

**3.4** The invention must be disclosed in such terms that it can be understood and in a manner sufficiently clear and complete for it to be evaluated and carried out by a person having ordinary skill in the art and state any advantageous effects of the invention with reference to the background art. The meaning of a "person having ordinary skill in the art" is discussed in IV, 5.7. This requirement of the disclosure should be met by the description with the aid of drawings, if any, which do not, of themselves, form part of the description. This means that the invention as claimed should be disclosed in such a way that the technical problem or problems, with which it deals can be appreciated and the solution can be understood and put into effect.

**3.5** The description should not contain drawing such as figure or flowchart but can be included in separate sheet. If drawings are included, they should first be briefly described in the description, in a manner such as: "Figure 1 is a plan view of the transformer housing; Figure 2 is a side elevation of the housing; Figure 3 is an end elevation looking in the direction of the arrow 'X' of Figure 2; Figure 4 is a cross-section taken through the line AA of Figure 1". When it is necessary to refer in the description to elements of the drawings, the name of the element should be referred to as well as its number, i.e. the reference should not be in the form; "3 is connected to 5 via 4", but, "resistor 3 is connected to capacitor 5 via switch 4".

**3.6** To avoid ambiguity and lack of clarity the description and drawings should be consistent with one another, especially in the matter of reference numerals and other signs, and each numeral or sign must be explained.

**3.7** A detailed description of the best mode contemplated by the applicant for carrying out the invention, using examples and referring to the drawings, if any, must be given. Since the application is addressed to the person having ordinary skill in the art it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it obvious to another person having ordinary skill in the art how to put the invention into practice. In many cases a single example or single embodiment will suffice, but where the claims cover a broad field the description should not usually be regarded as satisfactory unless it gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims.

**3.8** In some cases it may be necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.

**3.9** It is the responsibility of the applicant to ensure that he supplies, when he first files his application, a sufficient disclosure. If the disclosure is seriously insufficient, such a deficiency cannot be cured subsequently by adding further examples or features without offending against Section 26A, which requires that the subject-matter content of the application must not be extended. Therefore in such circumstances, either the application must be refused or, if the deficiency arises only in respect of part of the subject matter claimed, the claims should be restricted to that part of the invention for which a sufficient description has been filed.

**3.10** The description should indicate explicitly the way in which the invention is industrially applicable and the way in which it can be made and used or, if it can only be used, the way in which it can be used, if this is not obvious from the description or from the nature of the invention. In view of the broad meaning given to the expression "industrially applicable" by Section 16, it is to be expected that, in most cases, the way in which the invention can be made or used in any kind of industry will be self-evident, so that no more explicit description on this point will be required.

**3.11** The manner and order of presentation of the description should be that specified in Regulation 12(1) (See Appendix A), i.e. as set out above, "unless, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more economical presentation".

**3.12** Although the description should be clear and straightforward with avoidance of unnecessary technical jargon, the use of recognised terms of art is not only acceptable, but should, in general, be required. Little known or especially formulated technical terms may be allowed provided that they are adequately defined and that there is no generally recognised equivalent. This discretion may be extended to foreign terms when there is no equivalent in the language of the proceedings. Terms already having an established meaning should not be allowed to be used to mean something different if this is likely to cause confusion. There may, however, be circumstances where a term may legitimately be borrowed from an analogous art. Terminology and signs must be consistent throughout the application.

**3.13** In the particular case of inventions in the computer field, program listings in programming languages cannot be relied on as the sole disclosure of the invention.

The description as in other technical fields, should be written substantially in normal language, possibly accompanied by flow diagrams or other aids to understanding, so that the invention may be understood by those persons having ordinary skill in the art who are deemed not to be programming specialists. Short excerpts from programs written in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention.

**3.14** When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published Standard (e.g. a Standard of sieve sizes), and such Standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the description.

The metric system of units of weights and measure and density should be used or, if another system is used, the units must also be expressed in the metric system (See Appendix B).

Similarly, temperature must be expressed at least in degrees Celsius or, in cryogenics, in Kelvin.

Other physical values must be expressed in the units recognised in international practice. Chemical and mathematical symbols, atomic weights and molecular formulae should be those in general use and technical terms, signs and symbols should be those "generally accepted in the field in question". In particular, if there are any agreed International Standards in the art in question, these should be adopted wherever practicable.

**3.15** The use of registered trade marks, trade names, proper names or similar words to refer to materials or articles is undesirable in so far as such words merely denote origin or in so far as they may relate to a range of different products. If such a word is used, the product must be sufficiently identified, without reliance upon the word, to enable the invention to be carried out by the person having ordinary skill in the art. However, where such words have become internationally accepted as standard descriptive terms and have acquired a precise meaning (e.g. "Bowden" cable, "Belleville" washer, and "Panhard" rod) they may be allowed without further identification of the product to which they relate.

**3.16** References to documents published before the priority date of the application (see Chapter V), including patent applications and specifications of granted patents, textbooks and periodicals, are allowable and often necessary to give information on the background art.

If, on the other hand, matter in a document referred to in the application as originally filed relates not to the background art but directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus), then the matter should as a rule be incorporated *expressis verbis* in the description, because the patent



specification should in principle be self-contained, i.e. capable of being understood without reference to any other document. The description should specify the technical field to which the invention relates. This places the invention in its proper setting.

### **3.17 Micro-organisms**

**3.17.1** In applications which either claim micro-organisms or use micro-organisms to carry out the invention, it is essential that the micro-organism is adequately defined if the requirements of sufficiency of the description (Regulation 12(1)(c)) are to be met.

**3.17.2** The criteria that must be satisfied are set out in Appendix C. However, when the micro-organism is described by reference to its accession number in a recognised collection, another problem arises. The Rules for depositing a micro-organism in a recognised collection, and for access to samples from that collection are governed by the Budapest Treaty, and Malaysia is not a signatory to that treaty. This means that a person in Malaysia, who wants to obtain a sample of a particular micro-organism so as to investigate a patent which refers to that micro-organism, cannot do so unless the patentee authorises the collection to release a sample to that person. Although the law is not certain in this respect, it is quite likely that a Malaysian patent, which requires the use of a micro-organism that is defined by an accession number in a collection, could be invalidated under Section 56(2)(b) of the Act, unless the Patentee agrees to release the micro-organism to any person who requires it to investigate the patent. The Patentee is entitled to place some conditions on this release; in particular that the released micro-organism cannot be passed on to any other persons.

**3.17.3** A notice has been drafted (See Appendix D) setting out the position to applicants, and a copy must be included in an examiner's report on all cases which refer to micro-organisms by reference to a culture collection.

## **4. Claims**

For further details, refer to chapter III.

## **5. Drawings**

**5.1** The requirements relating to the form and content of drawings are set down in Regulations 15, 18(2), and 18(10). Preferably, the numbering should be effected by using two separate series of numbering each beginning with one series commencing with the first sheet of description and continuing through the claims until the last sheet of the abstract and the second series being applicable only to the sheets of the drawings and commencing with the first sheet of such drawings. (See Appendix A)

## **6. The abstract**

**6.1** The purpose of the abstract is to give brief technical information about the disclosure as contained in the description, claims and drawings. In particular, it should be a useful searching tool for patent examiners. It should also give sufficient information to make it possible to assess whether there is a need to consult the description, claims and drawings. The abstract generally has no legal effect on the application containing it; for instance, it cannot be used to interpret the scope of protection claimed.

### **6.2 The abstract must:**

- (a) commence with the title of the invention,
  - (b) indicate the technical field to which the invention pertains,
  - (c) contain a concise summary of the disclosure as contained in the description, claims and drawings, which must be so drafted as to allow a clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principle use of the invention, and where applicable, it should contain the chemical formula which, among those contained in the application, best characterises the invention,
  - (d) not contain statements on the alleged merits or value of the invention or on its speculative application,
  - (e) preferably not contain more than one hundred and fifty words,
  - (f) not contain drawings but shall be accompanied by an indication of the figure or exceptionally more than one figure of the drawings, which should accompany the abstract.
- A reference sign in parenthesis should follow each main feature mentioned in the abstract and illustrated by a drawing.

## **CHAPTER III THE CLAIMS**

### **1. General**

The application must contain "a claim or claims".

#### **1.2 These must:**

- (i) define the invention in terms of the technical features of the invention, and
- (ii) be clear and concise and fully supported by the description and the number of claims shall be reasonable taking into consideration the nature of the invention.

**1.3** Since the terms of the claims determine the extent of the protection conferred by a patent, clarity of claim is of the utmost importance. The Act and Regulations do not specify how the claims are to be interpreted, but the generally accepted approach is to interpret the claims having regard to the description and any drawings in such a way that fair protection to the patentee for his contribution to the art is combined with a reasonable degree of certainty for third parties. Thus the area of protection should not, in one extreme be interpreted as that defined by the strict literal meaning of the wording of the claims with the description and drawings being used only to resolve any ambiguity, nor, in the other extreme, as what might be deduced from the description and drawings, with the claims serving only as a guide.

### **2. Form and content of claims**

**2.1** The claims must be drafted in terms of the technical features of the invention. This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose should be allowed if they assist in defining the invention. It is not necessary that every feature should be expressed in terms of a structural limitation. Functional limitations may be included, provided that a person having ordinary skill in the art would have no difficulty in providing some means of performing this function without exercising inventive skill. Claims to the use of the invention in the sense of the technical application thereof are allowable.

**2.2** Regulation 13(6)(a) and (b) defines the two-part form which a claim should adopt "wherever appropriate".

The first part (prior art) or preamble should contain a statement indicating the designation of the subject-matter of the invention, i.e. the general technical class of apparatus, process, etc., to which the invention relates, followed by a statement of "those technical features of the invention which are necessary for the definition of the claimed subject-matter but which, in combination, are found in the closest prior art document. This statement of prior art features is applicable only to independent

claims and not to dependent claims (see III, 3.2.2). It is clear from the wording of Regulation 13 that it is necessary only to refer to those prior art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a camera such as the lens and view-finder.

The second part or "characterizing portion" should state the "technical features which, in combination with the features stated under paragraph (a) (first part), it is desired to protect", i.e. the features which the invention adds to the closest prior art document. If the closest prior art document in the state of the art according to Section 14(2)(a) e.g. cited in the search report, reveals that one or more features in the second part of the claim were already known in combination with all the features in the first part of the claim, the examiner should require that such feature or features be transferred to the first part.

### **3. Kinds of claim**

#### **3.1 Categories**

Section 26 states that an application should relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Regulation 19(1) sets out specific combinations or "categories" of claims permitted under Section 26 (see III, 7.1.2). In fact, there are only two basic kinds of claim, viz, claims to a physical entity (product, apparatus) and claims to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or composition (e.g. a chemical compound or a mixture of compounds) as well as any physical entity (e.g. an object, article, apparatus, machine, or system of co-operating apparatus) which is produced by a person's technical skill. Examples are: "a steering mechanism incorporating an automatic feed-back circuit .....": "a woven garment comprising ....."; or "an insecticide consisting of X, Y, Z"; or "a communication system comprising a plurality of transmitting and receiving stations". The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things (see IV; 3.5).

**3.1.2** Subject to the conditions for unity of invention being satisfied (see III, 7), Regulation 19(2) states that an application may contain two or more independent claims in the same category which cannot be covered readily by a single generic claim. However, there are other circumstances where it may not be appropriate to cover the subject-matter

of an invention by a single independent claim in a particular category, for example, where the invention relates to an improvement in two separate but inter-related articles which may be sold separately, but each carry out the same inventive idea, such as an electric plug and socket or transmitter and receiver. Further examples are where the invention resides in a group of new chemical compounds and there are a number of processes for the manufacture of such compounds, or where a known substance is disclosed for a number of distinct medical uses. (See IV, 3.5)

### **3.2 Independent and dependent claims**

**3.2.1** All applications will contain one or more independent claims directed to the essential features of the invention. Any such claim may be followed by one or more dependent claims concerning particular embodiments of that invention. It is evident that any dependent claim relating to a particular embodiment must effectively include also the essential features of the invention and hence must include all the features of at least one independent claim. The term particular embodiment should be construed broadly as meaning any more specific disclosure of the invention than that set out in the main claim or claims.

**3.2.2** A "dependent claim" must contain, if possible at the beginning, a reference to the other claim, all of whose features it includes. Since a dependent claim does not by itself define all the characterising features of the subject-matter which it claims, expressions such as "characterised in that" or "characterised by" are not necessary in such a claim, and are to be avoided. A claim defining further features of an invention may include all the features of another dependent claim and should then refer back to that claim. Also, in some cases a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities; a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims.

**3.2.3** All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims should be grouped together to the extent and in the most practical way possible. The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association of related claims to be readily determined and their meaning in association with related claims to be readily determined and construed.

**3.2.4** If the two-part form is used for the independent claim(s), dependent claims may relate to further details of features not only of the characterising portion but also of the preamble.

**3.2.5** A claim, whether independent or dependent, can refer to alternatives provided those alternatives are of a similar nature and can fairly be substituted one for another and provided also that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe (see also III, 7.1.3).

**3.2.6** A claim may also contain a reference to another claim, even if it is not a dependent claim as defined in Regulation 14. One example of this is a claim referring to a claim of a different category (e.g. "Apparatus for carrying out the process of Claim 1 . . . .", or "Process for the manufacture of the product of Claim 1 . . . ."). Similarly, in a situation like the plug and socket example of III, 3.1.2, a claim to the one part referring to the other co-operating part (e.g. "plug for cooperation with the socket of claim 1 ...") is not a dependant claim.

#### **4. Clarity and interpretation of claims**

**4.1** The requirement that the claims shall be clear and concise applies to individual claims and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. Therefore the meaning of the terms of a claim should, as far as possible, be clear for the person skilled in the art from the wording of the claim alone.

**4.2** Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. Moreover, if such a special meaning applies, the examiner should, so far as possible, require the claim to be amended whereby the meaning is clear from the wording of the claim alone.

**4.3** Any inconsistency between the description and the claims should be avoided if it may throw doubt on the extent of protection and therefore render the claim unclear. Such inconsistency can be of the following kinds:

(a) Simple verbal inconsistency.

For example, there is a statement in the description which suggests that the invention is limited to a particular feature, but the claims are not so limited; also, the description places no particular emphasis on this feature and there is no reason for believing that the feature is essential for the performance of the invention. In such a case the inconsistency can be removed either by broadening the description or by limiting the claims. Similarly, if the claims are more limited than the description, the scope of the claims may be broadened or the description may be limited.

(b) Inconsistency regarding apparently essential features. For example, it may appear,

either from general technical knowledge or from what is stated or implied in the description, that a certain described technical feature not mentioned in an independent claim is essential to the performance of the invention, or in other words is necessary for the solution of the problem to which the invention relates. In such a case, the claim is unclear, because an independent claim must be comprehensible from a technical point of view and must also clearly indicate all the essential features of the invention. If, in response to this objection, the applicant shows convincingly, e.g. by means of additional documents or other evidence, that the feature is not in fact essential, he may be allowed to retain the unamended claim and, where necessary, to amend the description instead. The opposite situation in which an independent claim includes features which do not seem essential for the performance of the invention is not objectionable.

(c) Part of the subject-matter of the description and/or drawings is not covered by the claims. For example, the claims all specify an electric circuit employing semi-conductor devices, but one of the embodiments in the description and drawings employs electronic tubes instead. In such a case, the inconsistency can normally be removed either by broadening the scope of the claims (assuming that the description and drawings as a whole provide adequate support for such broadening) or by removing the "excess" subject-matter from the description and drawings. However, if examples in the description and/or drawings which are not covered by the claims, are presented, not as embodiments of the invention, but as background art or examples which are useful or understanding the invention, the retention of these examples may be allowed.

**4.4** Objection should be taken to general statements in the description which imply that the scope of protection may be expanded in some vague and imprecisely defined way. In particular, objection should be raised to any statement which refers to the scope of protection being expanded to cover the "spirit" of the invention; objection should likewise be raised, in the case where the claims are directed to a combination of features, to any statement which expressly or impliedly suggests that protection is nevertheless sought not only for the combination as a whole, but also for individual features or sub-combinations thereof.

**4.5** The claims must define the invention in terms of its technical features. An independent claim should therefore specify clearly all of the essential features needed to define the invention except insofar as such features are implied by the generic terms used, e.g. a claim to a "bicycle" does not need to mention the presence of a wheel. If a claim is to a process for producing the product of the invention, then the process as claimed should be one which, when carried out in a manner which would seem reasonable to a person having ordinary skill in the art, necessarily has as its end result that particular product; otherwise there is an internal inconsistency and therefore lack of clarity in the claim. In the case of a product claim, if the product is of a well-known

kind and the invention lies in modifying it in certain respects, it is sufficient if the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for apparatus.

**4.6** Relative or similar terms such as "thin", "wide", or "strong" in a claim may render the scope of the claim vague and uncertain and should not in general be used. However, if the term has a well-recognised meaning in the particular art, e.g. "high-frequency" in relation to an amplifier, and this is the meaning intended its use is permissible. Where the term has no well-recognised meaning, it should be replaced by a more precise wording found elsewhere in the original disclosure. Where there is no basis in the disclosure for a clear definition, and the term is not essential having regard to the invention, it may exceptionally be retained in the claim, because to excise it would generally lead to an extension of the disclosure in the initial application contrary to Section 26A. However an unclear term cannot be allowed in a claim if the term is essential in delineating the invention since the claim would lack clarity. Equally, an unclear term cannot be used by the applicant to distinguish his invention from the prior art.

**4.7** Particular attention is required whenever the word "about" or similar terms such as "approximately" are used. Such a word may be applied, for example, to a particular value (e.g. "about 200°C") or to a range (e.g. "about x to about y"). In each case, the examiner should use his judgement as to whether the meaning is sufficiently clear in the context of the application read as a whole. However, the word can only be permitted if its presence does not prevent the invention from being unambiguously distinguished from the prior art with respect to novelty and inventive step.

**4.8** The use of registered trade marks, trade names, proper names and similar expressions in claims should not be allowed unless their use is unavoidable; they may be allowed exceptionally if they are generally recognised as having a precise meaning (see also II, 3.15).

**4.9** Expressions like "preferably", "for example", "such as" or "more particularly" should be looked at carefully to ensure that they do not introduce ambiguity. Expressions of this kind have no limiting effect on the scope of a claim; that is to say, the feature following any such expression is to be regarded as entirely optional.

**4.10** Where the invention relates to a chemical compound, it may be characterised in a claim in various ways, e.g., by its chemical formula, as a product of a process or, exceptionally, by its parameters. Characterisation of a chemical compound solely by its parameters should, as a general rule, not be allowed. It may, however, be allowable in those cases where the invention cannot be adequately defined in any other way.



This can arise, e.g. in the case of macromolecular chains. In such cases, however, only parameters usual in the art should be employed to characterise the compound.

**4.11** Claims for products defined in terms of a process of manufacture are admissible only if the products as such fulfil the requirements for patentability, i.e. inter alia that they are new and inventive. A product is not rendered novel merely because it is produced by means of a new process. A claim defining a product in terms of a process is to be construed as a claim to the product as such and the claim should preferably take the form "Product X obtainable by process Y", or any wording equivalent thereto, rather than "Product X obtained by process Y".

**4.12** Where a claim for an apparatus seeks to define the invention by reference to features of the use to which the apparatus is to be put, a lack of clarity can result. For example a claim reading "A box for storing magnetic tape cassettes on end, characterised in that the stored cassettes project beyond the upper edges of the box to facilitate removal" is unclear since, though directed to a box, it defines not a box per se, but its relationship to the cassettes. Such a claim should make clear the size of the box, if desired by defining the size of the cassettes or must be directed to a combination of box and cassettes.

**4.13** For the purposes of examination, a "use" claim of a form such as "the use of substance X as an insecticide" should be regarded as equivalent to a "process" claim of the form "a process of killing insects using substance X"

Thus a claim of the form indicated should not be interpreted as directed to the substance X as intended for use of an insecticide. Similarly, a claim for "the use of a transistor in an amplifying circuit" would be equivalent to a process claim for the process of amplifying using a circuit containing the transistor and should not be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of using the transistor in building such a circuit".

**4.14** The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings. In particular they must not normally rely on such references as "as described in part of the description", "as illustrated in Figure 2 of the drawings", or "substantially as described and illustrated in the accompanying drawings". A claim containing the latter phrase is known as an „omnibus claim“.

**4.15** The use of references in the claims to features of the drawings is not prohibited. On the contrary, if there are drawings, and the technical features of the claims would be rendered more intelligible by relating these features to the corresponding features of the drawings (e.g. where a complete machine has been illustrated), then this should

preferably be done by placing the appropriate reference signs in parentheses after the features in the claims. This should be done in both parts of claims having the two-part form specified in Regulation 13(6). These reference signs are not normally construed as limiting the scope of a claim, but merely act as aids to an easier understanding of the claimed invention. If the absence of reference signs makes it very difficult to relate a claim to the particular description, it is often possible to amend the wording of the claim as an alternative to inserting reference signs therein. Another acceptable alternative is to put the reference signs in a corresponding statement of invention in the description.

## **5. Conciseness, number of claims**

**5.1** The requirement that the claims shall be clear and concise refers to the claims in their entirety as well as to the individual claims. The number of claims must be considered in relation to the nature of the invention the applicant seeks to protect. Undue repetition of wording, e.g. between one claim and another should be avoided by the use of the dependent form. Regarding independent claims in the same category, see III, 3.1.2.

Claims should be numbered consecutively in Arabic numerals.

## **6. Support in description**

**6.1** The claims must be fully supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings.

**6.2** Most claims are generalisations from one or more particular examples. The extent of generalisation permissible is a matter which the examiner must judge in each particular case in the light of the relevant prior art. Thus an invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with advances in a known technology. A fair statement of claim is one which is not so broad that it goes beyond the invention, nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. The applicant should be allowed to cover all obvious modifications, equivalents to and uses of that which he has described; after the date of filing, however, he should be allowed to do so only if this does not introduce subject-matter which goes beyond the disclosure of the initial application, i.e. does not contravene Section 26A. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description, he should be allowed to draft his claims accordingly. Where there is any serious inconsistency between the claims and the description, amendment

to remove this will be required.

**6.3** Where certain subject-matter is clearly disclosed in a claim of the application as filed, but is not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter. Where the claim is dependent, it may suffice if it is mentioned in the description that the claim sets out a particular embodiment of the invention (see II, 3.4).

## **7. Unity of invention**

### **7.1 Independent claims**

**7.1.1** The application must "relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept". The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same category (as in the examples given in III, 3.1.2), but the more usual case is a plurality of independent claims in different categories as permitted by Regulation 19.

**7.1.2** A plurality of independent claims in different categories may constitute a group of inventions linked to form a single general inventive concept, the link being e.g. that between a product and the process which produces it ; or between a process and an apparatus for carrying out the process.

Regulation 19 sets out three different specific combinations of claims in different categories and each of these combinations is permissible in any one application. These are:

- (a) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for a use of the product; or
- (b) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the process; or
- (c) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for apparatus or means specifically designed for carrying out the process.

**7.1.3** Alternative forms of an invention may be claimed either in a plurality of independent claims, as indicated in III, 7.1.1 or in a single claim (see III, 3.2.5). In the latter case the presence of the two alternatives as independent forms may not be immediately apparent. In either case, however, the same criteria should be applied in deciding whether or not there is unity of invention, and lack of unity of invention may then also exist within a single claim.

## **7.2 Dependent claims**

**7.2.1** There is no question of plurality of invention in respect of a dependant claim and the claim from which it depends, because the general concept they have in common is the subject-matter of the independent claim, which is also contained in the dependant claim. For example suppose claim 1 claims a turbine rotor blade shaped in a specified manner, while claim 2 is for a "turbine rortor blade as claimed in Claim 1 and produced from alloy Z". The common general concept linking the dependant with the independent claim is "turbine rotor blade shaped in a specified manner". If, however, the independent claim appears to be not patentable, then the question whether there is still an inventive link between all the claims dependant on that claim needs to be carefully considered. It may be that the "special technical features" of one claim dependant on this non-patentable independent claim are not present in the same or corresponding form in an other claim dependant on that claim.

**7.2.2** The question of unity of invention must always be considered by the examiner. If unity is found to be lacking, the applicant should be required to limit his claims in such a way as to avoid the objection. Of course, the applicant has the option of filing a divisional application(s) under Section 26B of the Act.

## **CHAPTER IV PATENTABILITY**

### **1. General**

**1.1** There are four basic requirements for patentability:

- (i) There must be an "invention".
- (ii) The invention must be industrially applicable.
- (iii) The invention must be "new".
- (iv) The invention must involve an "inventive step".

**1.2** In addition to these four basic requirements, the applicant should be aware of the following two requirements that are implicitly contained in the Patents Act and Patents Regulations.

(i) The invention must be such that it permits in practice the solution to a specific problem in the field of technology (following the teaching contained in the application), Section 12(1). It should be noted that an invention may be or may relate to a product or process, Section 12(2).

(ii) The invention must be of a "technical character" to the extent that it must relate to a technical field, and must have technical features in terms of which the matter for which protection is sought can be defined in the claim or claims (Regulation 13(5)).

**1.3** The Patents Act does not require explicitly or implicitly that an invention to be patentable must entail some technical progress or even any useful effect. Nevertheless, advantageous effects, if any, with respect to the prior art should be stated in the description (Regulation 12(1)(c)). Any such effects may provide evidence indicative of the presence of "inventive step". (See IV, 5).

### **2. Inventions**

**2.1** The Patents Act defines in Section 12 what is meant by "invention", and Section 11 states the conditions which must be fulfilled for the invention to be patentable. "Invention" in this context means that which is specified in a claim. It is therefore possible for an application to contain claims which relate to patentable inventions as well as claims which define inventions which are not patentable or matters which are not inventions. In such a case amendment is necessary, since a patent should be granted only when each claim defines a patentable invention. A claim will generally be held to be bad if anything falling within its scope is not patentable. Section 13 contains a list of things which shall not be regarded as patentable inventions even though they may fall within the definition of "invention" set out in Section 12.

**2.2** In considering whether an application relates to an invention within the meaning of Section 12(1), there are two general points the applicant must bear in mind. First, any exclusion from patentability under Section 13(1) should be regarded as applying only to the extent to which the application relates to the excluded subject-matter as such. Secondly, it is necessary to identify and assess the real contribution which the subject-matter claimed, considered as a whole, adds to the prior art. If this contribution is abstract or intellectual and not of a technical character, there is no invention within the meaning of Section 12(1) and in general it will not be possible to formulate an acceptable claim. Thus, for example, if the claim is for a known manufactured article having a painted design or certain written information on its surface, the contribution to the art is as a general rule non-technical and merely an aesthetic creation or presentation of information. Similarly, if a computer program is claimed in the form of a physical record, e.g. on a conventional tape or disc, the contribution to the art is still not more than a computer program and as such of a purely intellectual character. In instances such as these, either there is no invention within the meaning of Section 12(1) or the claim relates to excluded subject-matter as such and is therefore not allowable. If, on the other hand, a computer program in combination with a computer causes the computer to operate in a different way from a technical point of view, the combination might be patentable.

It must also be borne in mind that the basic test of whether there is an invention within the meaning of Section 12(1) or whether there is exclusion from patentability under Section 13(1) is separate and distinct from the questions whether the invention is susceptible of industrial application, is new or involves an inventive step.

**2.3** The items on the list in Section 13, paragraph 1, will now be dealt with in turn, and further examples will be given in order better to clarify the distinction between what is patentable and what is not.

### **3. Non-patentable Inventions**

#### **3.1 Discoveries**

If a person finds out a new property of a known material or article, that is merely discovery and unpatentable. But if the discovery leads to the conclusion that the material can be used for making a particular article or in a particular process, then the article or process could be patentable. For example, the discovery that a particular known material is able to withstand mechanical shock would not be patentable, but a railway sleeper made from that material would not fall foul of this exclusion. To find a substance or micro-organism freely occurring in nature is also merely discovery and therefore unpatentable.

If, however, as will generally be the case, it were necessary to extract and isolate it then a process developed for this purpose, and also the material when obtained

by this process, could both be patentable. A gene which is discovered to exist in nature may be patentable if a technical effect is revealed.

### **3.2 Scientific theories and Mathematical methods**

Scientific theories are statements about the natural world, reasoned or otherwise, and the same principles apply as for discoveries, i.e. the theories themselves are not patentable no matter how radical or revolutionary they may be, but if they lead to practical applications these may well be patentable. For example, the physical theory of semi conductivity would not be patentable. However, new semiconductor devices and processes for manufacturing these may be patentable. As with scientific theories, mathematical methods are not patentable no matter how ingenious or useful as an aid to computation they may be. But again the products of their practical application may be patentable. Such products must, however, be distinguishable from other known products of the same kind which do not result from the application of the theory or method, the distinction residing either in the product itself or in the technical process of its production and not merely in the fact that a particular theory or mathematical method was involved. For example, a propeller the shape of which conforms to a new mathematical formula would not be patentable if the shape were not new. Although a new method of calculation would not be patentable, a calculating machine constructed to carry out that method may well be patentable provided it is distinguishable from known machines by technical features and not merely by being programmed to perform the calculation. A mathematical method for designing electrical filters is not patentable; nevertheless filters designed according to this method could be patentable provided they have technical features to which a product claim can be directed.

### **3.3 Plant or animal varieties or essentially biological processes for the production of plants or animals other than man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes.**

The question whether a process is "essentially biological" is one of degree depending on the extent to which there is technical intervention by man in the process; if such intervention plays a significant part in determining or controlling the result it is desired to achieve, the process would not be "essentially biological" and hence not excluded. To take some examples, a method of crossing, inter-breeding, or selectively breeding, say, horses involving merely selecting for breeding and bringing together those animals having certain characteristics would be essentially biological and therefore unpatentable. On the other hand, a process of treating a plant or animal to improve its properties or yield or to promote or suppress its growth, e.g. a method of pruning a tree, would not be essentially biological since, although a biological process is involved, the essence of the invention is technical; the same could apply to a method of treating a plant characterised by the application of a growth-stimulating substance or radiation. The treatment of soil by technical means to suppress or promote

the growth of plants is also not excluded from patentability.

Man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes are specifically exempted from the exclusion. The term microbiological process is to be interpreted as covering not only industrial processes using micro-organisms, but also processes for producing new micro-organisms, e.g. by genetic engineering. The product of a microbiological process may also be patentable per se (product claim). Propagation of the micro-organism itself is considered to be a microbiological process; consequently, the micro-organism can be protected per se as a product of that process. The term micro-organism also covers plasmids and viruses.

### **3.4 Schemes, rules and methods for performing mental acts, playing games or doing business**

These are further examples of items of an abstract or intellectual character. In particular, a scheme for learning a language, a method of solving cross-word puzzles, a game (as an abstract entity defined by its rules) or a scheme for carrying out a commercial operation, for example a method of book-keeping, would not be patentable. However, apparatus for playing a game or carrying out a scheme might be patentable.

### **3.5 Methods for the treatment of the human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body**

This provision does not apply to products used in any such methods. Patents may, therefore, be obtained for surgical, therapeutic or diagnostic instruments or apparatus for use in such methods. Also the manufacture of prostheses or artificial limbs, as well as methods of taking measurements therefor on the human body, would be patentable, so that a method of manufacturing a prosthetic tooth which involves making a model of patient's teeth in the mouth would not be excluded from patentability. Patents may also be obtained for new products for use in these methods of treatment or diagnosis, particularly substances or compositions. However, by Section 14(4) a known substance or composition already comprised in the prior art as defined in Section 14(2), may be patented for use in these methods if the known substance or composition was not previously disclosed for use in surgery, therapy or diagnosis ("first medical use"). The same substance or composition cannot subsequently be patented for any other use of that kind. A claim to a known substance or composition for the first use in surgical, therapeutic and/or diagnostic methods should be in a form such as : "substance or composition X" followed by the indication of the use, for instance " ...for use as a medicament", "... as an anti-bacterian" or "... for curing disease Y". In contrast to what is stated in III, 4.13 these types of claims will be regarded as restricted to the substance or composition when presented or packaged for the specific use. Product claims per se can only be obtained for novel products. However, this does not mean that product claims for the first medical use need not fulfil all other requirements



of patentability. A claim in the form "Use of substance or composition X for the treatment of disease Y ..." will be regarded as relating to a method for treatment explicitly excluded from patentability by Section 13(1) and therefore will not be accepted. A claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" is allowable for either a first or "subsequent" (second or further) such application, if this application is new and inventive. It should be noted that Section 13(1)(d) excludes only treatment by surgery or therapy or diagnostic methods. It follows that other methods of treatment of live human beings or animals (e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool) or other methods of measuring or recording characteristics of the human or animal body are patentable provided that (as would probably be the case) such methods are of a technical, and not essentially biological character and provided that the methods are susceptible of industrial application. The latter proviso is particularly important in the case of human beings. A treatment or diagnostic method, to be excluded, must actually be carried out on the living human or animal body. A treatment or diagnostic method practised on a dead human or animal body would therefore not be excluded from patentability by virtue of Section 13(1). Treatment of body tissues or fluids after they have been removed from the human or animal body, or diagnostic methods applied thereon, are not excluded from patentability insofar as these tissues or fluids are not returned to the same body. Thus the treatment of blood samples is not excluded, whereas a treatment of blood by dialysis with the blood being returned to the same body would be excluded. A distinction is made between methods of diagnosis and methods which may be used in diagnosis. Methods of obtaining information, e.g. by physical measurement, from the living human or animal body are not excluded from patentability if they merely produce intermediate results which on their own do not enable a decision to be made on the treatment necessary. For example, measurement of blood pressure may reveal an abnormality but not the cause which requires treatment. Other such methods include tomography and NMR scans. Treatment by therapy implies the curing of a disease or malfunction of the body through prophylactic methods, e.g. immunisation, are considered to be therapeutic treatments and thus excluded. Surgery is not limited to healing treatments, being more indicative of the nature of the treatment; methods of cosmetic surgery are thus excluded from patentability. However, application of substances to the body for purely cosmetic purposes is not therapy and a process for waving human hair or improving its strength, or a process for strengthening finger nails would be patentable. Certain other forms of subject-matter are not patentable as they do not fall within the definition of "invention" contained in Section 12. These are dealt with below.

### **3.6 Programmes for computers**

A computer program is a set of instructions for controlling a sequence of operations of a data-processing system. It closely resembles a mathematical method. It may be

expressed in various forms and may be presented in a format suitable for direct entry into a particular computer or may require transcription into a different format. It may be presented in terms either of software or in combination with hardware. A data-processing operation can be implemented either by means of a computer programme or by means of special circuits and the choice may have nothing to do with the inventive concept but be determined purely by factors of economy or practicality. With this point in mind, examination in this area should be guided by the following approach: A computer programme claimed by itself or as a record on a carrier is not patentable, irrespective of its content. The situation is not normally changed when the computer programme is loaded into a known computer. If, however, the subject-matter as claimed makes a technical contribution to the prior art, patentability should not be denied merely on the ground that a computer programme is involved in its implementation. This means, for example, that programme-controlled machines and programme-controlled manufacturing and control processes should normally be regarded as patentable subject-matter. It follows also that, where the claimed subject-matter is concerned only with the programme-controlled internal working of a known computer, the subject-matter could be patentable if it provides a technical effect. As an example, consider the case of a known data-processing system with a small fast working memory and a larger but slower further memory. Suppose that the two memories are organised under programme control, in such a way that a process which needs more address space than the capacity of the fast working memory can be executed at substantially the same speed as if the process data were loaded entirely in that fast memory. The effect of the programme in virtually extending the working memory is of a technical character and might therefore support patentability. Where patentability depends on a technical effect, the claims must be so drafted as to include all the technical features of the invention which are essential for the technical effect. Where patentability is admitted then, generally speaking, product, process and use claims would be allowable.

#### **4. Exceptions to patentability**

**4.1** Section 31(1) states that the grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the performance of any act in respect of the claimed invention is prohibited by any law or Regulation, except when the performance of that act would be contrary to public order or morality. The purpose of this is to exclude from protection inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive or immoral behaviour; one obvious example of subject-matter which should be excluded under this provision is a letter-bomb. This provision is likely to be invoked only in rare and extreme cases. A fair test to apply is to consider whether it is probable that the public in general would regard the invention as so abhorrent that the grant of patent rights would be inconceivable.

If it is clear that this is the case, objection should be raised by the examiner otherwise not.

**4.2** Excluded from patentability are products and processes where it appears that such a product or process would be prejudicial to the interest of the nation.

## **5. Industrial application**

**5.1** Section 16 states that an invention shall be considered industrially applicable if it can be made or used in any kind of industry. "Industry" should be understood in its broad sense as including any physical activity of "technical character" i.e. an activity which belongs to the useful or practical arts as distinct from the purely intellectual or aesthetic arts; it does not necessarily imply the use of a machine or the manufacture of an article and could cover e.g. a process for dispersing fog, or a process for converting energy from one form to another. Thus, Section 16 excludes from patentability very few inventions which are not already excluded by reason of Sections 12 and 13(1). One further class of invention which would be excluded, however, would be articles or processes alleged to operate in a manner clearly contrary to well-established physical laws, e.g. a perpetual motion machine. Objection could arise under Section 16 only insofar as the claim specifies the intended function or purpose of the invention, but if, say, a perpetual motion machine is claimed merely as an article having a particular specified construction then objection should be made because of lack of clarity.

**5.2** Methods of testing generally should be regarded as inventions susceptible of industrial application and therefore patentable if the test is applicable to the improvement or control of a product, apparatus or process which is itself susceptible of industrial application.

**5.3** It should be noted that industrial applicability is not a requirement that overrides the exclusions specified in Section 13(1) e.g. an administrative method of stock control is not patentable, having regard to Section 13(1)(c), even though it could be applied to the store of spare parts of a factory.

## **6. Newness (novelty); prior art**

**6.1** Section 14(1) states that an invention is new if it is not anticipated by prior art. Section 14(2)(a) defines the prior art as everything disclosed to the public anywhere in the world, by written publication, by oral disclosure, by use, or in any other way prior to the priority date of the patent application claiming the invention. The width of this definition should be noted. There are no restrictions whatever as

to the language in which the relevant information was made available to the public; also no age limit is stipulated for the documents or other sources of the information. There are however certain specific disclosures which are to be disregarded as far as the prior art is concerned. (See IV, 9).

**6.2** A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. The problem likely to arise for the examiner is where:

- (a) a document reproduces an oral description (e.g. a public lecture) or gives an account of a prior use (e.g. display at a public exhibition); and
- (b) Only the oral description or lecture was publicly available before the priority date of the application, the document itself being published on or after this date.

In such cases, the examiner should start with the assumption that the document gives a true account of the earlier lecture, display or other event as forming part of the prior art. If, however, the applicant gives sound reasons for contesting the truth of the account given in the document, then again the examiner should not pursue the matter further.

**6.3** It should be noted that the priority date in Section 14(2) is defined in Section 27A as the filing date of the application except where priority is claimed under the Paris Convention in which case it is the date of filing of the first foreign application whose priority is claimed.

## **7. Conflict with other domestic applications**

**7.1** The prior art also comprises the contents of a domestic application having an earlier priority date than the application being examined, to the extent that such contents are included in the patent granted on the basis of the said domestic patent application. (By virtue of Section 15 such earlier applications are part of the prior art only when considering novelty and not when considering inventive step). The purpose of this provision is to avoid the same monopoly being granted on concurrent or co-pending applications by deeming the contents of the earlier application to have been published as from an earlier date than, in fact, they were. By the content of a domestic application is meant the whole disclosure, i.e. the description, drawings and claims, including any matter explicitly disclaimed or prior art explicitly described. However, the "content" does not include any priority document (the purpose of such document being merely to determine to what extent the priority date applies to the disclosure of the domestic application). It is important to note that it is the contents of the

earlier application as contained in the patent subsequently granted which are to be considered when applying Section 14(2)(b).

**7.2** It is an accepted principle in most patent systems that two patents shall not be granted to the same applicant for one invention. It is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions, for example in the case of divisional applications (Section 26B). However, in the rare case in which there are two or more applications from the same applicant and the claims of those applications have the same priority date and relate to the same invention, the applicant should be told that he must either amend one or more of the applications in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant. (Section 30(6)). Where appropriate, cross-references should be used. Should two applications of the same priority date be received from two different applicants, each must be allowed to proceed as though the other did not exist. [Section 31(2A)].

## **8. Test for Novelty**

**8.1** The two questions to be answered in order to determine whether an invention is new within the meaning of Section 14(1) are:

- (a) has a particular document or action been disclosed in such a way as to make it part of the prior art, and
- (b) are the details or disclosures of the document or action such as to destroy the novelty of the invention claimed.

**8.2** The answer to the first question will be determined by the effective date of the disclosure. (See IV, 6 and 7). This Section of the Guidelines deals with the second question.

**8.3** It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together. (See IV, 10.8)

**8.4** The interpretation of novelty has yet to be determined by the Court. A strict and narrow view taken by some is that when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents. This means that if the claim under examination includes very minor (well-known equivalents) features not found in the prior art citation, then there is novelty. The justification for this view is that it is pointless to get involved in arguments with the applicant on whether or not the claimed subject-matter is new, when the Examiner can rely on the much broader objection of lack of inventive step.

**8.5** A possible alternative approach would be to rely on the definition of invention in Section 12 in cases where a development from the prior art is claimed comprising the substitution of a well-known equivalent which does not solve any technical problem. Such an approach would be consistent with the well-established principle that no monopoly should be granted which would prevent the public from doing what was already known (novelty) or what was a non-inventive development from the prior art (obviousness). To give effect to this principle the approach of looking for an invention as defined by Section 12 should be used when examining applications for utility innovations for which there is no requirement for inventive step. However, since a lack of inventive step objection can be made against any patent application where the novelty of the matter claimed is an obvious development from the prior art (ie whether or not the development solves a technical problem), it will generally be more straightforward to take the strict and narrow view of novelty for patent applications.

**8.6** A document takes away the novelty of any claimed subject-matter if that subject-matter is derivable from that document either expressly or impliedly, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used (even if this not explicitly stated) takes away the novelty of the use of an elastic material.

**8.7** In determining novelty, a prior document should be read as it would have been read by a person having ordinary skill in the art on the effective date of the document. By "effective" date is meant the publication date in the case of a previously published document and the priority date in the case of a document falling within Section 14(2)(b).

**8.8** In considering novelty, it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and a disclosure of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets.

**8.9** In the case of a prior document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the person with ordinary skill would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching.

## **9. Non-prejudicial disclosures**

**9.1** There are three specified instances (and these are the only three) in which a prior disclosure of the invention shall not be taken into consideration as part of prior art. These are:

(a) if the disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title;

(b) if the disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title; or

(c) if the disclosure is by way of a pending application to register the patent in the United Kingdom Patent Office as at the date of coming into force of the 1983 Act.

**9.2** An essential condition, in both instances (a) and (b), is that the disclosure in point must have taken place not earlier than one year preceding the date of filing the application.

**9.3** The wording for (a) is quite general and has the effect that any disclosure of the invention whether deliberate or accidental, and whether resulting from an act committed in ignorance or full knowledge of patent law, is to be disregarded provided that the disclosure took place not more than one year before the application was filed.

**9.4** Regarding instance (b), the disclosure might be made in a published document or in any other way. As a particular instance, the disclosure might be made in an application of earlier priority date. Thus, for example, a person B who has been told of A's invention in confidence, might himself apply for a patent for this invention. If so, the disclosure resulting from the publication of any patent granted on B's application will not prejudice A's rights, provided that A has already made an application, or applies within one year of such publication.

**9.5** As regards (c) the normal period for putting a U.K. patent application in order for grant is four years and six months from the declared priority date. Provision (c) therefore ceased to have any effect from 1 April 1991.

## **10. Inventive step**

**10.1** "An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under paragraph (a) of subsection (2) of Section 14, such inventive step would not have been obvious to a person having ordinary skill in the art". Novelty and inventive step are different criteria. Novelty

exists if there is any real difference between the invention and the known art. The question of inventiveness only arises if there is novelty.

**10.2** Examination for inventive step on a utility innovation application is not required. (See VIII).

**10.3** The "prior art" for purposes of considering inventive step is as defined in Section 15; it does not include later published domestic applications referred to in Section 14(2)(b). Thus the question to consider, in relation to any claim defining the invention, is whether at the priority date of that claim, having regard to the art known at the time, it would have been obvious to the person having ordinary skill in the art to arrive at something falling within the terms of the claim. If so, the claim is bad for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology, but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person having ordinary skill in the art. In considering inventive step, as distinct from novelty, it is fair to construe any published document in the light of subsequent knowledge and to have regard to all the knowledge generally available to the person having ordinary skill in the art at the priority date of the claim.

**10.4** The invention claimed must normally be considered as a whole. Thus it is not correct as a general rule, in the case of a combination claim, to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious.

**10.5** While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that there are various ways in which an invention may be arrived at. An invention may, for example, be based on the following: (i) The formulation of an idea or of a problem to be solved (the solution being obvious once the problem is clearly stated).

Example: the problem of indicating to the driver of a motor vehicle at night the line of the road ahead by using the light from the vehicle itself. As soon as the problem is stated in this form the technical solution viz, the provision of reflective markings along the road surface, appears simple and obvious.

(ii) The devising of a solution to a known problem.

Example: the problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution ("freeze-branding") consists in applying the discovery that the hide can be permanently depigmented by freezing.



(iii) The arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious).

Example: the agreeable flavour of butter is found to be caused by minute quantities of a particular compound. As soon as this insight has been arrived at, the technical application comprising adding this compound to margarine is immediately obvious. Many inventions are of course based on a combination of the above possibilities - e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

**10.6** If an independent claim is new and non-obvious, there is no need to investigate the presence or absence of inventive step in any claim dependent thereon. Similarly, if a claim to a product is new and non-obvious, there is no need to investigate the obviousness of any claims for a process which inevitably results in the manufacture of that product or any claims for a use of that product.

**10.7** The person having ordinary skill in the art should be presumed to be a workman or technician who is aware of everything in the prior art and who has the skill to make routine workshop developments but not to exercise inventive ingenuity. He is assumed to be at least sufficiently interested to address his mind to the subject and to consider the practical application of the information which he is presumed to have. There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, than a single person. This may apply e.g. in certain advanced technologies such as computers or telephone systems and in highly specialised processes such as the commercial production of integrated circuits or of complex chemical substances. Further, with a prospective solution in mind the workman or technician might need to seek advice from an expert in another field; in this case the person having ordinary skill in the art may thus be regarded as a team combining the knowledge of both arts.

**10.8** In considering whether there is inventive step (as distinct from novelty), it is permissible to combine together the disclosure of two or more documents or parts of documents, different parts of the same document or other pieces of prior art, but only where such combination would have been obvious to the person having ordinary skill in the art at the effective priority date of the claim under examination.

## CHAPTER V PRIORITY

### 1. The right to priority

**1.1** Section 27A defines the priority date of an application for a patent as the filing date of the application except where a declaration of priority is made under Section 27. (See V, 1.3).

**1.2** An application is accorded as its filing date the date on which it satisfies the requirements of Section 28. This date remains unchanged except in the special circumstances of late-filed corrections or drawings provided for in Section 28(4) and(5). The filing date may be the only effective date of the application. It is then of importance not only for fixing the expiry of certain time limits, but also for determining the prior art relevant to the novelty or obviousness of the subject-matter of the application, and for determining which of two or more applications from independent persons for the same invention is to proceed to grant - Section 18(4).

**1.3** However, in many cases, an application will claim the right of priority of the date of filing of an earlier application. In such cases, it is the priority date (i.e. the date of filing of the earlier application) which becomes the effective date for the purposes mentioned in the preceding paragraph except for fixing the expiry of certain time limits.

**1.4** For a valid declaration claiming priority, several conditions must be satisfied: the earlier application whose priority is claimed must have been made by the applicant or his predecessor in title; it must have been filed not more than 12 months before the filing date of the application; and it must have been made pursuant to any international treaty or any international Convention. It is to be noted that by Section 27(1A) the 12 months period cannot be extended.

The words "pursuant to any international treaty or any international Convention" mean that priority may be claimed from an earlier national, regional or international application. In practice this means that priority may be claimed from any application filed in a State adhering to the Paris Convention, a European application made under the European Patent Convention, or an application made under the Patent Cooperation Treaty. The earlier application may be for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate. So long as the contents of the application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the outcome of the application may later be; for example, it may subsequently be abandoned or refused.

**1.5** Normally the filing date of the "first application" must be claimed as a priority, i.e. the application disclosing for the first time any or all of the subject-matter of the application. If it is found that the application to which the priority claim is directed is in fact not the first application in the above sense, but some or all of the subject-matter was disclosed in a still earlier application originating from the same inventor, the priority claim is invalid as far as the subject-matter was already disclosed in the still earlier application.

**1.6** To the extent that the priority claim is invalid, the effective priority date of the application is the date of its filing as specified in Section 27A. The previously disclosed subject-matter of the application is not new, if the still earlier application referred to above was published prior to the effective priority date of the application (Section 14(2)(a)).

**1.7** Priority may be claimed from "one or more" earlier national, regional or international applications i.e. an application may claim rights of priority based on more than one earlier application.

## **2. Claiming priority**

**2.1** An applicant who wishes to claim priority must file a declaration of priority giving particulars of the previous filing, as specified in Regulation 21(1). If requested, the applicant must provide a certified copy of the previous application and, if necessary, a translation of it into either the national language or the English language (Regulation 22(3)).

**2.2** The date and State of any filing from which priority is claimed must be stated at the time of filing the application and the file number of the priority application must be indicated within 3 months from the date on which the application containing the declaration was filed. Where the earlier application is a regional or an international application, the name of the State or States for which it was filed must be stated. Where the copy of an earlier application has already been furnished for another application, the applicant may make a reference to that other application. Where a translation is required, this must be filed within 3 months from the date of the Registrar's request.

## **CHAPTER VI SUBSTANTIVE EXAMINATION PROCEDURE**

### **1. Introduction**

**1.1** This chapter sets out the general procedure for examination, together with guidance on particular matters where necessary. It does not provide instructions on matters of internal administration.

**1.2** Substantive examination is to be carried out in accordance with Section 30 and Regulation 27C. The examiner's first step is to study the description, drawings (if any) and the claims. In carrying out his task the examiner will have in the file the documents making up the application and a complete history of the proceedings up to the start of the examination. In particular this file will include the request for grant; description, drawings (if any) and the claims as originally filed; any amendments made as a result of the preliminary examination (see VI, 1.1); the request for substantive examination and the priority documents (if any) together with any translations (see V, 3), and any corresponding search examination results provided under Section 29A(4).

**1.3** A request for substantive examination must be filed within eighteen (18) months from the filing date of the application and this period may not be extended by the general provision under Section 82 because there is specific provision for deferment of the filing of a request for examination.

**1.4** Any person aggrieved by any decision or order of the Registrar may appeal to the Court. If a decision to refuse a patent is reversed on appeal, the application may be referred back to the examiner for further examination. In such a case, the further examination will normally be entrusted to the examiner who performed the original examination. The examiner is bound by the decision of the Court.

### **2. The request**

The following requirements have to be complied with when making a request for substantive examination.

- (a) the request must be made on form 5
- (b) the prescribed fee must be paid
- (c) the request must be filed within eighteen (18) months from the filing date of the patent application.

**2.2** The request must be filed within eighteen (18) months from the filing date of the application and this period may not be extended by the general provision for deferment of the filing of a request for examination.

### **3. Substantive requirements**

#### **3.1 General**

**3.1.1** Where a request for modified examination has been filed, the application is referred to an examiner who must determine whether or not the requirements designated as substantive requirements have been complied with and report the result of his determination to the Registrar.

**3.1.2** The designation of the substantive requirements is found in Regulation 27C(1) and (2):

"(1) The requirements of Sections 13 (non-patentable inventions) and 14(novelty), 15(inventive step), Part V(rights to a patent), and Sections 26(unity of invention), 26A(amendment of application), 26B(division of application), and 27(right of priority) of the Act and Regulations 7(2)(title of invention), 10(applicant's right to patent), 12(description), 13(claims), 14(dependent claims), 15(drawings), 16(abstract), 17(measures, terminology and signs), 21(declaration claiming priority) and 50(signatures by partnerships, companies and associations) shall be substantive requirements for the purposes of Section 30(1) of the Act.

(2) For the purpose of determining whether the application complies with the substantive requirements, in particular sections 14 and 15 of the Act, the examiner shall search such documents as the Registrar deems necessary."

**3.1.3** In connection with Section 14(2)(b) the examiner should bear in mind that no formal objection can be taken unless the application with the earlier priority date proceeds to grant. Therefore, wherever possible the earlier application should be examined first.

**3.1.4** When the examiner has studied and understood the claims (including any amended claims), he should make a search, including a search for any additional conflicting domestic applications falling within the area defined by Section 14(2)(b).

**3.1.5** Where the claims relate to more than one invention (see III, 7), the examiner will broadly indicate in his report each invention is defined. If it is clear from the specification what may be taken as the principal invention, a search will be made in respect of those claims defining that invention and substantive report issued in respect of that invention. The report should indicate that it relates to the principal invention only, clearly identifying that invention. In rare case, it is not clear which is the principle invention, and the first report, insofar as the specification is concerned, should in such cases be confined to the objection of lack of unity and the applicant is to be informed that all other issues are reserved pending the lodgement

of proposed amendments or advice as to what the applicant considers to be the principle invention. The applicant has the option of filing divisional applications under Section 26B(see IV, 6).

**3.1.6** Taking into account the documents (if any) found as the results of the search referred to in VI, 3.1.4 above, the examiner should identify any requirements of the Patents Act and Regulations specified in Regulation 27C as substantive requirements which, in his opinion, the application does not satisfy. He will then send a report to the applicant giving reasons for any objections he raises and inviting the applicant to file his observations or submit amendments within three months. When the applicant has replied, the examiner will then re-examine the application.

**3.1.7** Any person aggrieved by any decision or order of the Registrar may appeal to the Court. If a decision to refuse a patent is reversed on appeal, the application may be referred back to the examiner for further examination. In such case, the further examination will normally be entrusted to the examiner who performed the original examination. The examiner is bound by the decision of the Court.

#### **4. Patentability**

Section 13 is made a substantive requirement under Regulation 27C (see VI, 3.1.2). The examiner should therefore ensure that there are no claims for a non-patentable invention in the Malaysian application (see IV, 3).

#### **5. Amendments**

##### **5.1 Examination of amendments**

**5.1.1** Any amendment under Section 26A whether made to meet the examiner's objections or at the applicant's own volition must satisfy the following conditions:

- (a) It must not go beyond the disclosure in the initial application.
- (b) It must not itself cause the application as amended to be open to further objection; e.g. the amendment must not introduce obscurity.

If the amendments do not meet these conditions, the applicant should be told that the amendments cannot be allowed. Apart from the amendments referred to above, the applicant may apply to the Registrar for the correction of clerical errors or obvious mistakes under Section 79. (See IV, 5.4)

**5.1.2** If an amendment is filed, subsequent proceedings are based on the description, claims and drawings as amended. Consent to an amendment does not necessarily imply that the application is free from any objection under the Patent Act. Distinctions should be drawn between different types of amendments.

**5.1.3** Amendments remedying a deficiency in response to the preceding communication must always be allowed, provided they do not give rise to some new deficiency. Amendments limiting a claim already considered allowable should normally be allowed, as too should those improving the clarity of the description or claims in a manner clearly desirable.

**5.1.4** A further factor is the amount of alteration to the application documents involved. Extensive reworking of the description or claims may be a proper response to highly relevant prior art. Regarding less extensive amendments, the examiner should adopt a reasonable approach, trying to balance fairness to the applicant against the need to avoid unnecessary delay and excessive and unjustified additional work for the Office. Any subsequent request to withdraw an amendment is itself a request for further amendment.

**5.1.5** Once there is a version of the documents on the basis of which a patent could be granted, any request by the applicant to replace it with an extensively reworked version should be refused, unless he has supplied well-founded reasons why the amendment was not proposed before this stage in the proceedings, particularly if the examiner has indicated that a version of the claims proposed by the applicant is grantable and that the applicant has only to bring the description into line with that version.

## **5.2 Allowability of a amendments**

**5.2.1** The question of allowability of amendments is legally a question of whether the application as so amended is allowable. An amended application must of course satisfy all the requirements of the Patents Act and Regulations specified as being substantive requirements. Also, however, especially when the claims have been substantially limited, the examiner should bear in mind that the following questions may require special consideration at the amendment stage:

- (i) Unity of invention : and
- (ii) Agreement of description and claims.

## **5.3 Additional subject-matter**

**5.3.1** There is normally no objection to an applicant introducing, by amendment, further information regarding prior art, which is relevant; indeed this may be required by the examiner. Nor should objection be taken to the straight-forward clarification of an obscurity, or the resolution of an inconsistency. When, however, the applicant seeks to amend the description (other than references to the prior art), the drawings, or the claims in such a way that subject-matter which extends beyond the disclosure in the initial application is thereby introduced, the application as so amended cannot be allowed.

**5.3.2** An amendment should be regarded as introducing subject-matter which extends beyond the disclosure in the initial application, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or deletion) results in the person having ordinary skill in the art being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to such a person in what has been expressly mentioned. (See VI, 4.3.4). The test for additional subject-matter therefore corresponds closely to the test for novelty given in IV, 8.

**5.3.3** For example, if an application related to a rubber composition comprising several ingredients and the applicant seeks to introduce the information that a further ingredient might be added, then this amendment should normally be objected to as offending against Section 26A. Likewise, in an application which described and claimed apparatus "mounted on resilient supports" without disclosing any particular kind of resilient support, objection should be raised if the applicant seeks to add the specific information that the supports are, or could be, e.g. helical springs (see, however, VI, 2.6).

**5.3.4** If, however, the applicant can show convincingly that the subject-matter in question would, in the context of the invention, be so well-known to the person having ordinary skill in the art that its introduction could be regarded as an obvious clarification, the amendment may be permitted. For example, in the matter of the rubber composition referred to in VI, 4.3.3, if the applicant were able to show that the further ingredient which he sought to introduce was, say, a well-known additive normally used in rubber compositions of that kind as an aid to mixing and that its omission would generally be questioned, then its mention would be allowable on the grounds that it merely clarified the description and introduced nothing not already known to the person having ordinary skill in the art; however, if the introduction of this additive brought about some special effects not originally disclosed, an amendment mentioning this should not be allowed. Similarly in the above-mentioned case of the resilient supports, if the applicant were able to demonstrate that the drawings, as interpreted by the person having ordinary skill in the art, showed helical springs, or that such a person would only consider helical springs for the mounting in question, the specific mention of helical springs would be allowable.

**5.3.5** Amendment by way of the introduction of further examples should always be looked at very carefully in the light of the general considerations outlined in paragraphs 5.3.1 to 5.3.4 above. The same applies to the introduction of statements of advantages of the invention: for example, if the invention as originally presented related to a process for cleaning woollen clothing consisting of treating the clothing with a



particular fluid, the applicant should not be allowed to introduce later into the description a statement that the process also has the advantage of protecting the clothing against moth damage.

**5.3.6** However, later filed examples or statements of advantage even if not allowed into the application may nevertheless be taken into account by the examiner as evidence in support of the allowability of the claims in the application. For instance, an additional example may be accepted as evidence that the invention can be readily applied, on the basis of the information given in the originally filed application, over the whole field claimed.

**5.3.7** Alteration or deletion of parts of the text, as well as the addition of further text, may introduce fresh subject-matter. For instance, suppose an invention related to a multi-layer laminated panel, and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment of this example either to alter the outer layer to polypropylene, or to omit this layer altogether would not normally be allowable. In each case the panel disclosed by the amended example would be quite different from that originally disclosed and hence the amendment would introduce fresh subject-matter and therefore be unallowable.

#### **5.4 Correction of clerical errors and obvious mistakes**

An applicant may, on payment of the prescribed fee request the Registrar on Form 16 to amend the application or other document for the purpose of correcting a clerical error or an obvious mistake. It is questionable whether or not these amendments will be subject to the requirements of Section 26A. A request to correct any clerical error or obvious mistake should be accompanied by a statement or declaration by the relevant person setting out the facts of the particular case and why discretion should be exercised in the applicant's favour.

A clerical error means a mistake in the course of some process such as word processing or photo-copying as distinct from lack of knowledge or use of incorrect information. An obvious mistake must be obvious in the sense that it is immediately evident from the documents as a whole (at least once attention is directed to the matter):

- (a) that an error has occurred; and
- (b) what correction should be made.

#### **5.5 Amendment of patents**

Section 79A provides for the amendment of any patent document for any reason. However, amendments are not allowable which would result in the introduction of new matter or which would result in extending the scope of the claims.

The comments above (relating to amendment of applications) concerning the introduction

of new matter also apply to amendment of patents. With regard to Checking whether or not the amendments extend the scope of the claims, a useful test is to ask the question " would the amendment make anything an infringement which would not have been an infringement before the amendment ". The introduction into the claim of features of an existing subsidiary claim, or features disclosed in the specification but not already claimed will normally narrow or restrict the scope of the claims, and should therefore be allowable.

## **6. Divisional applications**

**6.1** Subsequent to the filing of an application, a divisional application may be filed. Its subject-matter shall not go beyond the disclosure in the initial application. The divisional application is accorded the filing date of its lodgement, and has the benefit of any right of priority of the initial application in respect of the subject-matter contained in the divisional application. An application may give rise to more than one divisional application. The examination of the divisional application is normally carried out as soon as possible and given to the Examiner of the parent application.

**6.2** If a divisional application contains subject-matter additional to that contained in the initial application and the applicant is unwilling to remedy this defect to remove that additional subject-matter, the divisional application must be refused.

**6.3** The most common reason for filing a divisional application is to meet an objection under Section 26 or lack of unity of invention. If the examiner objects that the application does not meet the requirements of Section 26, the applicant is allowed to limit his application to a single invention. It is important that the limitation of the initial application is clear and unconditional. The communication inviting the applicant to limit the application due to lack of unity should include a reference to the fact that if the application is not limited the application may be refused.

**6.4** In some cases of unclear or conditional limitations e.g. where the matter of division is somewhat complex, it may be appropriate for the examiner to send the applicant a further communication inviting the applicant to make the limitation clear and unconditional and informing him that further substantive examination of the initial application will be deferred until this requirement has been met.

**6.5** The applicant may file a divisional application(s) for the subject matter deleted from the initial application if he wishes to obtain protection for the subject matter.

**6.6** In accordance with Regulation 19A, a divisional application to overcome an examiner's objection, must be filed within 3 months of the examiner's adverse report. A voluntary

divisional may be filed not later than 3 months of the examiner's first report.

**6.7** In most cases divisional applications will be filed at the same time as amendments to the initial application are submitted e.g. with claims to the subject-matter of the divisional removed, but it would be allowable for an applicant to file divisional applications after amending the initial application provided they are filed within the three months allowed under Regulation 19A (a) or (b).

**6.8** The examination of a divisional application should be carried out exactly as for any other application. Comparison of the divisional application with the initial application is necessary, however, to ensure that, as far as possible each application describes only the matter coming within the ambit of its claims. The same comparison should be made between divisional applications where there is more than one. When it is necessary for one application to describe matter claimed by another application (e.g. the description of one of the inventions may not be understandable without a description of the other invention), it must include a cross-reference to that other application. The cross-reference should make it clear that the matter in question is claimed in the other application.

**6.9** Even though the claims of a divisional application need not be limited to subject-matter already claimed in claims of the initial application, they nevertheless must be in respect of subject-matter not going beyond the disclosure of the initial application.

## **CHAPTER VII MODIFIED EXAMINATION**

### **1. Introduction**

**1.1** Modified substantive examination is an effective short-cut to processing a patent application through to grant by making as much use as possible of any search or examination already carried out by a foreign Patent Office on a corresponding patent application for the same invention. In this way no attempt is made to duplicate work already done by competent authorities employing highly skilled and experienced examiners with extensive database resources.

**1.2** The procedure has been adopted in a number of countries, and there is legislative authority for it in Section 29A(2):

If a patent or other title of industrial property protection has been granted to the applicant or his predecessor in title in a prescribed country outside Malaysia or under a prescribed treaty or Convention for an invention which is the same or essentially the same as the invention claimed in the application, the applicant may, instead of requesting for a substantive examination, request for a modified substantive examination.

**1.3** The prescribed countries are Australia, the United Kingdom and the United States of America and Japan. The only prescribed treaty or Convention is the European Patent Convention.

**1.3.1** A request for Modified Substantive examination with Japan as a prescribed country must be filed on or after 1 July 2002.

**1.3.2** A request for Modified Substantive examination with Republic of Korea as a prescribed country must be filed on or after 19 June 2003.

### **2. The request**

**2.1** The following requirements have to be complied with when making a request for modified examination.

- (a) the request must be made on form 5A
- (b) the prescribed fee must be paid
- (c) the request must be filed within 18 months from the filing date of the patent application.
- (d) the request must be accompanied by a certified copy of the patent granted in ONE of the prescribed country together with a certified translation into English if the patent is not in that language.

(e) the request must be accompanied by amendments to bring the description, claims and drawings of the patent application into conformity with those of the granted patent if they are not, apart from matters of form, substantially the same.

**2.2** A request for modified substantive examination must be filed within 18 months from the filing date of the application and this period may not be extended by the general provision under Section 82 because there is specific provision for deferment of the filing of a request for examination.

### **3. Substantive requirements**

#### **3.1 General**

**3.1.1** Where a request for modified examination has been filed, the application is referred to an examiner who must determine whether or not the requirements designated as substantive requirements have been complied with and report the result of his determination to the Registrar.

**3.1.2** The designation of the substantive requirements is found in Regulation 27D(1) and (2):

(1) The requirements of Sections 13 (non-patentable inventions) and 14 (novelty), Part V (rights to a patent), and Sections 26A (amendments of application), 26B division of application, and 27 (right of priority) of the Act and Regulations 10 (applicant's right to patent), 21 (declaration claiming priority) and 50 (signatures by partnerships, companies and associations) shall be substantive requirements for the purposes of Section 30(2) of the Act.

(2) In addition, it shall also be a substantive requirement that the description, claims and drawings of the invention claimed in the application, whether as filed or as amended under the Act or these Regulations, apart from matters of form, shall be the same or substantially the same as the description, claims and drawings of the invention granted a patent or other title of industrial property protection by the prescribed country or under the prescribed treaty or Convention.

#### **3.2 Patentability**

Although there are no major differences between the types of invention which are patentable under the laws of Malaysia and the prescribed countries and the EPC (European Patent Convention), it is possible that a patent may be granted in a prescribed country with claims directed to an invention which is not patentable in Malaysia. Section 13 is made a substantive requirement under Regulation 27D (1). The examiner should therefore ensure that there are no claims for a non-patentable invention in the Malaysian application. See also paragraph 3.3.3 below.

### **3.3 Conformity between application and foreign patent**

**3.3.1** It is a substantive requirement under Regulation 27D(2) that:

the description, claims and drawings of the invention claimed in the application, whether as filed or as amended, under the Act or these Regulations apart from matters of form, shall be the same or substantially the same as the description, claims and drawings of the invention granted a patent or other title of industrial property protection [the foreign granted patent] by the prescribed country or under the prescribed treaty or Convention.

and it is also a mandatory requirement of Regulation 27A(3)(b) that the request for modified examination must be accompanied by any required amendments to bring the description, claims and drawings of the patent application into conformity with those of the foreign granted patent.

The following paragraphs 3.4.2 to 3.4.5 provide guidance on how these requirements, and in particular the words "substantially the same" and "into conformity" should be interpreted.

**3.3.2** The primary consideration to bear in mind is the one which is fundamental to the reason for adopting modified examination, namely that it is inefficient to go through the whole process of examining a patent application if it claims an invention for which a patent has already been granted elsewhere by a competent authority. Minor differences in the wording of the claims of the application and the granted patent may be allowed provided they do not result in the respective claims having different scope.

**3.3.3** Notwithstanding the last sentence of paragraph 3.4.2 above, there may be occasions when major differences between the claims of the patent application and the claims of the granted patent may be allowable or even essential under modified examination. For example, claims to a method for treating the human body by surgery which are not patentable under Malaysian law must not be included in a Malaysian patent application even if they have been allowed in a patent granted elsewhere.

**3.3.4** Other examples of where differences between the description, claims and drawings of the patent application and the granted foreign patent may be allowable or essential are when the differences are necessary :

- (i) to correct an obvious mistake in the granted patent,
- (ii) to meet a formal requirement of the Malaysian patent Regulations,
- (iii) to include reference numerals or a "characterising" clause in a claim at the applicant's choice, or
- (iv) to delete an "omnibus" claim.

**3.3.5** The considerations of paragraphs 3.4.2 to 3.4.4 above apply equally to applications as filed and to amendments which accompany a request for a modified examination or are filed subsequently to such a request. No amendment should be allowed at any time which would result in a patent application on which a request for a modified substantive examination has been filed not being in substantial conformity with the foreign granted patent, except under the special circumstances outlined in paragraphs 3.3.3 and 3.3.4 above.

### **3.4 Amendments**

**3.4.1** The applicant may amend the application provided that the amendment shall not go beyond the disclosure in the initial application. It is highly unlikely that any amendment filed to bring an application on which modified examination has been requested into conformity with a granted foreign patent would introduce new matter, but examiners should be on the alert for any case where the Malaysian application is based on an original application which has not proceeded to grant. For example, a Continuation-in-Part US patent containing added matter may be granted or an original application may be withdrawn and a patent granted on a new application which contains added matter. It is therefore important always to check that the granted patent on which modified examination is based and the Malaysian application are both derived directly from the same foreign application. Any amendment to bring the Malaysian application into conformity with a patent derived from some other application should be checked very carefully for added matter.

**3.4.2** The only remedy when added matter is found in the check referred to in paragraph 3.5.1 above would appear to be to file a request for substantive examination of the unamended Malaysian application under Section 29A(1) if this is still possible within the prescribed period for filing such a request or within any period of deferment which has already been granted.

### **3.5 Division of application**

**3.5.1** The only occasion when this may be allowed under modified examination is when the original foreign application has been divided. Normally the Malaysian application will have been divided before a request for modified examination has been filed - in effect a voluntary division of the application within the period allowed under Regulation 19A(b).

**3.5.2** Separate requests for modified examination in respect of individual parent and

divisional Malaysian applications must be made, each request being accompanied by a copy of the corresponding granted foreign patent and any necessary translations and amendments to bring each application into conformity with the corresponding granted foreign patent.

**3.5.3** There are several possibilities in that the applicant may choose to:

(a) divide the Malaysian application in the same manner as the foreign application was divided, ie there is a Malaysian application corresponding to each of the foreign parent and divisional applications,

(b) proceed with a single Malaysian application which may correspond to either the parent granted foreign patent (with or without matter from the original application having been excised) or any one of the granted divisionals, or

(c) proceed with several Malaysian applications corresponding to any selection from the granted foreign patents.

**3.5.4** Each application in a divided set of applications should be treated as a separate application on which modified examination has been requested and modified examination should be carried out as explained in Chapters I to III, but in addition any cross-references between the applications should be checked and if necessary amended so that they properly refer to the appropriate Malaysian application.

### **3.6 Declaration of priority**

Each initial Malaysian application for which a request for modified examination should contain a declaration of priority from an earlier foreign application. Any divisional application for which modified examination is requested will be accorded a filing date and the benefit of any right of priority of the initial application, subject to confirmation by the Director, as set out in paragraph VI, 6.1. The requirements of Regulation 21 apply to divisional applications on which modified examination has been requested in the same way as they apply to divisionals for which substantive examination under Section 29A (1) has been requested.



## **CHAPTER VIII UTILITY INNOVATIONS**

### **1. Introduction**

**1.1** The provisions of the Act apply to applications for a certificate for a utility innovation in the same way as they apply to an application for the grant of a patent except that, as provided by Section 17A, Sections 11 and 15 (inventive step), 26 (unity of invention) and certain other provisions relating to granted patents do not apply to utility innovations, and certain provisions relating to applications for patents are modified in respect of utility innovations by the Second Schedule to the Act.

**1.2** The definition of "invention" given by Section 12:

An invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.

applies unmodified to utility innovations. Section 13 as modified by the Second Schedule in respect of utility innovations makes it clear that the same items as are excluded from being patentable are also excluded from being eligible for a certificate for a utility innovation.

Section 17 defines utility innovation as:

any innovation which creates a new product or process, or any new improvement of a known product or process, which can be made or used in any kind of industry, and includes an invention.

The proper interpretation of this provision may be open to some argument as to whether a utility innovation may or must include an invention as defined by Section 12. Until such time as the Court may decide otherwise, the latter interpretation is to be adopted for the reasons explained in IV, 4.5.5. Therefore, an application for a certificate for a utility innovation should be refused if the innovation claimed does not include an invention. In other words, as with patent applications, there must be novelty of a technical nature which provides the solution to a specific problem in the field of technology, the only difference being that inventive step is not a consideration with regard to utility innovations.

**1.3** It is also to be noted that the unity of invention requirement of Section 26 is not applied to utility innovations.

### **2. Examination of applications for utility innovations**

**2.1** Inventive step is not a requirement for an application for a certificate for a utility innovation. However, meeting the strictly narrow interpretation of novelty alone is not sufficient to justify grant of a certificate for a utility innovation because section 17 requires the presence of an invention as well as novelty. Since

invention is defined in Section 12 as an idea which permits in practice the solution of a specific problem in the field of technology, it follows that a certificate for a utility innovation should not be granted for an innovation in which the only novelty lies in the substitution of a well-known equivalent for an element in a product or process or in the addition of some other feature, e.g. decoration, which produces no technical effect and does not solve any technical problem. It must be stressed however that, there being no requirement for inventive step in a utility innovation, objection should only be raised on the grounds that there is no invention within the meaning of Section 12 when a very well-known equivalent element (e.g. part of the common general knowledge found in text books) has been substituted for an element in a known product or process or a feature added to a known product or process clearly has no technical effect. In many instances the claim presented will be narrow and detailed, containing many points of difference from the closest prior art and the description will give an indication of any problem addressed by the innovation and whether or not that problem is of a technical nature. In such cases it should be relatively easy to decide whether an invention is present, but in borderline cases the benefit of any doubt should be given to the applicant.

**2.2** The requirement for a single claim in an application for a certificate of utility innovation would normally mean that there would be no more than one invention claimed. However, a single claim may contain alternatives, and if the number or nature of these is such as to make the scope of the claim unclear, objection should be raised.

### **3. Conversion between application for a patent and application for a certificate for a utility innovation**

**3.1** An application for a patent may be converted under the provisions of Section 17B and Regulation 33C into an application for a utility innovation and, similarly, an application for a utility innovation may be converted into an application for a patent. Any request for conversion must be filed not later than six months from the date of the examiner's first report under Section 30(1) or (2). If an application is converted, the converted application is deemed to have been filed at the time the initial application was filed.

The administrative section will deal with the conversion under Regulation 33C. The application should then be forwarded as soon as possible to the Examiner for completion of the examination.

**3.2** A patent and a certificate for a utility innovation cannot both be granted to the same applicant for the same subject matter. Thus, for example, if an applicant has already obtained a certificate for a utility innovation for the same subject matter as a subsequent patent application, then the patent application cannot proceed to

grant unless the certificate is surrendered.