



LAWS OF MALAYSIA

Act A1196

PATENTS (AMENDMENT) ACT 2003

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LAWS OF MALAYSIA**Act A1196****PATENTS (AMENDMENT) ACT 2003**

An Act to amend the Patents Act 1983.

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ENACTED by the Parliament of Malaysia as follows:

Short title and commencement

1. (1) This Act may be cited as the Patents (Amendment) Act 2003.

(2) Subject to subsection (3), this Act comes into operation on a date to be appointed by the Minister by notification in the *Gazette*, and the Minister may appoint different dates for the coming into operation of different provisions of this Act.

(3) Sections 3 and 6 come into operation on the date of publication of this Act in the *Gazette*.

Amendment of section 34

2. The Patents Act 1983 [*Act 291*], which is referred to as “the principal Act” in this Act, is amended by substituting for section 34 the following section:

“Public inspection

34. (1) The Registrar shall make available for public inspection after eighteen months from the priority date or filing date of a patent application and upon payment of the prescribed fee—

(a) the name, address and description of the applicant and the name and address of his agent, if any;

- (b) the application number;
 - (c) the filing date of the application and, if priority is claimed, the priority date, the number of the earlier application and the name of the State in which the earlier application was filed or where the earlier application is a regional or an international application, the name of the country or countries for which and the office at which it was filed;
 - (d) the particulars of the application including the description, claim or claims, drawing or drawings, if any, and the abstract and any amendments to the application, if any; and
 - (e) any change in ownership of the application and any reference to a licence contract appearing in the file relating to the application.
- (2) Notwithstanding subsection (1) a patent application shall not be made available for public inspection if—
- (a) the patent application is withdrawn or refused or deemed to be withdrawn or refused before the expiry of the period of eighteen months from the priority date or filing date of the patent application; or
 - (b) it appears to the Registrar that the application contains information which contravenes public order or morality.
- (3) Information relating to a patent application may be inspected only with the written permission of the patent applicant if the information is requested within eighteen months from the priority date or filing date of the patent application.
- (4) A certified extract of the information may be obtained upon payment of the prescribed fee.
- (5) After an application is made available for public inspection, an applicant may in writing warn a person who has commercially or industrially worked the invention which is the subject matter of the application that a patent application for the invention has been filed.

(6) An applicant may demand that a person who has commercially or industrially worked the invention pay as compensation to the applicant in respect of the invention—

- (a) from the time the person is given the warning under subsection (5); or
- (b) in the absence of a warning, after the patent application in respect of the invention has been made available for public inspection,

an amount equivalent to what he would have normally received for the working of the invention to the time of the grant of the patent.

(7) The right to demand compensation as provided for in subsection (6) shall be exercised only after the grant of the patent.

(8) The exercise of the right to demand compensation under subsection (6) shall not prevent the applicant from exercising his rights as the owner of the patent in respect of the invention after the grant of the patent.

(9) Where a patent application is withdrawn or refused after the application is made available for public inspection, the right under subsection (6) shall be deemed never to have existed.”.

Amendment of section 35

3. Section 35 of the principal Act is amended—

- (a) in subsection (1), by substituting for the word “The” the words “Subject to subsections (1B) and (1C), the”; and
- (b) by inserting after subsection (1A) the following subsections:

“(1B) Where a patent application was filed before 1 August 2001, and was pending on that date, the duration of the patent granted on that application shall be twenty years from the date of filing or fifteen years from the date of grant, whichever is the longer.

(1c) The duration of a patent granted before 1 August 2001 and still in force on that date shall be twenty years from the date of filing or fifteen years from the date of grant whichever is the longer.”.

Amendment of section 52

4. Section 52 of the principal Act is amended by substituting for paragraph (a) the following paragraph:

“(a) the scope of the licence specifying in particular the period for which licence is granted;”.

New Part XIV_A

5. The principal Act is amended by inserting after Part XIV the following Part:

“PART XIV_A

INTERNATIONAL APPLICATIONS UNDER THE PATENT COOPERATION TREATY

Interpretation

78A. For the purposes of this Part—

“International Bureau” means the International Bureau of the World Intellectual Property Organization and, as long as it subsists, the United International Bureau for the Protection of Intellectual Property (BIRPI);

“international search” means a search conducted by the International Searching Authority appointed under Article 16 of the Treaty to discover relevant prior art with respect to the invention;

“international phase” means the period beginning from the filing of an international application to the time the international application enters the national phase;

“national phase” means the period beginning from the performance, by the applicant, of the acts specified in subsection 78o(1);

“receiving office” means the national office or the intergovernmental organization with which the international application has been filed;

“elected office” means the national office of or acting for the State elected by the applicant under Chapter II of the Treaty;

“designated office” means the national office of or acting for the State designated by the applicant under Chapter I of the Treaty;

“international preliminary examination” means a preliminary and non-binding examination carried out by the International Preliminary Examination Authority appointed under Article 32 of the Treaty on the questions of whether the invention appears to be novel, involves an inventive step and is industrially applicable;

“international application” means an application for a patent filed under the Treaty.

“Treaty” means the Patent Cooperation Treaty done at Washington on 19 June 1970;

Application

78B. The provisions of this Part shall apply to an international application filed under the Treaty.

Patent Registration Office as receiving office

78c. The Patent Registration Office shall act as a receiving office for an international application.

Patent Registration Office as designated office

78D. The Patent Registration Office shall act as a designated office for an international application in which Malaysia is designated for the purposes of obtaining a patent or utility innovation under Part VI.

Patent Registration Office as elected office

78E. The Patent Registration Office shall act as an elected office for an international application if the applicant elects Malaysia as a State in which he intends to use the results of the international preliminary examination.

Persons eligible for international application

78F. Any person who is a citizen or resident of Malaysia shall be entitled to file an international application for a patent with the Patent Registration Office.

Filing of an international application

78G. (1) An international application shall be filed by submitting to the Patent Registration Office a request in the prescribed form together with a description, one or more claims, drawings, if any, and an abstract.

(2) The request shall contain—

- (a) a petition to the effect that the international application be processed according to the Treaty;
- (b) the designation of the State or States in which protection for the invention is desired;
- (c) the name, nationality and residence of the applicant;
- (d) the name and the place of business of the applicant's agent, if any;
- (e) the title of the invention; and
- (f) the name and address of the inventor.

(3) The application shall be submitted together with the prescribed fee.

Filing date and the effect of filing an international application

78H. (1) The Registrar shall accord as the international filing date the date of receipt of the international application, if at the time of receipt—

- (a) the applicant, or if the application is made by more than one applicant, at least one of them, is a citizen or resident of Malaysia;
- (b) the international application is in the national language or English language;
- (c) the international application contains at least the following elements:
 - (i) an indication that it is intended as an international application;
 - (ii) the designation of the State in which the protection for the invention is desired;
 - (iii) the name of the applicant;
 - (iv) a description; and
 - (v) a claim or claims.

(2) If the Registrar finds that the international application does not, at the time of receipt, contain the elements listed in paragraph (1)(c), the Registrar shall request the applicant to file a correction within thirty days from the date of the request.

(3) The Registrar shall accord as the international filing date the date of receipt of correction if the applicant complies within the time specified in subsection (2).

(4) If the applicant does not comply with the request for correction within the time specified in subsection (2), the Registrar shall notify the applicant that his application is considered to have been withdrawn.

(5) The international application which fulfills the requirements as listed in paragraphs (1)(a) to (c) and has been accorded an international filing date shall have the effect of a patent application

under Part VI if Malaysia is a designated State in the application and the international filing date shall be considered to be the filing date.

Defects in international application

78i. (1) If an international application—

- (a) does not contain the title;
- (b) is not signed as provided for in the regulations;
- (c) does not contain the prescribed indications concerning the applicant;
- (d) does not contain an abstract; or
- (e) does not comply with the physical requirements as prescribed under the Treaty,

the Registrar shall request the applicant to make amendments within the time prescribed in the request.

(2) If the international application refers to a drawing or drawings which is or are not included in that application, the Registrar shall request the applicant to furnish the drawing or drawings within the prescribed time.

(3) The Registrar shall accord as the international filing date the date of receipt of the drawing or drawings if the applicant complies within the prescribed time.

(4) If the applicant fails to furnish the drawings within the prescribed time, any reference to the drawing or drawings shall be considered non-existent.

International application considered withdrawn

78j. (1) An international application shall be considered withdrawn if—

- (a) the applicant has failed to make the amendments within the prescribed time;
- (b) the prescribed fee has not been paid; or

(c) the Registrar finds that any of the requirements as listed in paragraphs 78H(1)(a) to (c) are not complied with, after an international filing date has been accorded to the international application.

(2) The Registrar shall inform the applicant in writing of the withdrawal and the reasons for the withdrawal.

Processing of international applications

78K. The Treaty and its rules shall apply to the processing of an international application during the international phase of the application.

International Searching Authority

78L. (1) The Registrar shall, by notification published in the *Gazette*, specify the International Searching Authority which is competent to carry out the international search for international applications filed with the Patent Registration Office.

(2) When there is more than one competent International Searching Authority, the applicant shall indicate his choice of International Searching Authority in the request.

International Preliminary Examination Authority

78M. (1) The Registrar shall, by notification published in the *Gazette*, specify the International Preliminary Examination Authority which is competent to carry out international preliminary examination for international applications filed with the Patent Registration Office.

(2) The applicant may request for an international preliminary examination to be carried out in respect of the application by submitting a demand in the prescribed form and paying the prescribed fee.

International publication of international application and its effect

78N. (1) The international publication of an international application by the International Bureau designating Malaysia as a designated office shall have the same effect as the making available for public inspection under section 34 of a patent application if the international publication is transmitted to and received by the Patent Registration Office.

(2) The Patent Registration Office shall make available the international publication of the international application designating Malaysia as a designated office for public inspection as soon as possible.

Entering the national phase

78o. (1) The applicant in respect of an international application designating Malaysia as a designated office shall before the expiration of thirty months from the priority date—

- (a) submit to the Patent Registration Office in the national language or English language—
 - (i) a request in the prescribed form;
 - (ii) a description;
 - (iii) a claim or claims;
 - (iv) a drawing or drawings, where required; and
 - (v) an abstract; and
- (b) pay the prescribed fee to the Patent Registration Office.

(2) If the applicant does not comply with the requirements of subsection (1) the application shall be considered to be withdrawn.

(3) Applications which have entered the national phase shall comply with the requirements of this Act.

(4) The Patent Registration Office shall not examine an international application designating the Patent Registration Office as designated office or elected office prior to the expiration of thirty months from the priority date.

(5) Notwithstanding subsection (4), the Patent Registration Office may, on the express request of the applicant, examine the international application at any time, if the applicant has fulfilled the requirements in subsection (1).

Search similar to international search for national applications

78p. (1) Any applicant who files a national application with the Patent Registration Office may request that a search similar to an international search be carried out on such application.

(2) The Patent Registration Office may subject a national application filed with it to an international search.

(3) In such cases, the description and the claims contained in the application shall be presented in the languages specified by the International Searching Authority, and the search fees shall be paid for by the applicant.

Conversion of an international application into a national application

78q. (1) Where a foreign receiving office has refused to accord a filing date to an international application, or the foreign receiving office has declared that the international application is considered withdrawn or the designation of Malaysia is considered withdrawn and copies of any document in the application have been sent to the Patent Registration Office at the request of the applicant, the Patent Registration Office shall decide whether such refusal or declaration is justified under the Treaty or its rules.

(2) If the Patent Registration Office finds that the refusal or declaration referred to in subsection (1) was the result of an error or omission, it shall treat the international application as if such error or omission had not occurred and shall treat the application as a patent application in accordance with the provisions of this Act.

(3) This procedure shall apply to an international application incorrectly declared by the International Bureau as having been withdrawn.”.

Repeal of section 13 of Act A1088

6. Section 13 of the Patents (Amendment) Act 2000 [*Act A1088*] is repealed.

