



P.U.(A) 48/2011
Patents Regulations (Amendment) 2011

Preamble

IN exercise of the powers conferred by section 87 of the Patents Act 1983 [*Act 291*], the Minister makes the following regulations:

Citation and commencement

1. (1) These regulations may be cited as the **Patents (Amendment) Regulations 2011**.
- (2) These Regulations come into operation on 15 February 2011.

Amendment of regulation 10

2. The Patents Regulations 1986 [*P.U. (A) 327/1986*], which are referred to as the “principal Regulations” in these Regulations, is amended by inserting after subregulation 10(2) the following subregulation:

“(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.”.

Amendment of regulation 26

3. Subregulation 26(1) of the principal Regulations is amended by inserting after the word “9,” the word “10,”.

Amendment of regulation 27

4. Subregulation 27(1) of the principal Regulations is amended by substituting for the words “two years” the words “eighteen months”.

Amendment of regulation 27A

5. Subregulation 27A(1) of the principal Regulations is amended by substituting for the words “two years” the words “eighteen months”.

Amendment of regulation 27C

6. Regulation 27C of the principal Regulations is amended—
 - (a) in subregulation (1), by deleting the word "10,"; and
 - (b) in subregulation (4), by substituting for the word "three" the word "two".

Amendment of regulation 27D

7. Regulation 27D of the principal Regulations is amended—
 - (a) in subregulation (1), by deleting the word "10,"; and
 - (b) in subregulation (5), by substituting for the word "three" the word "two".

New regulation 27E

8. The principal Regulations are amended by inserting after regulation 27D the following regulation:
 - 27E. (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 grounds 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."

Amendment of regulation 52

9. The principal Regulations are amended by substituting for regulation 52 the following regulation:

52. (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.”.

New regulations 52A and 52B

10. The principal Regulations are amended by inserting after regulation 52 the following regulations:

52A. (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. (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.”.

Amendment of Schedule I

9. The principal Regulations are amended by substituting for Schedule I the following Schedule:

“SCHEDULE I
(Subregulation 2(2))
FEES

PART I

<i>(1)</i> <i>Item</i> <i>No</i>	<i>(2)</i> <i>Matter/Proceeding</i>	<i>(3)</i> <i>Corresponding</i> <i>Form</i>	<i>(4)</i> <i>E-Filing Fee</i> <i>(RM)</i>	<i>(5)</i> <i>Manual Fee</i> <i>(RM)</i>
1	Request for grant of patent (b) Claims for 1st ten claim for every additional claim (per claim)	Form 1	260.00 Nil 20.00	290.00 Nil 20.00
2	Declaration of withdrawal of application	Form 2	Nil	Nil
2A	Entering national phase	Form 2A		

	for first ten claims		260.00		290.00
	for every additional claim (per claim)				
			20.00		20.00
2B	Request for reinstatement under section 780A	Form 2A	650.00	per month of delay	690.00 per month of delay
3	Request for substantive examination	Form 5	950.00		1100.00
4	Request for modified substantive examination	Form 5A	600.00		640.00
5	Request for deferment of filing of request for examination or provision of information	Form 5B	Nil		Nil
6	Request for certified copies of extract	Form 5C	70.00		80.00
7	Request to amend Register	Form 5D	70.00		80.00
8	Request for reinstatement of lapsed patent	Form 5E	130.00		140.00
9	Request for licence to exploit patented invention	Form 5F	Nil		Nil
10	Request to convert application for patent into application for certificate of utility innovation or vice versa	Form 5G	260.00		290.00
11	Request for approval of expedited examination	Form 5H	200.00		250.00
12	Request for Expedited examination	Form 5I	2000.00		2200.00

13	Application or recording of assignment of transmission	Form 6	130.00	140.00
14	Application for entry in Register that any person may obtain a licence	Form 7	70.00	80.00
15	Application for cancellation of entry in Register that any person may obtain a licence	Form 8	70.00	80.00
16	Request for recording of particulars of licence contract in Register	Form 9	130.00	140.00
17	Request for recording of expiry or termination of licence contract in Register	Form 10	100.00	110.00
18	Application for compulsory licence	Form 11	100.00	110.00
19	Request for amendment of decision	Form 12	100.00	110.00
20	Request for cancellation of compulsory licence	Form 13	100.00	110.00
21	Application for grant of certificate of utility innovation	Form 14	130.00	140.00
22	Application to extend term of certificate for utility innovation	Form 15	130.00	140.00

23	Request to amend Form 16 application for grant of patent	70.00	80.00
24	Request to amend patent Form 16A	70.00	80.00
25	Appointment or change of patent agent Form 17	70.00	80.00
26	Application for registration of patent agent Form 18	2600.00	2670.00
27	Application for registration as candidate for examination Form 18A	130.00	140.00

PART II

<i>(1)</i> Item No.	<i>(2)</i> Matter/Proceeding	<i>(3)</i> E-Filing Fee (RM)	<i>(4)</i> Manual Fee
1	Copy of patent	40.00	40.00
2	Copy of search report	30.00	30.00
3	Examination of Register	15.00 per hour	15.00 per hour
4	Certified copies or extract from Register	15.00 per page	15.00 per page
5	Copy or extract from Register	3.00 per page	3.00 per page
6	Fee for public inspection of information relating to patent application	30.00 per hour	30.00 per hour
7	Certified copies or extract of any information – for 1st five pages	100.00 per page	100.00 per page
	for every additional page	3.00 per page	3.00 per page
8	Annual fee for patent: for second year after grant of patent	260.00	290.00
	for third year after grant of patent	330.00	360.00

<i>(1)</i>	<i>(2)</i>	<i>(3)</i>	<i>(4)</i>
<i>Item</i>	<i>Matter/Proceeding</i>	<i>E-Filing Fee</i>	<i>Manual Fee</i>
<i>No.</i>		<i>(RM)</i>	
	for fourth year after grant of patent	390.00	420.00
	for fifth year after grant of patent	460.00	490.00
	for sixth year after grant of patent	520.00	560.00
	for seventh year after grant of patent	600.00	640.00
	for eighth year after grant of patent	650.00	690.00
	for ninth year after grant of patent	720.00	760.00
	for tenth year after grant of patent	780.00	820.00
	for eleventh year after grant of patent	850.00	890.00
	for twelfth year after grant of patent	900.00	940.00
	for thirteenth year after grant of patent	1050.00	1100.00
	for fourteenth year after grant of patent	1200.00	1250.00
	for fifteenth year after grant of patent	1300.00	1350.00
	for sixteenth year after grant of patent	1600.00	1660.00
	for seventeenth year after grant of patent	1850.00	1900.00
	for eighteenth year after grant of patent	2100.00	2200.00
	for nineteenth year after grant of patent	2400.00	2500.00
	for twentieth year after grant of patent	2600.00	2700.00
9	Surcharge for reinstatement	100% of fee for year concerned	100% of fee for year concerned
10	Surrender of compulsory licence	80.00	90.00
11	Surrender of patent	80.00	90.00
12	Annual fee for certificate for utility innovation:		
	for third year after grant of certificate	160.00	170.00
	for fourth year after grant of certificate	210.00	240.00
	for fifth year after grant of certificate	210.00	240.00
	for sixth year after grant of certificate	260.00	290.00
	for seventh year after grant of certificate	260.00	290.00

<i>(1)</i>	<i>(2)</i>	<i>(3)</i>	<i>(4)</i>
<i>Item</i>	<i>Matter/Proceeding</i>	<i>E-Filing Fee</i>	<i>Manual Fee</i>
<i>No.</i>		<i>(RM)</i>	
	for eight year after grant of certificate	320.00	350.00
	for ninth year after grant of certificate	320.00	350.00
	for tenth year after grant of certificate	370.00	400.00
	for eleventh year after grant of certificate	520.00	560.00
	for twelfth year after grant of certificate	780.00	820.00
	for thirteenth year after grant of certificate	910.00	950.00
	for fourteenth year after grant of certificate	1050.00	1100.00
	for fifteenth year after grant of certificate	1300.00	1350.00
	for sixteenth year after grant of certificate	1450.00	1500.00
	for seventeenth year after grant of certificate	1600.00	1650.00
	for eighteenth year after grant of certificate	1700.00	1750.00
	for nineteenth year after grant of certificate	1850.00	1900.00
	for twentieth year after grant of certificate	1950.00	2000.00
13	Holding of hearing	130.00	140.00
14	Certificate of grant of patent	Nil	Nil
15	Certificate for a utility innovation	Nil	Nil
15A	Examination fee	130.00 per subject	140.00 per subject
16	Appeal against examination results	260.00 per subject	290.00 per subject
17	Extension of time (for every month or part of a month)	70.00	80.00
18	Surcharge for late payment of annual fee	100% of fee for year concerned	100% of fee for year concerned
19	Public search through computer	30.00	30.00
20	Computer print-out (bibliography data per page)	10.00	10.00
21	Permitted information (upon request)		
	for less than 10 pages	130.00	140.00
	for the subsequent pages	7.00	7.00

<i>(1)</i> <i>Item</i> <i>No.</i>	<i>(2)</i> <i>Matter/Proceeding</i>	<i>(3)</i> <i>E-Filing Fee</i> <i>(RM)</i>	<i>(4)</i> <i>Manual Fee</i>
22	Fee for preparing international application	3.00 per page	3.00 per page

PART III

<i>(1)</i> <i>Item</i> <i>No.</i>	<i>(2)</i> <i>Matter/ Proceeding</i>	<i>(3)</i> <i>E-Filing Fee</i> <i>(RM)</i>	<i>(4)</i> <i>Manual Fee</i> <i>(RM)</i>
1	Transmittal fee under Rules 14 and 19 of the Regulations under the Treaty: for the first 30 sheets for each sheet in excess of 30 sheets (per sheet)	500.00 60.00	550.00 70.00
2	Fee for the late furnishing of transliteration for the purposes of international search	25% of the international filing fee prescribed under the Treaty	25% of the international filing fee prescribed under the Treaty
3	Fee for the late furnishing of transliteration for the purposes of international publication	25% of the international filing fee prescribed under the Treaty	25% of the international filing fee prescribed under the Treaty
4	Late payment fee under Rule 16 of the Regulation under	(i) 50% of the amount of unpaid fees; or	

(1) Item No.	(2) Matter/ Proceeding	(3) E-Filing Fee (RM)	(4) Manual Fee (RM)
	Treaty		(ii) an amount equal to the transmittal fee; whichever is the higher provided that the amount of late payment fees shall not exceed 50% of the international filing fee prescribed under the Treaty
5	Fee for complying with national requirement in response to the invitation	130.00	140.00

Amendment of Schedule II

The principal Regulations is amended in Schedule II by inserting after Form 5G the following form:

“

<p>Patents Form No. 5H</p> <p>PATENTS ACT 1983</p> <p>REQUEST FOR APPROVAL FOR EXPEDITED EXAMINATION</p> <p>(Regulation 27E)</p> <p>To: The Registrar of Patent Patents Registration Office Kuala Lumpur, Malaysia</p>	<p>For Official Use</p> <p>APPLICATION NO. :</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>*Cheque/Postal Order/Money Order/Draft/ Cash No.:</p> <p>.....</p>
	<p>Date of mailing:</p>

Please submit this Form in duplicate together with the prescribed fee	Applicant's or Agent's file reference:
---	---

I. IN THE MATTER OF:

Patent Application No.: Filing Date:

Certificate Application No.: Filing Date:

II. APPLICANT:

Name :

Address :

.....

III. REQUEST:

The applicant requests the Registrar to refer the patent application identified above for an expedited examination in accordance with subregulation 27E(2) and (3) of the Patents Regulations 1986. This application contains the following (*please tick*):

(a) Statutory Declaration

(b) Grounds of statement

(c) Others (*please specify*)

.....

.....

Where the Registrar is satisfied that the request for expedited

examination complies with the requirement, he shall issue a notification that the applicant shall make the payment of the prescribed fee.

IV. ADDITIONAL INFORMATION accompanying this Form:

Yes No

V. SIGNATURE

** (Applicant/Agent) (Date)

If Agent, indicate Agent's Registration No.

* Delete whichever does not apply

** Type name under signature and delete whichever does not apply

<p>Patents Form No. 5I</p> <p>PATENTS ACT 1983</p> <p>REQUEST FOR FEE FOR EXPEDITED EXAMINATION</p> <p>(Regulation 27E)</p> <p>To: The Registrar of Patent Patents Registration Office Kuala Lumpur, Malaysia</p>	<p>For Official Use</p> <p>APPLICATION NO. :</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>*Cheque/Postal Order/Money Order/Draft/ Cash No.:</p> <p>.....</p>
	<p>Date of mailing:</p>

Please submit this Form in duplicate together with the prescribed fee	Applicant's or Agent's file reference:
<p>I. IN THE MATTER OF:</p> <p style="margin-left: 40px;">Patent Application No.: Filing Date:</p> <p style="margin-left: 40px;">Certificate Application No.: Filing Date:</p>	
<p>II. APPLICANT:</p> <p style="margin-left: 40px;">Name :</p> <p style="margin-left: 40px;">Address :</p> <p style="margin-left: 80px;">.....</p>	
<p>III. REQUEST:</p> <p style="margin-left: 40px;">The applicant makes the payment for the expedited examination upon receipt of the Registrar's notification in accordance with subregulation 27E(5) of the Patents Regulations 1986.</p>	
<p>IV. ADDITIONAL INFORMATION accompanying this Form:</p> <p style="text-align: center; margin-left: 100px;"> Yes <input type="checkbox"/> No <input type="checkbox"/> </p>	
<p>V. SIGNATURE</p> <p style="text-align: center; margin-left: 100px;"> ** (<i>Applicant/Agent</i>) (<i>Date</i>) </p> <p style="margin-left: 40px;">If Agent, indicate Agent's Registration No.</p>	

--

- * Delete whichever does not apply
- ** Type name under signature and delete whichever does not apply

11. The principal Regulations are amended in Schedule II by inserting after Form 21 the following form:

<p>Patents Form No. 22</p> <p>PATENTS ACT 1983</p> <p>STATEMENT JUSTIFYING THE APPLICANT'S RIGHT TO A PATENT/CERTIFICATE (Regulation 10)</p> <p>To: The Registrar of Patent Patents Registration Office Kuala Lumpur, Malaysia</p>	<p>For Official Use</p> <p>APPLICATION NO. :</p> <p>Filing Date:</p> <p>Request received on:</p>
	<p>Date of mailing:</p>
<p>Please submit this Form in duplicate</p>	<p>Applicant's or Agent's file reference: </p>
<p>I. IN THE MATTER OF:</p>	

Patent Application No.: Filing Date:
Certificate Application No.: Filing Date:

II. TITLE OF INVENTION:

III. APPLICANT:
Name :
Address :
.....

IV. I/we believe that the inventor(s)/innovator(s) of the above mentioned application is as follows:
.....
.....
.....

V. Statement justifying the applicant's right to a patent/certificate*:
.....

IV. ADDITIONAL INFORMATION accompanying this Form:
Yes No

VI. SIGNATURE
.....
** (Applicant/Agent) (Date)

If Agent, indicate Agent's Registration No.

* Delete whichever does not apply

** Type name under signature and delete whichever does not apply

Made 11 February 2011

[KPDN(S)(U2)26/6/20; PN(PU2)410/VI]

DATO' SERI ISMAIL SABRI BIN YAAKOB
Minister of Domestic Trade, Cooperatives and Consumerism