
MALAYSIA IP HANDBOOK

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PATENT



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TRADEMARK



INDUSTRIAL DESIGN

TRADEMARK APPLICATION IN MALAYSIA

1. Legislation:

Trade Marks Act 1976 (Act 175), Trade Marks Act (Regulation 1997), Trade Marks Act 1994(Amended) and Trade Marks Act 2000(Amended)

2. Definition:

A trademark is a sign used for the purpose of indicating a connection between a person having the right to use the sign and his goods or services. A sign includes words, logos, labels, names, letters, numbers or a combination of the above.

3. Criteria:

A trade mark has to fulfill the one of following conditions in order to claim protection as a trademark.

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

4. Membership:

- ✓ - Paris Convention
- X – Madrid Protocol

Malaysia is a member of the Paris Convention from 1989, whereby applications from convention countries will be subject to the same priority date in Malaysia. The application for priority has to be made within six months of the first application in a convention country.

5. Rule of Priority:

“First to Use” is the rule followed by Malaysia in determining priority of trademarks.

6. Duration and Renewal:

A trade mark application once registered is valid for 10 years from the date of application. It may be renewed every ten years thereafter with payment of a renewal fee.

**MALAYSIA TRADEMARK
APPLICATION PROCEDURES**

1.Application

Every applicant is required to submit an application with the Malaysian Trademark office



2.Examination

On submission of the application, the Trade Marks office will examine the application for statutory compliances. Such examinations could lead to office actions. Applicants will be informed and also given an opportunity to reply to such office actions.



3.Publication

A trade mark which passes through examination be published in the government gazette subject to the satisfaction of the registrar.



4.Opposition

Third parties can oppose the application within three months of publication.



5.Registration

On completion of objections and opposition a Certificate of Registration will be issued by the trade marks office subject to the payment of a fee.

Filing Requirements

The following information and/or documents are required to file an application for a trademark application in Malaysia:-

1. Application Form (TM 5).
2. Power of Attorney (TM 1).
3. One clear print for a black-and-white mark; 15 prints for a colour mark.
4. A list of goods or services (which closely follow the Nice International Classification).
5. The full name and address of the applicant, company, country/state of incorporation.
6. A Statutory Declaration from the applicant affirming that they are the proprietors of the mark, to be signed before a Commissioner for Oaths (if signed locally) or before a Notary Public (if signed abroad).
7. For marks that contain non-English words, a certified transliteration and translation.
8. If convention priority is claimed, a certified copy of the priority application (with a certified English translation where documents are not in English).

Documents To Be Furnished For Filing Trade/Service Mark Application in Malaysia

Basic Requirements

Documents	Remarks	Time of Filing
Statutory Declaration	Notarized	2 months from filing
Mark in the form of foreign characters has to be accompanied with transliteration in English	Certified by Translator	2 months from filing

Additional Documents for Claiming a Convention Priority

Documents	Remarks	Time of Filing
Priority documents	Certified copy of the basic application. Documents in any other language have to be provided with its English translation.	2 months from filing

Documents for Filing a Request of Recordals of Assignments and Changes

Documents	Remarks	Time of Filing
Copy of : – Assignment deed, or – Document of name change – Document of address change	notarized Certified Certified	Anytime after registration

Documents for Filing an Opposition or Counter-Opposition (Deadline for Applying is during 3 Months Publication Period of the Trade Mark Application to be Opposed)

Documents	Remarks	Time of Filing
Copy of registrations in various countries	no legalization	On filing date
Copy of advertisements/ brochures of the products bearing the mark	no legalization; as many and as early as possible	On filing date

PATENT APPLICATION IN MALAYSIA

In Malaysia, patent protection is obtainable by way of either entering the national phase of a Patent Cooperation Treaty (PCT) application or filing a direct national application.

1. Legislation:

Patents Act 1983 (Act 291).

2. Patentability Criteria:

A patent has to fulfill the following conditions in order to claim protection.

- it is new
- it involves an inventive step
- it is industrially applicable

Non-Patentable Subject Matter:

An invention is not patentable if it contains the following:

- discoveries, scientific theories and mathematical methods,
- plant or animal varieties or essentially biological processes for the production of plant or animals,
- schemes, rules or methods for doing business, performing mental acts, and
- methods for the treatment of the human or animal body by surgery or therapy, and diagnostic methods practiced on the human or animal body.

3. Utility Innovations

The Malaysian patent system also provides for the grant of utility innovation certificates. A utility innovation must fulfill the criteria of novelty and industrial applicability (but not inventiveness). A utility innovation certificate may only have one claim and subject to evidence of commercial/industrial use in Malaysia, enjoys the same duration of protection like a patent.

4. Membership:

- ✓ - Paris Convention
- ✓ - PCT

Malaysia is a member of the Paris Convention since 1989, whereby applications from convention countries will be subject to the same priority date in Malaysia. The application for priority has to be made within twelve months of the first application in a convention country.

Malaysia is also a member of the PCT since 2006. An applicant who has made an international patent application may file and/or prosecute the patent application during its national phase entry into Malaysia within 30 months from the filing date of the international application or from the earliest priority date of the application if a priority is claimed.

5. Rule of Priority:

Unless requested by an Examiner, there is no requirement to file a certified copy of any priority application. "First to Apply" is the rule followed by Malaysia in determining priority of patents.

**MALAYSIA PATENT
APPLICATION PROCEDURES**

1. Filing of Patent Application

Every applicant is required to submit an application to the registrar of patents within 12 months of priority date.

2. Publication

Details of the application, including the specification are made available for public inspection after 18 months from the patent filing date. Once published, the application will enjoy provisional protection under which, upon grant, the patentee may claim compensation for unauthorized use of the invention prior to grant.

3. Substantive Examination

Every applicant has to file a request for a substantive or modified substantive examination within 18 months (for filing made before 15 Feb 2011, it was 24 months) from the patent filing date (for a non-PCT patent filing into Malaysia) and within 48 months from the international filing date (for a PCT national entry into Malaysia), wherein the registrar will refer the application to the examiner. The examiner will then submit a report after examining the application for compliance of regulations. Once the applicant makes observations on the report or amendments as the case may be the examiner will again report to the registrar who will then process the application.

4. Registration

A patent once registered is valid for a term of 20 years and will be subject to protection subject to payment of annual renewal fees. Annuity is payable upon grant.

Filing Requirements

The following information and/or documents are required to file an application for a patent in Malaysia:-

Direct National Application:-

1. Request for the grant of a patent (PF 1):-
 - the name and address of the applicant;
 - the name and address of the inventor;
 - a specification comprising a description, claims and any necessary drawings; and
 - the country and filing particulars of basic application whose priority is claimed.
2. Appointment of Patent Agent (PF 17)
3. If the applicant is not the inventor, a statement explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.
4. There is no requirement for the filing of an assignment from inventor to applicant.

PCT National Phase Application

- Form 2A ;
- a copy of the PCT application in English language (i.e. request form [PCT/RO/101](#));
- the details of the PCT application (suitably, the bibliographic page as published by WIPO);
- one copy of the PCT specification as originally filed (in or translated to English);
- one copy of any amendments filed in the international phase (in or translated to English);
- an Appointment of Agent form signed by the applicant; and
- if the applicant is not the inventor, a statement explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.

Documents To Be Furnished For Filing A Patent Application in Malaysia

Basic Requirements

Documents	Remarks	Time of Filing
Patent specification, claims and abstract in English	no legalization requirement	On filing date
Drawings	(if any)	On filing date

Additional Documents for Convention Patent Application

Documents	Remarks	Time of Filing
Priority documents	Certified copy of the basic patent application	Within 2 months from request by the Examiner
Appointment of Agent (PF10)		Within 2 months from request by the Examiner

Additional Documents for Entry of PCT National Phase in Malaysia

Documents		Time of Filing
International Preliminary Report on Patentability based on International Preliminary Search Report (Chapter I); or		On filing date
International Preliminary Report on Patentability based on International Preliminary Examination Report (Chapter II)		On filing date

INDUSTRIAL DESIGN APPLICATION IN MALAYSIA

1. Legislation:

Industrial design protection in Malaysia is governed by the Industrial Designs Act 1996 which entered into force on 1st September 1999. Prior to this date, industrial designs were protected in Malaysia by registering the design in the United Kingdom.

2. Definition:

Industrial design means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means.

3. Criteria:

A design must have features of shape, configuration, pattern or ornament which are new and appeal to and are solely judged by the eye.

On the point of novelty, Malaysian industrial design law adopts worldwide novelty standard, in that the design must not have been disclosed to the public anywhere in Malaysia or elsewhere in the world before the priority date or the date of application for registration in Malaysia, in respect of the same article or any other article. The applicant is required to include a “statement of novelty” in the registered design application.

Excluded Subject Matter:

The following features are excluded from industrial design registration in Malaysia:-

- method or principle of construction
- features of shape or configuration
- features of shape or configuration that depend on the appearance of another article, of which the first article is intended by the designer to form an integral part and;
- designs for an article where appearance is immaterial, in the sense that aesthetics are not normally taken into account to any material extent by persons using those kind of articles.

4. Rule of Priority:

Applications for priority have to be made within six months from the earliest date of filing.

5. Duration and Renewal:

The initial term of registration for a Malaysian design is 5 years from the filing date of the application for registration. The application can be renewed for four further five year periods, giving a maximum term of 25 years.

**MALAYSIA INDUSTRIAL
DESIGN APPLICATION
PROCEDURES**

1. Application

Every design application has to be filed with the Malaysian Industrial Design office.



2. Examination

Applications are examined by the Registrar to ensure they meet all formal requirements within 6 months from the date of filing. There is no search or substantive examination of the application.

However, in practice, objections of a substantive nature are often raised. The applicant will be required to make amendments or modifications to the application as determined by the registrar.



3. Publication

Once the certificate is issued the Registrar will cause the registration to be published in the Gazette containing the notice of registration, details of the owner and other related information.



4. Registration

The registrar will record the details of the design in his register and issue a certificate of registration to the applicant. A design once registered is valid for a term of 5 years and will be subject to protection depending on its further renewal for two further five years periods.

Filing Requirements

The following information and/or documents are required to file an application for an industrial design application in Malaysia:-

1. ID Form 1 with
 - (a) Full name, address and state of incorporation/nationality of the applicant.
 - (b) Name of article and statement of novelty; and details of any priority claim i.e. at least the country and filing date.
 - (c) International Design Classification; serial number of the priority application.
 - (d) Full name and address of the author.
 - (e) Information on how the applicant has derived the right to the design from the author (normally by way of assignment, employment or other agreement);
2. Appointment of Agent Form (Form ID 10) signed by the applicant.
3. six sets of representations of the design (drawings or photographs).
4. Priority documents and certified English translation (if necessary) of the priority document.

Documents To Be Furnished For Filing an Industrial Design Application in Malaysia

Basic Requirements

Documents	Remarks	Time of Filing
Appointment of Agent (Form ID10)	no legalization/ notarization requirement	On filing date
Description of Design	to be translated to English	On filing date
Drawings/Photographs		On filing date

Additional Documents for Claiming Convention Priority

Documents	Remarks	Time of Filing
Priority documents	to be translated to English language	2 months from filing

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