

**MALAYSIA**

**Patents Regulations**

as amended by P.U. (A) 48/2011

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## **PART I PRELIMINARY**

### **1. Citation and commencement.**

These Regulations may be cited as the Patents Regulations 1986 and shall come into force on the 1 October 1986.

### **2. Fees.**

(1) The fees to be paid in respect of all matters arising under the Act and these Regulations shall be as specified in Schedule I.

(2) The fees shall be paid to the Patents Registration Office by such means and in such manner as the Registrar may direct.

### **3. Forms.**

The forms referred to in these Regulations are those set out in Schedule II.

## **PART II APPLICATION AND PROCEDURE FOR GRANT AND DURATION OF PATENT**

### **4. Interpretation.**

In this Part, unless the context otherwise requires, "application" means an application for the grant of a patent and "applicant" shall be construed accordingly.

### **5. Application for grant of patent.**

(1) An application shall contain-

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

(2) The application shall be filed at the Patent Registration Office.

### **5A. Filing of an international application.**

(1) An international application shall be filed in three copies.

(2) Where an international application is filed in less than three copies, the Patent Registration Office shall prepare the additional copies required and the application shall pay to the Patent Registration Office the prescribed fees for preparing such additional copies.

### **6. Name and declaration of inventor.**

(1) The application shall contain the name and address of the inventor.

(2) An inventor who does not wish to be named in a patent may, by declaration in writing signed by him and submitted to the Registrar, indicate that he does not wish to be so named.

### **7. Request for the grant of a patent.**

(1) A request for the grant of a patent shall be made to the Registrar on Form 1 together with the payment of the prescribed fee.

(2) The title of the invention shall indicate clearly and concisely the subject-matter to which the invention relates.

### **8. Names and addresses.**

Names and addresses given in the application shall in all cases be the

full names and addresses.

**9. Nationality and residence.**

(1) The applicant's nationality shall be indicated by the name of the State of which he is a national or, if the applicant is not a natural person, the name of the State under whose laws it is constituted.

(2) The applicant's residence shall be indicated by the name of the State of which he is a resident.

**10. Applicant's right to patent.**

(1) Where the applicant is the inventor, the request shall state that fact.

(2) Where the applicant is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent.

(3) For the purposes of subregulations (1) and (2), the request shall be made in Form 22 and shall be submitted together with Form 1 and Form 17.

**11. Common representative.**

If an application is submitted by more than one applicant and the applicants have not appointed a patent agent to represent all of them-

(a) the request shall designate one of the applicants as their common representative; or

(b) if the request does not designate one of the applicants as their common representative, the applicant first named in the request shall be considered the common representative.

**12. Description.**

(1) The description shall first state the title of the invention as appearing in the request and shall-

(a) specify the technical field to which the invention relates;

(b) indicate the background art which, as far as is known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and wherever possible, cite the documents reflecting such art;

(c) disclose the invention in such terms that it can be understood and in a manner sufficiently clear and complete for the invention to be evaluated and to be 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;

(d) briefly describe figures in the drawings, if any;

(e) describe the best mode contemplated by the applicant for carrying out the invention, using examples where appropriate and referring to the drawings, if any; and

(f) indicate explicitly, when it is not obvious from the description or nature of the invention, 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.

(2) The description shall be presented in the manner and order specified in subregulation (1) 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) The description shall not contain drawings.

### **13. Claims.**

(1) The claims shall be clear and concise and fully supported by the description; and the number of the claims shall be reasonable taking into consideration the nature of the invention.

(2) If there are several claims they shall be numbered consecutively in Arabic numerals.

(3) Claims shall not contain drawings and shall not, unless necessary, rely, in respect of the technical features of the invention, on references to the description or drawings.

(4) Where the application contains drawings, the technical features mentioned in the claims shall, wherever possible be followed by reference signs relating to such features and placed between parentheses, subject to the following:

(a) reference signs which do not particularly facilitate quicker understanding of a claim should not be included;

(b) the same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs.

(5) The claims shall define the invention in terms of the technical features of the invention.

(6) Whenever appropriate, claims shall contain-

(a) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art;

(b) a characterizing portion, preceded by the words "characterized in that", "characterized by", "wherein the improvement comprises", or any other words to the same effect stating concisely the technical features which, in combination with the features stated under paragraph (a), it is desired to protect.

#### **14. Dependent claims.**

(1) Any claim which includes all the features of one or more other claims ("dependent claim") shall contain, if possible at the beginning, a reference to the other claim or claims and shall then state the additional features claimed.

(2) [Deleted]

(3) A dependent claim shall be construed as including all the limitations contained in the claims to which it refers or, if the dependent claim is a multiple dependent claim, all the limitations contained in the particular claim in relation to which it is considered.

(4) All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most practical way possible.

#### **15. Drawings.**

(1) Subject to subregulation (2), drawing shall be required when they are necessary for the understanding of the invention.

(2) Notwithstanding subregulation (1), where the nature of the invention admits of illustration by drawings the applicant may include drawings in the application when filed.

(3) Flow sheets and diagrams shall be considered drawings for the purposes of these Regulations.

#### **16. Abstract.**

(1) The abstract shall commence with a title for the invention.



(2) The abstract shall contain-

(a) a summary of the disclosure as contained in the description and the claims and drawings, if any; and

(b) where applicable, the chemical formula which, among all the formulae contained in the application, best characterizes the invention.

(3) The summary mentioned in subregulation (2) (a) shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention.

(4) The abstract shall be as concise as the disclosure permits and shall preferably not contain more than one hundred and fifty words.

(5) The abstract shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(6) Each main technical feature mentioned in the abstract and illustrated by a drawing in the application shall be followed by the reference sign used in that drawing placed between parentheses.

(7) The abstract shall not contain drawings but shall be accompanied by the most illustrative of any drawings furnished by the applicant.

(8) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the description, the claims or the drawings.

## **17. Measures, terminology and signs.**

(1) Units of weight and measures shall be expressed in terms of the metric system.

(2) Temperatures shall be expressed in degrees Celsius.

(3) Densities shall be expressed in metric units.

(4) For heat, energy, light, sound, and magnetism, as well as for mathematical formulae and electrical units, the rules of international practice shall be observed.

(5) For chemical formulae, the symbols, atomic weights, and molecular formulae in general use shall be employed.

(6) In general, only such technical terms, signs and symbols as are generally accepted in the field in question should be used.

(7) The terminology and the signs shall be consistent throughout the application.

#### **18. Physical requirements.**

(1) Unless provided otherwise, the application and any accompanying statements or documents shall be filed in duplicate, but the Registrar may require that they be filed in more than two copies.

(2) All documents of the application shall be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset and microfilming.

(3) All sheets shall be free from cracks, creases and folds and only one side of each sheet contained in the application shall be used.

(4) All documents of the application shall be on A4 paper (29.7 cm x 21 cm) which shall be strong, white, smooth, non-shiny and durable.

(5) Notwithstanding subregulation (4), the Registrar may accept sheets of sizes other than A4.

(6) The minimum margins of sheets shall be 2 cm.

(7) All sheets shall be numbered at the top of the sheet and in the middle, in consecutive Arabic numerals.

(8) The text matter of the application shall be typed or printed in a dark, indelible colour in at least 1 1/2 line spacing, but graphic symbols, chemical or mathematical formulae and certain characters may, if necessary, be hand written or drawn.

(9) In the application, every fifth line of each sheet of the description and the claims shall be numbered in Arabic numerals placed to the left of the relevant lines but to the right of the margin.

(10) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes without colouring.

(11) The application and any associated statement or document shall be filed in the national language or in the English language.

#### **19. Unity of invention.**

(1) For the purposes of section 26 of the Act, the same patent application may include-

(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 an apparatus or means specifically designed for carrying out the process.

(2) Subject to section 26 of the Act, an application may contain two or more independent claims of the same category which cannot be covered readily by a single generic claim.

(3) Subject to section 26 of the Act, an application may contain a reasonable number of dependent claims claiming specific forms of the invention claimed in an independent claim even when the features of any dependent claim could be considered as constituting in themselves an invention.

#### **19A. Division of application.**

For the purposes of section 26B(1) of the Act-

(a) where an application is divided pursuant to an objection in an Examiner's report made under section 30(1) or 30(2) of the Act for non-compliance with section 26 of the Act, the request for the division of the application shall be made within three months from the date of mailing of such report;

(b) in any other case, the applicant may, of his own volition, request for the division of the application not later than three months from the date of mailing of the Examiner's first report made under section 30(1) or 30(2) of the Act.

**20. Disclosures to be disregarded for prior art purposes.**

An applicant shall state in the request or at any other time any disclosure which he is aware of and which in his opinion should be disregarded for prior art purposes under section 14(3) of the Act and shall state the facts in an accompanying statement.

**21. Declaration claiming priority.**

(1) A declaration claiming priority under section 27(1) of the Act shall state-

- (a) the date of each earlier application;
- (b) subject to subregulation (2), the number of each earlier application;
- (c) subject to subregulation (3), the symbol, if any, of the International Patent Classification which has been allocated to each earlier application;
- (d) the name of the State in which each earlier application was filed or, where the earlier application is a regional or an international application, the name of the State or States for which it was filed; and
- (e) where the earlier application is a regional or an international application, the office with which it was filed.

(2) Where at the time of filing the declaration referred to in subregulation (1) the number of any earlier application is not known, that number shall be furnished within three months from the date on which the application containing the declaration was filed.

(3) When a symbol of the International Patent Classification has not been allocated to the earlier application or had not yet been allocated at the time of filing the declaration referred to in subregulation (1), the applicant shall state this fact in the declaration.

(4) Where the priorities of two or more earlier applications are claimed in accordance with subregulation (1), the information relating to those earlier applications may be included in a single declaration.

(5) [Deleted]

**22. Copy of earlier application.**

(1) Where section 27(2) of the Act applies, the applicant shall furnish the certified copy of each earlier application within three months from the date of the Registrar's request.

(2) Where the copy referred to in subregulation (1) has already been

furnished for another application, the applicant may make a reference to that other application.

(3) Where the earlier application referred to in subregulation (1) is in a language other than the national language or the English language, the Registrar may require the applicant to furnish him, within three months from the date of the Registrar's request, with a translation of the earlier application in the national language or in the English language.

### **23. Corrections in declaration claiming priority.**

(1) If the Registrar finds that the requirements of regulations 21 and 22 have not been complied with he shall request the applicant to file the required particulars, documents or corrections within three months from the date of the request.

(2) If the applicant does not comply with the request referred to in subregulation (1), the Registrar shall inform the applicant in writing that the declaration is deemed to be invalid under section 27(4) of the Act and shall state the reasons.

### **24. Withdrawal of application.**

(1) An applicant may withdraw his application by a declaration on Form 2 addressed to the Registrar and signed by the applicant or his agent so authorized for that specific purpose.

(2) In the case of several applicants the declaration referred to in subregulation (1) shall be signed by all the applicants or on behalf of all the applicants by their agent so authorized for that specific purpose.

(3) Where a declaration is signed by an agent, such declaration shall be accompanied by the letter authorizing him to sign the declaration.

### **25. Filing date.**

(1) When the Registrar records the filing date of the application he shall send to the applicant a certificate of filing in the form of a copy of the request with the filing date and application number marked thereon.

(2) The required correction under section 28(2) of the Act shall be filed within three months from the date of the Registrar's request.

(3) Where the Registrar treats the application as invalid in accordance

with section 28(3) of the Act, he shall inform the applicant in writing of the reasons.

(4) The drawings under section 28(4) of the Act shall be furnished within three months from the date of the Registrar's request.

#### **25A. Entering the national phase.**

(1) An international application entering the national phase under section 780 or 780A shall be subject to the prescribed fees which shall be paid by using Patents Form No. 2A.

(2) An application shall be deemed to have fulfilled the requirement of section 780(1) (a) or 780A(1) (a), as the case may be, if the international application in the English language has been made available by the International Bureau to the Patent Registration Office.

#### **26. Preliminary examination.**

(1) The requirements of regulations 5, 6, 7(1), 8, 9, 10, 11, 18 and 51 shall be formal requirements for the purposes of section 29(1) of the Act.

(2) Where section 29(2) of the Act applies, the Registrar shall notify the applicant of his findings and the applicant shall make any observation on such finding or any amendment to the application or both within three months from the date of mailing of the Registrar's notification.

#### **27. Request for substantive examination.**

(1) A request for a substantive examination shall be made to the Registrar on Form 5 together with the payment of the prescribed fee within eighteen months from the filing date of the application.

(1A) Notwithstanding subregulation (1), a request for a substantive examination of an international application which has entered the national phase shall be made to the Registrar in Patents Form No. 5 together with the payment of the prescribed fee within four years from the filing date of the international application.

(2) Where an application is divided under regulation 19A, a further request for a substantive examination shall be made at the time of the filing of the request for the division of the application.

(3) A request for a substantive examination shall, where appropriate, be accompanied by-

(a) information relating to the application number and filing date of any application for a patent or other title of industrial property protection filed with any prescribed industrial property office relating to the same or essentially the same invention as that claimed in the application;

(b) information relating to the number assigned to a patent or other title of industrial property protection granted for the same or essentially the same invention as that claimed in the application by any prescribed industrial property office;

(c) the results of any searches or examinations carried out by any prescribed industrial property office relating to the same or essentially the same invention as that claimed in the application and where the results of any searches or examinations are not in the English language, a certified translation in the English language of such search or examination.

(4) The Registrar may waive, as he deems fit, any requirement under subregulation (3).

(5) Where an application is deemed to be withdrawn under section 29A(5) of the Act, the Registrar shall inform the applicant in writing of that fact and shall state the reasons therefor.

(6) For the purposes of these Regulations, "prescribed industrial property office" means the Patent Office of Australia, the Patent Office of Japan, the Patent Office of the Republic of Korea, the Patent Office of the United Kingdom, the Patent Office of the United States of America or the European Patent Office, as the case may require, in its capacity as a national office or, where appropriate, as an International Searching Authority or as an International Preliminary Examination Authority under the Patent Cooperation Treaty.

#### **27A. Request for modified substantive examination.**

(1) A request for a modified substantive examination shall be made to the Registrar on Form 5A together with the payment of the prescribed fee within eighteen months from the filing date of the application.

(1A) Notwithstanding subregulation (1), a request for a modified substantive examination of an international application which has entered the national phase shall be made to the Registrar in Patents Form No.

5A together with the payment of the prescribed fee within four years from the filling date of the international application.

(2) Where an application is divided under regulation 19A, a further request for a modified substantive examination shall be made at the time of the filing of the request for the division of the application.

(3) A request for a modified substantive examination shall be accompanied by-

(a) a certified true copy of the patent or other title of industrial property protection granted to the applicant or his predecessor in title in the prescribed country or under the prescribed treaty or Convention, and where the patent or other title of industrial property protection is not in the English language, a certified translation in the English language thereof;

(b) where the description, claims or 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 are not, apart from matters of form, substantially the same as the description, claims or drawings of the invention claimed in the application, the amendments required for the purpose of bringing them into conformity.

(4) Where an application is deemed to be withdrawn under section 29A(5) of the Act, the Registrar shall inform the applicant in writing of that fact and shall state the reasons therefor.

(5) For the purposes of these Regulations-

"prescribed country" means Australia, Japan, the Republic of Korea, the United Kingdom or the United States of America, as the case may require;

"prescribed treaty or Convention" means the European Patent Convention.

**27B. Deferment of filing of request for substantive examination and modified substantive examination.**

(1) A request for a deferment of the filing of a request for a substantive examination under regulation 27 or a modified substantive examination under regulation 27A or a deferment of the provision of information or documents required under regulation 27(3) shall be made to the Registrar on Form 5B.

(2) For the purposes of section 29A(7) of the Act, the maximum period of deferment allowed-



(a) subject to regulation 27B(3), for the filing of a request under regulation 27 or regulation 27A, shall be five years from the filling date of the application; and

(b) for the provision of the information or documents required under regulation 27(3), shall be five years from the filing date of the application.

(3) Where the application is unable to file in a request for a modified substantive examination within the time period specified in paragraph (a) of subregulation (2), the application may file in a request for a substantive examination within three months from the expiry of the time period specified in that paragraph.

#### **27C. Substantive examination.**

(1) The requirements of sections 13, 14, 15 and 16, Part V, and sections 26, 26A, 26B and 27 of the Act and regulations 7(2), 12 to 17, 21 and 50 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) Upon receipt of the Examiner's report under section 30(1) (b) of the Act, the Registrar may request the Examiner to conduct a further search or other investigation to determine whether the requirements of sections 14 and 15 of the Act have been satisfied and subregulation (2) shall apply in relation to such further search or other investigation.

(4) Where section 30(3) of the Act applies, the Registrar shall send a copy of the Examiner's report to the applicant and the applicant shall make any observation on such report or any amendment to the application or both within two months from the date of mailing of the report.

(5) Where the applicant makes any observation on the Examiner's report or any amendment to the application or both within the prescribed period, the Registrar shall refer them to the Examiner who shall report his determination to the Registrar.

(6) [Deleted]

**27D. Modified substantive examination.**

(1) The requirements of sections 13 and 14, Part V, and sections 26A, 26B and 27 of the Act and regulations 21 and 50 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) For the purpose of determining whether the application complies with the substantive requirements, in particular section 14 of the Act, the Examiner shall search such documents as the Registrar deems necessary.

(4) Upon receipt of the Examiner's report under section 30(2) (b) of the Act, the Registrar may request the Examiner to conduct a further search or other investigation to determine whether the requirements of section 14 of the Act have been satisfied and subregulation (3) shall apply in relation to such further search or other investigation.

(5) Where section 30(3) of the Act applies, the Registrar shall send a copy of the Examiner's report to the applicant and the applicant shall make any observation on such report or any amendment to the application or both within two months from the date of mailing of the report.

(6) Where the applicant makes any observation on the Examiner's report or any amendment to the application or both within the prescribed period, the Registrar shall refer them to the Examiner who shall report his determination to the Registrar.

(7) [Deleted]

**27E. Expedited Examination.**

(1) An applicant who requests or has requested for substantive examination under regulation 27 may request the Registrar to undertake an expedited examination of the application once it has been made available for public inspection under section 34 of the Act.

(2) A request for expedited examination shall be made to the Registrar in Form 5H and shall be accompanied with—

- (a) a statutory declaration stating the reasons for requesting the expedited examination; and
- (b) the prescribed fee.

(3) If an applicant has requested for an expedited examination, the Registrar may do so if the Registrar is reasonably satisfied that—

- (a) it is in the national or public interest;
- (b) there are infringement proceedings taking place or evidence showing potential infringement with regards to the patent being applied;
- (c) the applicant has already commercialized the invention or plan to commercialize the invention within two years from the filing date of a request for expedited examination under this regulation;
- (d) application for grant of the patent is a condition to obtain monetary benefits from the Government or institutions recognized by the Registrar;
- (e) the invention relates to green technologies that will enhance the quality of the environment or conservation of energy resources; or
- (f) there are other reasonable grounds which support the request.

(4) The Registrar shall notify the applicant in writing, as soon as practicable after making his decision, whether the expedited examination shall be conducted or not.

(5) If the Registrar is satisfied that a request for an expedited examination of the application is warranted, the applicant shall, within five working days from the date of receipt of the Registrar's decision in subregulation (4), file Form 5I and pay the prescribed fee.

(6) For the purpose of substantive examination of the application, if the Examiner reports that any of the requirements referred to in subsections 30(1) and (2) of the Act was not complied with, the Registrar shall give the applicant an adverse report to explain to the applicant the requirements which were not complied with and the applicant shall be given one opportunity to make observations on the report and to amend the application as to comply with those requirements within three weeks from the date of the issuance of the adverse report by the Registrar.

(7) If the applicant fails to amend the application within the time stipulated under subregulation (6), the request for expedited examination is deemed to be withdrawn.

## **28. Notification of refusal of application.**

Where an application is refused under section 29(2), 30(3), 30(6), 31(1) or 85 of the Act, the Registrar shall notify the applicant in writing of that decision and shall state the reasons therefor.

## **29. Certificate of grant of patent.**

(1) The certificate of the grant of a patent referred to in section 31(2) (a) of the Act shall contain-

- (a) the number of the patent;
- (b) the name and address of the owner of the patent;
- (c) the name of the inventor (except where he has indicated he does not wish to be named);
- (d) the filing date and the priority date, if any, of the application;
- (e) the date of the grant of the patent; and
- (f) the title of the invention; and
- (g) the date the certificate of grant of the patent is issued.

(2) [Deleted]

## **30. Contents of patent.**

The patent granted pursuant to section 31(2) of the Act shall contain-

- (a) the number of the patent;
- (b) the name and address of the owner of the patent;
- (c) the name and address of the inventor (except where he has indicated he does not wish to be named);
- (d) the name and address of the agent, if any;
- (e) the filing date of the application;
- (f) the priority date of the application, if any, and the name of the country or countries in which or for which the earlier application was filed;
- (g) the date of the grant of the patent;
- (h) the title of the invention;
- (i) the symbol of the International Patent Classification;
- (j) the abstract;
- (k) the description;
- (l) the claims; and
- (m) all the drawings, if any.

## **31. Register.**

(1) The Register shall be kept in such form and on such medium as the Registrar may determine.

(2) The Register shall contain the particulars specified in paragraphs (a) to (j) of regulation 30.

**31A. Request for certified copies of or extracts from Register, etc.**

A request for certified copies or extracts for the purposes of sections 33, 33A(2), 34 and 83A of the Act shall be made to the Registrar on Form 5C together with the payment of the prescribed fee.

**31B. Amendment of Register.**

(1) A request under section 33B of the Act to amend the Register shall be made to the Registrar on Form 5D together with the payment of the prescribed fee.

(2) The Registrar may require the submission of such information or documents, including a written explanation by the owner of the patent, in support of the request for the amendment.

**32. Contents of reference to grant of patent published in Gazette.**

A reference to the grant of a patent published pursuant to section 31(3) (a) of the Act shall indicate the particulars specified in (a) to (j) of regulation 30 as well as the most illustrative of any drawings.

**33. Annual fees.**

(1) The prescribed annual fee shall be paid to the Registrar who shall record the payment in the Register.

(2) The lapse of a patent for non-payment of the prescribed annual fee shall be recorded in the Register.

(3) Annual fees paid shall not be refundable.

**33A. Reinstatement of lapsed patent.**

(1) A request under section 35A(1) of the Act for the reinstatement of a lapsed patent shall be made to the Registrar on Form 5E together with the payment of the prescribed fee.

(2) The Registrar may require the submission of such information or documents, including a written explanation by the person making the request, in support of the request for the reinstatement of the lapsed patent.

(3) Where a case for reinstatement has not been made out to the satisfaction

of the Registrar, he shall notify the person making the request in writing of that fact and shall state the reasons therefor and shall give the person making the request an opportunity to be heard.

(4) Upon receipt of a notification under subregulation (3), the person making the request may, within one month from the date of the mailing of the notification, request for a hearing.

(5) Where the Registrar receives a request for a hearing under subregulation (4), he shall give the person making the request an opportunity to present his case and shall thereafter give his decision.

(6) Where no request for a hearing is received within the prescribed period or where the person making the request does not appear on the date fixed for the hearing of the request the Registrar shall refuse the request for reinstatement and shall inform the person making the request in writing of that decision.

(7) Where a case for reinstatement has been made out to the satisfaction of the Registrar, he shall notify the person making the request in writing of that fact.

(8) Upon receipt of a notification under subregulation (7), the person making the request shall, within one month from the date of the mailing of the notification, pay to the Registrar all annual fees due and the prescribed surcharge for reinstatement.

(9) The Registrar shall, upon receipt of the annual fees due and the prescribed surcharge for reinstatement, reinstate the patent; and the date of reinstatement shall be recorded in the Register.

### **33B. Protection of persons who exploit lapsed patents.**

(1) Any person who has exploited or taken definite steps, by contract or otherwise, to exploit a patent after it is notified in the Gazette that the patent has lapsed and before it is notified in the Gazette that the patent has been reinstated may request for a licence to exploit the patented invention.

(2) A request under subregulation (1) shall be made to the Registrar on Form 5F.

(3) A copy of the request shall be served on the owner of the patent.

(4) The Registrar may require the person making the request or the owner of the patent or both to appear before him for the purpose of giving a statement or submitting any document or other information.

(5) The Registrar may, where he is satisfied that a licence to exploit the patented invention should be granted, grant a licence to the person making the request subject to such terms and conditions as the Registrar deems fit and the owner of the patent shall be deemed to have consented to such grant.

(6) The Registrar shall inform the person making the request and the owner of the patent in writing of his decision.

### **33C. Conversion of applications.**

(1) A request under section 17B(3) of the Act to convert an application for a patent into an application for a certificate for a utility innovation or to convert an application for a certificate for a utility innovation into an application for a patent shall be made to the Registrar on Form 5G together with the payment of the prescribed fee.

(2) Where a case for conversion has been made out to the satisfaction of the Registrar, he shall notify the person making the request in writing of that fact.

(3) Upon receipt of a notification under subregulation (2), the person making the request shall, within one month from the date of the mailing of the notification, pay to the Registrar-

(a) in the case of a request to convert an application for a patent into an application for a certificate for a utility innovation, the prescribed fee payable under regulation 45;

(b) in the case of a request to convert an application for a certificate for a utility innovation into an application for a patent, the prescribed fee payable under regulation 7.

(4) For the avoidance of doubt it is declared that where an application has been converted in accordance with this regulation, the prescribed fee paid on the original application shall not be refundable.

### **PART III RIGHTS OF OWNER OF PATENT**

#### **34. Application to record assignment or transmission.**

(1) Any application under section 39(2) of the Act to record in the Register the assignment or transmission of a patent application or a patent shall be made to the Registrar on Form 6 together with the payment of the prescribed fee.

(2) The application shall be signed, in the case of an assignment, by or on behalf of the parties to the transfer and, in the case of a transmission, by or on behalf of the person entitled to the patent application or patent.

(3) The application shall be accompanied by documents proving to the satisfaction of the Registrar the change of ownership.

(4) When subregulations (1) to (3) have been complied with, the Registrar shall record the assignment or transmission in the Register.

(5) Where a change in ownership related to a patent, a reference thereto shall be also published in the Gazette.

#### **35. Entry in Register that any person may obtain a licence.**

(1) An application under section 42(1) of the Act shall be made on Form 7 together with the payment of the prescribed fee.

(2) An application under section 42(6) of the Act shall be made on Form 8 together with the payment of the prescribed fee.

#### **36. Request to record particulars of licence contracts.**

A request under section 42(4) of the Act shall be made to the Registrar on Form 9 together with the payment of the prescribed fee.

#### **37. Request to record expiry or termination of recorded licence contracts.**

A request under section 47(a) of the Act shall be made to the Registrar on Form 10 together with the payment of the prescribed fee.



## **PART IV COMPULSORY LICENCES**

### **38. Application for compulsory licence.**

(1) An application under sections 49 and 49A of the Act shall be made to the Registrar on Form 11 together with the payment of the prescribed fee.

(2) For the purpose of section 49(2) of the Act, the reasonable period of time shall be six months from the initial efforts made to obtain authorization from the owner of the patent.

### **39. Procedure for grant of compulsory licence.**

(1) The Registrar shall, within three months from the date of the application, examine whether the requirements of section 50(1) of the Act and regulation 38 are satisfied and, if the requirements are satisfied, send a copy of the application to the licensor and licensee and invite the licensor or licensee, as the case may be, to make any observations.

(2) The Registrar shall give the notice required by section 50(2) of the Act, in writing, not later than three months before the date set for the Board to consider the application.

### **40. Notification of the Board's decision.**

(1) The Registrar shall notify in writing any party required to appear before the Board under section 51(1) of the Act not later than one month before the date set for the appearance.

(2) Within one month from the date the Board makes its decision, the Registrar shall notify the applicant, the licensor or the licensee, as the case may be, of the decision and shall record the decision in the Register setting out the following particulars:

- (a) the name and address of the applicant;
- (b) the date of filing of the application;
- (c) the applicable statutory provision under which the application was made;
- (d) the title of the patented invention;
- (e) the number and date of the grant of the patent in question;
- (f) the date and nature of the decision; and
- (g) if a compulsory licence was granted, the particulars referred to in section 52 of the Act.

(3) The Registrar shall publish the decision of the Board under section 51(1) of the Act in the Gazette setting out the particulars mentioned in paragraphs (a) to (f) of subregulation (2).

**41. Amendment and cancellation of compulsory licence.**

(1) The request under section 54(1) of the Act to amend the decision granting a compulsory licence shall be made to the Registrar on Form 12 together with the payment of the prescribed fee.

(2) The request under section 54(2) of the Act to cancel a compulsory licence shall be made to the Registrar on Form 13 together with the payment of the prescribed fee.

(3) The procedure set out in sections 50 and 51 of the Act and in regulations 38, 39 and 40 shall apply, to the extent relevant, for amending or cancelling a compulsory licence.

**42. Surrender of compulsory licence.**

(1) The written declaration of surrender of a compulsory licence under section 54(3) of the Act shall be accompanied by the payment of the prescribed fee.

(2) The Registrar shall record the surrender in the Register and notify the owner of the patent as required by section 54(3) within one month from the date of receipt of the declaration of surrender.

(3) The Registrar shall publish the surrender as required by section 54(3) of the Act in the Gazette.

## **PART V SURRENDER AND INVALIDATION**

### **43. Surrender of patent.**

The written declaration of surrender of a patent under section 55(1) of the Act shall be accompanied by the payment of the prescribed fee.

### **44. Invalidation of patent.**

(1) The owner of the patent shall notify any licensees of any proceedings brought under section 56 of the Act.

(2) The person requesting the invalidation shall notify any beneficiaries of compulsory licences of any proceedings brought under section 56 of the Act.

## **PART VI UTILITY INNOVATIONS**

### **45. Certificate for a utility innovation.**

(1) An application for the grant of a certificate for a utility innovation under Part IVA of the Act shall be made to the Registrar on Form 14 together with the payment of the prescribed fee.

(2) An application to extend the term of a certificate for a utility innovation shall be made to the Registrar on Form 15 together with the payment of the prescribed fee.

(3) The provisions of these Regulations, except regulation 19 and Part IV, shall apply to utility innovations to the extent relevant.

(4) In the forms made applicable to utility innovations under subregulation (3), "certificate" means a certificate for a utility innovation.

## **PART VIA PATENT AGENTS**

### **45A. Interpretation.**

In this Part, unless the context otherwise requires-

"Board of Examiners" means the board of Examiners of Patent Agents established under regulation 45G;

"Secretary-General" means the Secretary-General of the Ministry charged with the responsibility for the development of industrial property.

### **45B. Representation in proceedings.**

(1) Unless the Act or any regulation made thereunder otherwise prescribes, or the Registrar otherwise directs, any person may be represented in proceedings before the Patent Registration Office by a patent agent who may attend, file documents and sign documents on that person's behalf.

(2) The appointment or change of a patent agent shall be made on Form 17, signed by the person or persons to be represented by the agent and submitted to the Registrar.

### **45C. Registration of patent agents.**

(1) An application to be registered as a patent agent in the Register of Patents Agents shall be made to the Registrar on Form 18 together with the payment of the prescribed fee.

(2) In order to be registered in the Register of Patents Agents, the applicant shall satisfy the Registrar-

- (a) that he is domiciled in or is a permanent resident of Malaysia;
- (b) that he is an advocate and solicitor of the High Court in Malaya or an advocate of the High Court in Sabah and Sarawak, or has a relevant degree or its equivalent in an appropriate branch of engineering or science from an institution of higher learning approved by the Board of Examiners, or has qualifications entitling him to graduate membership of a professional engineering or scientific institution or the like recognized by the Board of Examiners; and
- (c) that he has passed the examination specified in regulation 45D.

(3) The Registrar may, at any time, require proof of the matters specified in paragraphs (a), (b) and (c) of subregulation (2).

(4) The Registrar may refuse to register any person who has been convicted of an offence involving fraud or dishonesty.

(5) The Registrar, upon being satisfied that the applicant qualifies to be registered in the Register of Patents Agents, shall register the applicant for a term expiring on the 31st December of that year.

**45D. Examination for patent agents.**

(1) For the purposes of regulation 45C(2)(c), the board of Examiners shall conduct an examination which shall consist of the following subjects:

- (a) technology;
- (b) Malaysian patent law and practice;
- (c) Malaysian trade mark and designs law and practice; and
- (d) foreign industrial property law and practice.

(2) An application for registration as a candidate for the examination specified in subregulation (1) shall be made to the Board of Examiners on Form 18A together with the payment of the prescribed fee.

(3) An application under subregulation (2) shall be sent to the Secretary to the Board of Examiners at the Patent Registration Office on or before the date determined by the board of Examiners for the submission of such applications.

(4) A candidate shall be required to sit for each of the subjects specified in subregulation (1) at a sitting of the examination.

(5) A candidate who has sat for and failed to pass any of the subjects specified in subregulation (1) may, if he is dissatisfied with his results, appeal to the Secretary-General for re-scrutiny of the results within fourteen days from the date of the notification of such results together with the payment of the prescribed fee.

(6) Upon receipt of an appeal under subregulation (5), the Secretary-General shall consider the appeal and make a decision thereon.

(7) The decision of the Secretary-General shall be final and conclusive.

(8) A candidate who has sat for and failed to pass any or all of the subjects specified in subregulation (1) at an examination may apply to re-sit such subject or subjects, as the case may be, at the next sitting of the examination and such application shall be made to the Board of Examiners on Form 18B together with the payment of the prescribed fee.

(9) Any candidate who has failed to pass all of the subjects specified in subregulation (1) after three attempts shall be deemed to have failed the overall examination and subregulations (5), (6), (7) and (8) shall not apply thereto.

(10) Any candidate who is deemed to have failed the overall examination under subregulation (9) may re-apply to be registered as a candidate under subregulation (2).

**45E. Renewal of registration of patent agents.**

(1) An application for the renewal of registration as a patent agent shall be made to the Registrar on Form 19 together with the payment of the prescribed fee by the 31st January of each year:

Provided that in the case of a person who immediately before the date of coming into force of this regulation was registered as a patent agent the application for the renewal of registration as a patent agent shall be made within thirty days of the expiry of the registration.

(2) The Registrar shall, upon being satisfied that the conditions specified in regulation 45C continue to be satisfied, renew the registration of the patent agent for a term expiring on the 31st December of that year: Provided that a person who immediately before the date of coming into force of this regulation was registered as a patent agent shall be deemed to have satisfied the conditions specified in regulation 45C(2)(c).

(3) Notwithstanding subregulation (2), the Registrar may refuse to renew the registration of any person who has been convicted of an offence involving fraud or dishonesty.

**45F. Cancellation of registration of patent agents.**

(1) The Registrar may cancel the registration of any person who has been convicted of an offence involving fraud or dishonesty.

(2) Where the registration of any person is cancelled under this regulation no fees paid for the purpose of registration or renewal of registration shall be refundable.

**45G. Board of Examiners of Patent Agents.**

(1) There is established a Board of Examiners of Patent Agents which shall consist of-

(a) the Registrar of Patents, who shall be Chairman; and

(b) four other persons proficient in the field of industrial property appointed by the Secretary-General.

(2) An officer of the Patent Registration Office shall be Secretary to the Board of Examiners.

(3) A member of the Board of Examiners appointed under subregulation (1) (b) shall, unless his appointment is sooner revoked or he sooner resigns, hold office for such period not exceeding three years as the Secretary-General may determine and shall be eligible for reappointment.

(4) At a meeting of the Board of Examiners three members shall form a quorum.

(5) In the absence of the Chairman, a member nominated by the Chairman shall preside at the meeting and such member may exercise all the powers of the Chairman in respect of that meeting.

(6) If on any question to be determined there is an equality of votes, the Chairman shall have the casting vote in addition to his deliberative vote.

(7) The Board of Examiners shall be responsible for-

- (a) the conduct of the examination specified in regulation 45D;
- (b) preparing and publishing the examination syllabus and determining the study material to be recommended;
- (c) preparing examination papers;
- (d) registering and admitting candidates;
- (e) determining the time, date and place for the examination;
- (f) awarding certificates; and
- (g) advising the Registrar as to the persons who have satisfied the requirements of paragraphs (b) and (c) of subregulation 45C(2).

(8) The Board of Examiners shall enjoy the prerogative of awarding and withdrawing certificates, withholding and cancelling the results of any candidate, and barring any person from taking the examination.

**45H. Setting, assessing and marking of examination questions and answers .**

(1) The Board of Examiners may appoint suitably qualified persons to be examiners for the purpose of setting, assessing and marking questions or answers for the examination specified in regulation 45D.



(2) The Board of Examiners may give such instructions in relation to the setting, assessing and marking of questions or answers as it considers necessary.

(3) The examiners appointed under subregulation (1) shall be paid such allowances as the Minister may direct.

## **PART VII MISCELLANEOUS**

### **46. Amendment of application.**

A request under section 79(1) of the Act to correct a clerical error or obvious mistake in an application for the grant of a patent shall be made to the Registrar on Form 16 together with the payment of the prescribed fee.

### **46A. Amendment of patent.**

A request under section 79A(1) of the Act to correct a clerical error or obvious mistake in a patent or any other document associated with the patent, or to amend a patent or any other document associated with the patent for any other reason shall be made to the Registrar on Form 16A together with the payment of the prescribed fee.

### **47. Hearing.**

(1) The Registrar shall give the person entitled to a hearing pursuant to section 81 of the Act not less than one month's notice of the date of hearing.

(2) Within twenty-one days of the date of the notice, the person notified shall inform the Registrar whether he desires to be heard.

(3) If the person notified fails to inform the Registrar within twenty-one days of his desire to be heard, the Registrar may proceed to exercise his power in the absence of such person.

(4) The Registrar may invite an Examiner to assist him in the hearing.

### **48. - 49. (Deleted).**

### **50. Signatures by partnerships, companies and associations.**

(1) A document purporting to be signed for or on behalf of a partnership shall contain the names of all the partners in full and shall be signed-

- (a) by all the partners; or
- (b) by any qualified partner stating that he signs on behalf of the partnership; or
- (c) by any other person who satisfies the Registrar that he is authorized to sign the document.

(2) A document purporting to be signed for or on behalf of a body corporate

shall be signed-

(a) by a director or the secretary or other principal officer of the body corporate; or

(b) by any other person who satisfies the Registrar that he is authorized to sign the document.

(3) A document purporting to be signed for or on behalf of an association of persons may be signed by any person who appears to the Registrar to be duly qualified.

#### **51. Address for service.**

(1) Every person concerned with any proceedings under the Act or any regulation made thereunder and every owner of a patent shall furnish to the Registrar, on Form 20 together with the payment of the prescribed fee, an address for service in Malaysia, which may be treated for all purposes concerning or connected with such proceedings or patent as the address of the person concerned.

(2) Notwithstanding subregulation (1), where a patent agent has been appointed, the address for service shall be the address of the patent agent.

(3) The furnishing of Form 20 is not required if the address for service has already been furnished in any other Form in Schedule II to these Regulations, and that address for service has not changed in any way.

#### **52. Filing and service of documents and things.**

(1) Any document or thing required or authorized by the Act or these Regulations to be filed at the Patent Registration Office shall be delivered by hand to the Patent Registration Office during its normal business hours or sent to the Registrar by post.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or thing, with the prepaid postage on it, to the Registrar at the Patent Registration Office and the document or thing shall be deemed to have been received at the time when the document or thing is actually received at the Patent Registration Office.

(3) The filing of a document or thing at the Patent Registration Office shall be deemed to be effected at such time as it is received at the Patent

Registration Office and is recorded as received.

**52A. Electronic filing of documents and things.**

(1) The Registrar may provide a service for the electronic filing of the document or thing required or authorized by the Act or these Regulations to be filed with the Registrar.

(2) A person who intends to use the service provided under subregulation (1) shall comply with the terms and conditions as may be specified by the Registrar, either generally by notice published in the official website or, in any particular case, by notice, including through electronic means, to the person desiring to use such service.

(3) A document or thing which is electronically filed under this regulation shall be deemed to be effected at such time as that document or thing is accepted by the electronic filing system.

(4) Where any accompanying document or thing is not capable of being filed electronically, such accompanying document or thing may be delivered or sent to the Registrar in the manner specified in regulation 8, subject to such terms and conditions as the Registrar may specify.

**52B. Terms and conditions for electronic filing.**

(1) Without limiting the generality of subregulation 52A(2), the terms and conditions for electronic filing shall include the following:

(a) the procedure to be complied with for the electronic filing of documents and things;

(b) the format or media in which a document or thing is to be recorded or stored for purposes of electronic filing;

(c) the manner of authenticating a document or thing which is required to be stamped, signed, sealed or certified, including the requirement for a digital signature of the person filing the document or thing; and

(d) the actions to be taken in the event of an interruption in the process of performing the electronic filing.

(2) Notwithstanding regulation 52A, the Registrar may refuse to accept or to register any document or thing which is filed electronically if-

(a) the information contained in such document or thing which is not capable of being displayed in a legible form;

(b) the electronic record of such document or thing is not capable of being stored in the electronic filing system;

(c) the electronic record of such document or thing appears to the Registrar to be altered, damaged, incomplete or forged; or  
(d) any of the terms or conditions on electronic filing specified by the Registrar is not complied with.

**53. Request for extension of time.**

A request under section 82 of the Act shall be made to the Registrar on Form 21 together with the payment of the prescribed fee.

SCHEDULE I FEES (omitted)

SCHEDULE II FORM (omitted)