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The Legal 500 Country Comparative Guides Malaysia **INTELLECTUAL PROPERTY**

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This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Malaysia.

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MALAYSIA

INTELLECTUAL PROPERTY



1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how);

Patent

An invention that is new, involves an inventive step and is industrially applicable. An invention (which may relate to a product or process) that is an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.

Utility innovation

Innovation which creates a new product or process, or any new improvement of a known product or process, which is capable of industrial application.

Trade secrets, confidential information, know-how.

Confidential information or documents is guarded in law and in equity. The law protects information or documents that has the necessary quality of confidence,

and not useless or trivial information. The interpretation of confidential is a question of fact in each case. Considerations which courts have found to be relevant, in determining this question include:

(a) skill and effort was expended to acquire the information;

(b) the information is jealously guarded by the owner and is not readily made available to anyone;

(c) the information have been imparted in circumstances importing an obligation of confidence, or it was plainly made known to the recipient that the material or information is confidential;

(d) the usages and practices of the industry support the assertion of confidentiality.

The definition of confidential information and trade secret varies by industry, and once it enters the public domain, it may affect the status of confidentiality of those information or secret.

b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees);

Trademark

Any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. Trademark includes collective mark or certification mark.

“Sign” includes both conventional mark and non-conventional mark, namely any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion or any combination thereof.

A “sign” may constitute a trademark even though it is used in relation to a service ancillary to the trade or

business of an undertaking and whether or not the service is provided for money or money's worth.

Common law right

Goodwill, or reputation attached to goods or services or business (goodwill or reputation) is protected under the jurisprudence of common law through the tort of passing off.

Geographical indication

An indication which may contain one or more words which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin.

c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

Copyright

Categories of work protectable under the law of copyright are (a) literary works; (b) musical works; (c) artistic works; (d) films; (e) sound recordings; and (f) broadcasts.

Works are protected irrespective of their quality and the purpose for which they were created. However, copyright protection shall not extend to any idea, procedure, method of operation or mathematical concept as such.

A literary, musical or artistic work shall be eligible for copyright if -

(a) sufficient effort has been expended to make the work original in character; and

(b) the work has been written down, recorded or otherwise reduced to material form.

Registered industrial design

Features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, but does not include- (a) a method or principle of construction; or (b) features of shape or configuration of an article which- (i) are dictated solely by the function which the article has to perform; or (ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part. The aim is that the finished article must be sufficiently attractive so as to attract the eye of the

customer.

Protection of new plant varieties grants the exclusive right to the breeder of a new plant variety for the purpose of exploiting that variety. Primarily, the plant varieties are protected under the law since breeding new varieties of plants requires substantial investment in the form of skill, labour, time, financial expenditure and material resources.

The layout-design of an integrated circuit

Three-dimensional disposition of the elements of an integrated circuit and the interconnections of the integrated circuit.

Layout-Designs of Integrated Circuits Act 2000 protects semiconductor chips and the layout-design of an integrated circuit.

Right to privacy

A multi-dimensional concept recognised in Malaysia, ensuring individuals' freedom from unwarranted publicity and without undue interference from the government or private individuals in matters not concerning the public.

The right to privacy is recognised in modern society, allowing individuals to control the collection, use, and disclosure of personal information. This includes interests, habits, family records, education records, communication records, and medical records. Inaccurate or misleading computerised data can harm individuals easily, in which it could be transferred for an unauthorised third party at high speed at very little cost.

Personal data

Any information in respect of commercial transactions, which- (a) is being processed wholly or partly by means of equipment operating automatically in response to instructions given for that purpose; (b) is recorded with the intention that it should wholly or partly be processed by means of such equipment; or (c) is recorded as part of a relevant filing system or with the intention that it should form part of a relevant filing system, that relates directly or indirectly to a data subject, who is identified or identifiable from that information or from that and other information in the possession of a data user, including any sensitive personal data and expression of opinion about the data subject.

2. What is the duration of each of these intellectual property rights? What

procedures exist to extend the life of registered rights in appropriate circumstances?

Patents: The duration of a patent, upon registration, shall be for 20 years from the date of filing of the application (**section 35 of the Patents Act 1983 ("PA")**). An annual renewal fee must be paid to keep the patent in force.

Utility Innovations: The duration of a certificate for a utility innovation shall be for ten years from filing, extendable for two consecutive terms of 5 years, amounting to maximum 20 years of protection (**PA read together with the Second Schedule of the PA**). An annual renewal fee must be paid to keep the utility innovation in force.

Trade secrets, confidential information and knowhow: Common law protection. Duration of protection is potentially perpetual for so long as the information, documents and trade secrets or know-how remain confidential and secret: *Vision Cast Sdn Bhd & Anor v. Dynacast (Melaka) Sdn Bhd & Ors [2014] 8 CLJ 884*.

Trademarks: The duration of a registered trademark is for 10 years and is renewable every ten years indefinitely (**section 39 of the Trademarks Act 2019 ("TMA 2019")**). In a case of unrenewed trademark where- (a) the registration of trademark is not renewed; or (b) the registration of trademark has been deemed removed and has not been restored, a person other than the person who was registered as the proprietor of the unrenewed trademark may apply for the registration of trademark (**section 40(1) TMA 2019**). Further, an action for infringement may not be instituted in respect of an act that was done after the registration of trademark has expired or has been deemed removed and before it was renewed or restored (section 57 of TMA 2019).

Geographical indications: The registration of a geographical indication shall be for a period of 10 years from the date of registration. The registration of the geographical indication may be renewed for further periods of 10 years in respect of each renewal (**sections 18 and 19 of Geographical Indications Act 2022**).

Copyright: Copyright Act 1987 ("CA 1987") provides for the duration of copyright which depends on the type of work.

Literary, musical or artistic work: during the life of the author and shall continue to subsist until the expiry of a period of 50 years after his death. In the case of a work

of joint authorship, "life of the author" shall be construed as a reference to the author who dies last.

Literary, musical or artistic work (not been published before the death of the author): 50 years from the beginning of the calendar year next following the year in which the work was first published.

Literary, musical or artistic work (published anonymously or under a pseudonym): 50 years computed from the beginning of the calendar year next following the year in which the work was first published or first made available to the public or made, whichever is the latest.

Sound recording, films, works of Government, Government organisations and international bodies, typographical arrangement of a published edition and broadcasts continues to subsist until the expiry of 50 years computed from the beginning of the calendar year next following the year in which the sound recording, film government work, broadcasts and edition was first published or made.

Rights in a performance/ performer's rights: 50 years computed from the beginning of the calendar year next following the year in which the performance was given or was fixed in a sound recording.

Right to equitable remuneration: from the time the sound recording is published until the expiry of a period of 50 years computed from the beginning of the calendar year next following the year of publication or, if the sound recording has not been published, from the time of fixation of the sound recording until the expiry of a period of 50 years computed from the beginning of the calendar year next following the year of the fixation.

Industrial designs: The registration of an industrial design shall, upon registration, subsist for 5 years from the filing date of the application for the registration of the industrial design. The period of registration of an industrial design may be extended for 4 further consecutive terms of 5 years each, if an application for extension is made in the prescribed form, and the prescribed extension fee is paid before the expiration of the current term (**section 25 of the Industrial Designs Act 1996 ("IDA")**).

New plant varieties: The breeder's right to a registered plant variety shall take effect from the filing date of an application for the registration of the plant variety and grant of breeder's right and shall subsist for a period of twenty years from a registered plant that is new, distinct, uniform and stable or fifteen years for a registered plant that is new, distinct and identifiable.

Layout design of an integrated circuit: The duration

of protection is 10 years from the date of its commercial exploitation or 15 years from the date of creation if not commercially exploited. However, the protection granted to a layout design shall lapse 15 years after the date the layout-design is created.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

Patents/ Utility Innovation:

In the absence of any provisions in a contract of employment or work execution, patent rights for an invention made during the employment or work execution shall be deemed to accrue to the employer or the person who commissioned the work. However, if the invention gains an economic value much greater than the parties could reasonably have foreseen at the time of concluding the contract of employment or for the execution of work, the inventor is entitled to equitable remuneration fixed by the Court in the absence of agreement.

Where an employee whose contract of employment does not require him to engage in any inventive activity makes, in the field of activities of his employer, an invention using data or means placed at his disposal by his employer, the right to the patent for such invention shall be deemed to accrue to the employer, in the absence of any provision to the contrary in the contract of employment.

In the absence of agreement, the Court may determine equitable remuneration based on the employee's emoluments, the invention's economic value, and any employer-derived benefits. The rights conferred on the inventor shall not be restricted by contract. The person whose name is recorded in the Register of Patents as the grantee of a patent/utility innovation is the grantee.

Trademark:

The proprietor of a trademark, who has a right over the ownership of the trademark who is the first user of the trademark in the course of trade is the common law owner or proprietor of a trademark.

For registered trademark, the registered proprietor shall be the owner of the trademark. In all legal proceedings relating to a registered trademark, the Register shall be prima facie evidence of anything contained in the Register, including the ownership of the registered proprietor. The registration of the trademark shall, after the expiration of five years from the date of registration

be conclusive and taken to be valid in all respects unless there exist any exception under section 53(a), (b) or (c) of the Trademarks Act 2019.

Geographical indications:

Any person who is carrying on an activity as a producer in the geographical area with respect to the goods and includes an association of such persons; or a competent authority may file an application for registration of a geographical indication of any goods.

Copyright:

Copyright shall vest initially in the author.

Where a work- (a) is commissioned by a person who is not the author's employer under a contract of service or apprenticeship; or (b) not having been so commissioned, is made in the course of the author's employment, the copyright shall be deemed to be transferred to the person who commissioned the work or the author's employer, subject to any agreement between the parties excluding or limiting such transfer.

Industrial designs:

The author of an industrial design shall be treated as the original owner of the industrial design.

Where an industrial design is created in pursuance of a commission for money or money's worth, the person commissioning the industrial design shall, subject to any contrary agreement between the parties, be treated as the original owner of the industrial design.

Similarly, where an industrial design is created by an employee in the course of his employment, his employer shall, subject to any contrary agreement between the parties, be treated as the original owner of the industrial design.

New plant varieties:

The holder of a breeder's right shall have the right to exploit the registered new plant varieties commercially.

Layout-design:

The right holder of a protected layout-design shall be determined as follows: (a) if the layout-design is not created in pursuance of a commission or in the course of employment, the creator of the layout-design is the right holder; (b) if the layout-design is created in pursuance of a commission, the person who commissioned the layout-design is the right holder; and (c) if the layout-design is created by an employee in the course of his employment, the employer is the right holder.

A person can be a right holder even if he shares the right in the layout-design with a person who is not a qualifying person.

In a layout-design with multiple rights held by multiple individuals, a reference to the right holder is a reference to all rights holders. The consent requirements for a right holder will require consent from all rights holders.

4. Which of the intellectual property rights described above are registered rights?

The owner of **Patent, Utility Innovation, Trademark, Geographical Indication, Protection of New Plant Varieties** and **Industrial Design** may apply for registration of their rights in Intellectual Property Corporation of Malaysia.

Whilst owner for **Trademarks** may apply for registration of the Trademarks, nothing in Trademarks Act 2019 shall be deemed to affect the right of action against any person for passing off goods or services as those of another person or the remedies in respect of the goods or services.

Trademarks Act 2019 expressly provides that a registered trademark shall be a personal or moveable property and may be the subject of a security interest in the same way as other personal or moveable property.

Similarly, Industrial Designs Act 1996 provides that a registered industrial design is personal property and may be the subject of a security interest in the same way as other personal or moveable property. Any rights in respect of a registered industrial design may be enforced in like manner as in respect of any other personal or moveable property.

Copyright subsist by virtue of the Copyright Act 1987 (CA 1987). Work is protectable under the copyright law if it fulfil the requirements as set out in CA 1987.

Voluntary notification of copyright is available in Malaysia.

A copyright owner or an assignee of the copyright can file a voluntary notification of their works, to the Controller of Copyright. If the notification is accepted, the Controller or Deputy Controller will issue a letter stating the notification has been entered into the Register. True extracts from the Register can be certified as prima facie evidence, and these extracts are admissible in all courts. Copyright owners or assignees should take advantage of this voluntary notification procedure to avoid disputes and ensure their rights are protected.

There is no registration for the **layout design of an integrated circuit**.

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

Patent/ Utility Innovation

Who: Any person may make an application for a patent either alone or jointly with another.

What: An invention is patentable if it is new, involves an inventive step and is industrially applicable.

A utility innovation is an innovation which creates a new product or process, or any new improvement of a known product or process, which is capable of industrial application, and includes an invention.

How: Brief summary of the procedure for registration of patent

Stages	Steps	Brief summary
1.	Application filed	Non-compliance → Rectify by the Applicant Compliance - Date of filing issued
2.	Preliminary Examination (Formality examination)	Non-compliance → Rectify by the Applicant Compliance - Date of filing issued
3.	Publication of application	The Registrar shall publish in the Official Journal the prescribed information relating to a patent application to the extent that such information is in the possession of the Registrar- (a) after 18 months from the filing date, or if right of priority is claimed, the priority date of a patent application; or (b) at the request of the applicant for an early publication before the period specified in paragraph (a) in the form as determined by the Registrar together with the payment of the prescribed fee.
4.	Public inspection	Where a patent application has been published, upon receipt of a payment of the prescribed fee, the Registrar shall make available for public inspection in the prescribed manner relating to a patent application to the extent that such information or document is in the possession of the Registrar
5.	Third party observation	Any person may, within 3 months from the date of publication or 3 months from the entry of national phase, make observations on any matter relating to patentability of a patent application as may be prescribed and shall include the reason for such observations
6.	Request for substantive examination or modified substantive examination (must be filed within 18 months from the filing date of the application, or within 4 years from the filing date of the international application)	The application complies with those requirements of the Patents Act 1983 and the Patents Regulations 1986 → certificate of grant of the patent. The application does not comply with the Patents Act 1983 and the Patents Regulations 1986, the Registrar shall give the Applicant an opportunity to make observations on the report and to amend the application so as to comply with those requirements, within the prescribed period. The application complies with those requirements of the Patents Act 1983 and the Patents Regulations 1986 → certificate of grant of the patent

Expedited examination process is available in Malaysia. An applicant who requests or has requested for substantive examination may request the Registrar to undertake an expedited examination of the application once it has been made available for public inspection.

Trademarks

Who: Any person who claims to be the bona fide proprietor of a trademark may apply for the registration of the trademark if- (a) the person is using or intends to use the trademark in the course of trade; or (b) the person has authorized or intends to authorize another person to use the trademark in the course of trade.

What: Any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings

How: Brief summary of the procedure for registration of Trademark

Stages	Steps	Brief summary and process undertaken by Intellectual Property Corporation of Malaysia (IPCM)
1.	Application filed	Formality examination Fully satisfy with the formality requirement → IPCM will proceed with substantive examination Provisional refusal → Applicant be given chance to rectify the Application to the satisfaction of IPCM → IPCM will proceed with substantive examination
2.	Substantive examination	Fulfil all requirements → IPCM will issue letter of acceptance and proceed with publication of the Application in IP Journal for opposition Provisional refusal → Applicant may appeal by requesting for ex-parte hearing or filing submission or evidence • Fulfil all requirements → IPCM will issue letter of acceptance and proceed with publication of the Application in IP Journal for opposition • Does not fulfil all requirement → IPCM will issue a refusal
3.	Opposition	No opposition → Registration (Issuance of Certificate of Registration) Opposition → Application will proceed into opposition proceedings • Opposition dismissed → Registration (Issuance of Certificate of Registration) • Opposition allowed → Application dismissed

Any person aggrieved by the decision of the Registrar in relation to the above matters may appeal to the High Court. An applicant for the registration of trademark may, except for collective mark, certification mark and sign which are colour, sound, scent, hologram, positioning or sequence of motion, request the Registrar

for an expedited examination.

Voluntary notification of copyright

Who: Owner of the copyright in the work or an assignee of the copyright

What: (a) literary works; (b) musical works; (c) artistic works; (d) films; (e) sound recordings; and (f) broadcasts.

How: Brief summary for voluntary notification of copyright

Application filed → Copyright work recorded → Certificate issued

Industrial Design

Who: The original owner of an industrial design.

What: Features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged by the eye, but does not include- (a) a method or principle of construction; or (b) features of shape or configuration of an article which- (i) are dictated solely by the function which the article has to perform; or (ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part.

How: Brief summary for industrial design registration.

Stages	Steps	Brief summary and process undertaken by Intellectual Property Corporation of Malaysia (IPCM)
1.	Application filed	Formality examination Fully satisfy with the formality requirement IPCM will proceed with substantive examination Does not fulfil the formality requirements Applicant be given chance to rectify the Application to the satisfaction of IPCM -> IPCM will proceed with substantive examination
2.	Substantive examination	Fulfil all requirements Registration (Issuance of Certificate of Registration) Objected Applicant may rectify the Application • Fulfil all requirements, IPCM will issue Certificate of Registration • Does not fulfil all requirements, Application will be rejected
3.	Gazette	

Any person aggrieved by any decision or order of the Registrar may appeal to the Court.

Geographical indication

Who: Any person who is carrying on an activity as a producer in the geographical area with respect to the goods and includes an association of such persons; or a competent authority.

What: An indication which may contain one or more words which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin.

How: Brief summary for geographical indication registration

File application → Formality examination to see compliance with statutory requirement → Amendment in the event of non-compliance → Advertised for opposition → Registration

New plant varieties

Who: A breeder, the employer of the breeder, the successor in title of the breeder, a farmer or a group of farmers, local community or indigenous people who have carried out the functions of a breeder or any government or statutory body which has carried out the functions of a breeder.

What: A form of intellectual property right which grants breeders of new plant varieties exclusive rights to exploit their varieties, for a specific period of time.

How: Brief summary for new plant varieties registration

Stages	Steps	Brief summary
1.	Filing of application	On receiving the application and the prescribed payment of the official filing fees, the application is checked to see the required information and documents have been submitted. If so, the application is assigned a filing date and an application number.
2.	Preliminary examination	The application undergoes a preliminary examination to determine if the variety is novel and falls under prohibited areas. The denomination proposed meets the requirements. If non-compliance is found, a written notification is issued, and the applicant is invited to rectify within 30 days. If all requirements are met, the applicant is notified and invited to submit a substantive examination request.
3.	Request for substantive examination	Request for substantive examination with prescribed fee within 30 days, using various methods like document examination, on-site inspection, growing test, and subsequent growing test if necessary.
4.	Substantive examination	Application examined to ascertain compliance with the criteria of distinctness, uniformity and stability. Non-compliance will give an opportunity to applicant to put the application in order within 30 days.
5.	Publication	Compliance - publication in the Government Gazette Three-month period given for any party to file an opposition against the application.
6.	Opposition	Opponents can oppose a new plant variety registration application on the grounds of breeder's rights, non-compliance with PNPV requirements, public order, morality, or environmental impact. A notice of opposition must be submitted to the Board and applicant on Form PBVT 4. Within 30 days, both parties must submit documentary evidence supporting their cases. The Board will consider the evidence and give both parties an opportunity to submit. The Board will decide whether to reject or approve the application and notify the parties of its decision in writing. However, if the applicant fails to do so within stipulated time, the application will be treated as abandoned. On the other hand, should the opponent fail to comply with the Board's request, the opposition will be regarded as abandoned, and the application will be approved.
7.	Approval by Plant Varieties Board	The application is approved if there is no opposition or if the Board's decision favours the applicant. If the opponent's decision is favourable, the application is rejected.
8.	Deposit of samples	On approval of the application, the applicant is required to deposit samples of the seed or any other propagating material of the plant variety at a centre approved by the Board.
9.	Registration	After fulfilling the depository requirement, the application is registered and awarded a certificate of registration of a new plant variety and grant of a breeder's right. The registration and denomination are recorded in the Register of New Plant Varieties, and a publication in the Government Gazette is made to notify the public of the registration is made.

6. How long does the registration

procedure usually take?

Patents & Utility Innovations: 3 years or more.
(Expedited examination process is available)

Trademarks: 12 to 18 months (Expedited examination process is available)

Industrial Designs: 6 to 8 months

Voluntary notification of copyright: 2 to 3 months

Geographical Indications: 6 to 9 months

Protection of new plant varieties: 6 to 8 months

7. Do third parties have the right to take part in or comment on the registration process?

Patents:

Yes, pursuant to Patents (Amendment) Act 2022 (Act A1649):

- third party observation process is enshrined in Section 34A

Trademarks:

Yes, during the opposition stage.

Industrial Designs:

Only opposition to the restoration of the registration.

Geographical Indications:

Yes, during the opposition stage.

New Plant Varieties:

Yes, during the opposition stage.

8. What (if any) steps can the applicant take if registration is refused?

Patents & Utility Innovations:

The applicant has three months to submit corrections for incomplete application forms, which otherwise are considered invalid.

If statutory non-compliance occurs during the Preliminary Examination, the applicant has three months to submit corrections, which will be returned to the Preliminary Examination, or else the application is

refused. If a Request for Substantive or Modified Substantive Examination is not received, the application will be withdrawn.

If statutory non-compliance occurs during the Substantive Examination, the applicant has 2-3 months to submit corrections, which will be returned for the Substantive Examination, or the application is refused.

Any person aggrieved by any decision or order of the Registrar may appeal to the High Court: section 88 (1) of the Patents Act 1986 ("PA 1986"). The procedures of appeal shall be made in accordance with the rules of court in civil matters: section 88(2) of the PA 1986. Subsequently, any person aggrieved by the decision or order of the High Court may appeal to the Court of Appeal, and possibly with the leave of the Federal Court, to appeal to the Federal Court.

Trademarks:

The Applicant may appeal to IPCM whether during the Formality Examination Stage or Substantive Examination upon the issuance of a provisional refusal.

If the application for registration of trademark does not fulfil any requirements for registration of trademark, the Registrar shall inform the grounds of provisional refusal to the applicant by a written notice and the applicant shall have an opportunity to - (1) make representations; (2) amend the application so as to meet the conditions, amendments, modifications or limitations, as the Registrar deems fit to impose; or (3) furnish additional or any other information or evidence, within such period as the Registrar may specify in the written notice.

The application shall be deemed withdrawn if the applicant does not respond within such period as specified by the Registrar in the written notice.

The Registrar shall refuse the application if the applicant's response does not satisfy the Registrar that those requirements are fulfilled and the Registrar shall, if required by the applicant, state in writing the grounds of the total provisional refusal.

Any person aggrieved by the decision of the Registrar in relation to the following matters may appeal to the High Court.

Where an appeal lies to the Court against the decision of the Registrar relating to a total provisional refusal - (1) the Court shall, where necessary, hear the applicant and the Registrar; and (2) the appeal shall be heard on the material stated by the Registrar to have been used by the Registrar in arriving at his decision and no further grounds of provisional refusal to the acceptance of the

application shall be allowed to be taken by the Registrar other than those so stated except by leave of the Court.

Industrial Designs:

When the application does not fulfil the requirements, the applicant has three months to submit amendments before the application is deemed abandoned.

Any person who is aggrieved by a Registrar decision or order may appeal to the High Court.

Geographical Indications:

If the application for the registration of the geographical indication made by the applicant does not fulfil any of the requirements for registration of a geographical indication, the Registrar shall inform the applicant of the grounds of provisional refusal by a written notice and give the applicant an opportunity, within such period as the Registrar may specify in the written notice, to—
(1) make a representation by way of a written submission or hearing; (2) amend the application for registration of the geographical indication to meet any condition, amendment, modification or limitation as the Registrar thinks fit to impose; or (3) furnish additional or any other information or evidence. Where the applicant does not respond to the Registrar within such period as specified in the written notice, the application for the

registration of the geographical indication shall be deemed to be withdrawn. Where the response given by the applicant does not satisfy the Registrar, the Registrar shall refuse the application for the registration of the geographical indication, and upon an application made by the applicant in the form as determined by the Registrar together with payment of the prescribed fee, state in writing the grounds of the refusal. Upon examination, where the Registrar finds that the application for the registration of the geographical indication fulfils the requirements for registration of a geographical indication, the Registrar shall accept the application for the registration of the geographical indication.

Any person aggrieved by a decision of the Registrar in relation to the following matters may appeal to the High Court. The Court shall, where necessary, hear the applicant and the Registrar; and the appeal shall be heard on the material as stated by the Registrar to have been used by him in arriving at the decision and no additional ground of refusal to the acceptance of the application for registration of geographical indication shall be allowed to be introduced by the Registrar other than those so stated except by leave of the Court.

9. What are the current application and renewal fees for each of these intellectual property rights?

		Official Fees for application (RM)		Official fees for renewal
1.	Patent	Request for grant of patent for first ten claims/Entering national phase for international application for first ten claims	290	Annual fee for patent For second year after grant of patent to twentieth year after grant of patent: • RM290 • RM360 • RM440 • RM530 • RM630 • RM730 • RM830 • RM910 • RM990 • RM1,020 • RM1,140 • RM1,280 • RM1,450 • RM1,550 • RM1,900 • RM2,100 • RM2,400 • RM2,700 • RM2,900
		Every additional claim (per claim)	20	
		Statement justifying the applicant's rights to the patent	80	
		Request for substantive examination	1,100	
		Request for modified substantive examination	640	
2.	Utility innovation	Application for grant of a certificate for a utility innovation	140	Application to extend term of certificate for a utility innovation: RM150 Annual fee for certificate for a utility innovation For third year after grant of certificate to twentieth year after grant of certificate: • RM170 • RM240 • RM290 • RM350 • RM350 • RM420 • RM420 • RM480 • RM670 • RM940 • RM1,090 • RM1,270 • RM1,550 • RM1,650 • RM1,820 • RM1,930 • RM2,090 • RM2,200
		Statement justifying the applicant's rights to the certificate for utility innovation	100	
		Request for substantive examination/ modified substantive examination/ deferment	Refer to patent	
3.	Trademarks	Application for registration of trademark	950 (for each class - by adopting from the pre-approved list) 1100 (for each class - without adopting from pre-approved list)	RM 1000
		Series of trademark for the second and each subsequent trademark (maximum of 6)	50 (for each trademark)	
4.	Copyright	Notification of copyright in a work	200	-
		Administration fee for an application of notification of copyright made manually	50	
		Deposit of an electronic copy of the work for every additional 1GB after 3GB	20	
5.	Industrial design	Application for a single design	500	RM800
		Application for each additional design specified RM500	500	
		Publication for each view of the representation contained in the application	200	
6.	Geographical indications	Application for Registration of Geographical Indication	250	RM420
		Advertisement for Registration	450	

10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?

Patents and Utility Innovations

To keep the same in force, owners of patents or utility innovations must pay annual fees before expiration date, with a 6-month grace period allowed after payment of such surcharge. Failure to pay the prescribed fee results in the patent shall lapse and a notice of the lapsing of the patent for nonpayment of any annual fee shall be published in the Official Journal.

Within 12 months from the date on which a notice of the lapsing of a patent is published in the Official Journal, (a) the owner of the patent or his successor in title; or (b) any other person who would, if the patent had not lapsed, have been entitled to the patent, may apply to the Registrar in the form as determined by the Registrar together with the payment of the prescribed fee to have the patent reinstated.

Industrial design

An industrial design registration can be extended for four consecutive five-year terms if an application is made before the current term expires. A grace period of six months is granted for unpaid extension fees, subject to a surcharge. If an extension is not made, the registration will lapse, and a notice of lapse will be published in the Official Journal. If the owner fails to pay renewal fees, they have a six-month grace period to restore the registration, subject to a surcharge payment.

Within one year from the date on which the notice of lapse of the registration of an industrial design was published in the Official Journal, the owner or his successor-in-title may apply for the restoration of the registration of the industrial design by filing a request for restoration and making payment of surcharge for restoration.

Trademarks

Where the request for renewal is made on or before the date of expiry of the registration, the fee payable shall be the renewal fee as mentioned above.

Where the request for renewal is made within the period of six months after the date of expiry of the registration, the fees payable shall be the renewal fee as mentioned above and a surcharge shall be imposed.

A request for renewal shall be made not later than six months after the date of expiry of the registration.

Renewal shall take effect from the expiry of the previous registration. Non-renewal of registration will amount to removal. The registered proprietor can request restoration within six months of removal, along with the required fee. If restoration is not applied within six months, the registration ceases. The renewal or restoration of the registration of a trademark shall be published in the Intellectual Property Official Journal.

In a case of unrenewed trademark where- (a) the registration of trademark is not renewed; or (b) the registration of trademark has been deemed removed and has not been restored, a person other than the person who was registered as the proprietor of the unrenewed trademark may apply for the registration of trademark.

Geographical Indications

A registered proprietor may, on or before the date of expiry of the registration, renew the registration of a geographical indication.

Renewal may still be filed during the grace period of 6 months after the date of expiry of the registration provided that the payment of surcharge is made.

In the case where the registered proprietor does not renew the registration of the geographical indication after six months of the expiry date of the registration, the geographical indication shall be deemed to be removed.

Where the geographical indication has been deemed to be removed, the registered proprietor may apply for the restoration of the removed registration within six months from the date of the removal together with payment of the prescribed fee.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

Deed of assignment, the relevant prescribed form and the requisite filing fees.

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Patents

A patent application or patent may be assigned or transmitted in the same way as other personal or

moveable property.

Any person becoming entitled by assignment or transmission to a patent application or patent may apply to the Registrar to have such assignment or transmission recorded in the Register.

No such assignment, transmission or security interest transaction shall be recorded in the Register unless- (a) the prescribed fee has been paid to the Registrar; (b) in the case of an assignment, it is in writing signed by or on behalf of the contracting parties. No such assignment or transmission shall have effect against third parties unless so recorded in the Register.

Trademarks

A registered trademark shall be a personal or moveable property and may be the subject of a security interest in the same way as other personal or moveable property.

A registered trademark shall be transmissible by assignment or transmission in the same way as other personal or moveable property and shall be so transmissible either in connection with the goodwill of a business or independently.

An assignment or other transmission of a registered trademark may be partial which is limited so as to apply in relation to some but not all of the goods or services for which the trademark is registered.

An assignment of a registered trademark, or an assent relating to a registered trademark, shall not be effective unless it is in writing and is signed by or on behalf of the assignor and assignee, or a personal representative.

The particulars of the assignment shall be entered in the Register on application being made. Until an application has been made and approved by the Registrar, the assignment shall be ineffective against a person acquiring a conflicting interest in or under the registered trademark in ignorance of the transaction.

Similarly, the assignee shall not be entitled to damages or an account of profits in respect of any infringement of the registered trademark occurring after the date of the transaction and before the date of the application for the registration made as mentioned above.

Industrial designs

A registered industrial design is personal property and is capable of assignment, transmission or being dealt with by operation of law in the same way as other personal or moveable property.

An assignment of a registered industrial design or an

application for the registration of an industrial design shall not be effective unless it is in writing and signed by or on behalf of the assignor and the assignee or, as the case may be, a personal representative thereof.

Where a person becomes entitled to- (a) a registered industrial design, or (b) an application for the registration of an industrial design by way of an assignment or transmission or by operation of law, he shall apply to the Registrar in the prescribed manner to record his title or interest in the Register. The Registrar shall record the particulars of the title or interest referred above in the Register. No assignment or transmission or operation of law or security interest transaction in respect of a registered industrial design shall have effect against third parties unless recorded in the Register.

Copyrights

Similarly, copyright shall be transferable by assignment, testamentary disposition, or by operation of law, as movable property.

An assignment of copyright may be limited so as to apply only to some of the acts which the owner of the copyright has the exclusive right to control, or to only part of the period of the copyright, or to a specified country or other geographical area.

No assignment of copyright shall have effect unless it is in writing.

An assignment by one copyright owner shall have effect as if the assignment is also granted by his co-owner or co-owners, and subject to any agreement between the co-owners, fees received by any of the owners shall be divided equally between all the co-owners.

An assignment may be effectively granted or made in respect of a future work, or an existing work in which copyright does not yet subsist, and the future copyright in any such work shall be transferable by operation of law as movable property.

New Plant Varieties

A breeder's right may be assigned with the approval of Board and the application shall be made in the manner to be specified by the Board in writing and accompanied with the prescribed fee. The assignment may be approved if it is in writing signed by or on behalf of the contracting parties or the holder or the applicant for the registration of a new plant variety and grant of a breeder's right dies or becomes incapacitated.

Layout-design

The protected layout-design is a personal property. Thus, it shall be transmissible by way of assignment or license. An assignment may be total or partial. It is important that the assignment shall be effective only when the assignment is in writing and signed by or on behalf of the assignor and the third party has notice of the assignment, whether actual or constructive.

13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

The licence must be reduced into writing and signed by or on behalf of the contracting parties.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Not mandatory.

However, there are advantages to have a license recorded in the Register. For example, under the Trademarks Act 2019, every person shall be deemed to have notice of a licence if the particulars of the grant of the licence are entered in the Register.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

Patents:

A "licence contract" is defined in the Patents Act 1983 to mean any contract by which the owner of a patent (the "licensor") grants to another person or enterprise (the "licensee") a licence to exploit the patented invention.

A licence contract shall be in writing signed by or on behalf of the contracting parties.

There is no distinction between the rights of exclusive and non-exclusive licensees to request the patentee to institute infringement proceedings unless there are provisions to the contrary in the licence contract.

Rights of the licensor, and the rights or limitation of the licensee may be clearly provided in the licence contract.

Where the patentee refuses or fails to institute infringement proceedings within three months from the receipt of the request, the licensee is able to institute

the proceedings in his own name after notifying the patentee of his intention to do so. The patentee has the right to join in the proceedings.

Trademarks:

There is a distinction between the rights of an exclusive and non-exclusive licensee with regards to enforcement of IP rights.

A licensee shall be entitled to bring infringement proceedings against the infringer in his own name. A licensee shall be entitled, unless his licence or any license through which his interest is derived, provides otherwise, to call on the registered proprietor of the trademark to take infringement proceedings in respect of any matter which affects his interests. If the registered proprietor refuses or does not take infringement proceedings within two months after being called upon, the licensee may bring the proceedings in his own name as if he were the registered proprietor. Where infringement proceedings are brought by a licensee, the licensee may not, without leave of the Court, proceed with the action unless the registered proprietor is either joined as a plaintiff or added as a defendant.

An exclusive licensee need not call on the registered proprietor of the trademark to take infringement proceedings. It is noteworthy that where proceedings for infringement of a registered trademark brought by the registered proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the registered proprietor or the exclusive licensee may not, without leave of the Court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

Copyright:

There is no distinction between the rights of exclusive and non-exclusive licensees in respect of enforcement. Except against the copyright owner, the exclusive licensee shall have the same rights of action and be entitled to the same remedies as those available in a legal action brought by a copyright owner for infringement of copyright as if the licence had been an assignment.

Where an action for infringement of copyright is brought either by the copyright owner or the exclusive licensee, and the action relates to an infringement in respect of which they have concurrent rights of action under that section, he is not entitled, except with the leave of court, to proceed with the action unless the copyright owner or the licensee is joined as a plaintiff in the action or added

as a defendant. An exclusive licensee, however, may obtain an interlocutory injunction without having to join the copyright owner as a party in the application.

Where an action, in so far as it is brought by the copyright owner for infringement of copyright, relates to an infringement in respect of which the owner of the copyright and the exclusive licensee have concurrent rights of action, and an account of profits is directed to be taken in respect of that infringement, then subject to any agreement of which the court is aware whereby the application of those profits is determined as between the owner of the copyright and the exclusive licensee, the court shall apportion the profits between them as the court may consider just.

Industrial Designs:

Where an exclusive or non-exclusive licensee intends to institute any infringement proceedings, the licensee must prove that they had made a prior request to the registered owner to institute proceedings for the infringement complained of by him and that the registered owner had refused or failed to institute the proceedings within three months from the receipt of the request. The registered owner however still has the right to join the proceedings.

Layout-design:

An exclusive licensee shall have the same rights of action and shall be entitled to the same remedies for the infringement of those rights against a successor in title to the right holder as he is entitled to against the right holder.

For matters relating to after the grant of the exclusive license as if the licence had been an assignment, an exclusive licensee shall have the same rights of action and entitled to the same remedies except against the right holder.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

Trademarks

Under the **Trademarks Act 2019 (“TMA 2019”)**, the following infringing acts may amount to a criminal offence:

1. Counterfeiting a trademark;
2. Falsely applying a registered trademark to goods or

services;

3. Making or possessing an article which is designed or adapted for making copies of a registered trademark;
4. Importing or selling goods with a falsely applied registered trademark.

Under **TMA 2019**, the relevant procedure on investigation and enforcement of the criminal offences are provided in Part XVI. Criminal charges in respect of false application of trademarks to goods and services are further provided under **TDA 2011**.

Copyright

Copyright infringement – a fine of not less than RM2,000 and not more than RM20,000 for each infringing copy, or to imprisonment for up to 5 years or to both and for any subsequent offence, to a fine of not less than RM4,000 and not more than RM40,000 for each infringing copy or to imprisonment for a term not exceeding 10 years or to both as stated in **S. 41 Copyright Act 1987 (“CA 1987”)**.

Patent, Utility Innovations, and Industrial Designs

There are no criminal sanctions for infringement of patents, utility innovations or industrial designs. However, there are certain offences provided under the PA and IDA respectively. Under the PA, an applicant of a patent or utility innovation has an obligation to file said patent or utility innovation first in Malaysia, unless the applicant obtains a written authority by the Registrar. The failure to comply with this obligation may result in criminal sanctions and if convicted may be liable to a fine not exceeding RM15,000 or to imprisonment for a term not exceeding two years or to both under S. 62A of PA. Further any person who falsely represents that anything disposed by him for value is a patented product or process; or falsely represent that a patent has been applied for in respect of any article disposed of for value by him, commits an offence and is liable upon conviction to a fine not exceeding RM15,000 or to imprisonment for a term not exceeding two years or to both. Under the IDA, any person who falsely represents that anything disposed of by him for value is an article protected by an industrial design registration commits an offence and shall be liable on conviction to a fine not exceeding RM15,000 or to imprisonment for a term not exceeding 2 years or to both under S. 37 of IDA.

Invocation of Criminal Sanctions

To invoke the criminal procedure as provided under the respective IP statutes, a police report or a report to the relevant ministry i.e. Ministry of Domestic Trade and

Cost Of Living Affairs (“MDTCA”) is needed. Following from the report to the MDTCA, the investigating team may require the attendance of individuals to give their statements. From there, the investigating team will prepare an investigation paper, that will be sent to the prosecuting officer who will have the discretion to prefer a charge against the wrongdoer.

Geographical Indications

Any person who falsely applies a registered geographical indication or any indication directly or indirectly referring the geographical indication to the goods commits an offence.

17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

Malaysian Courts are proactive in guarding the rightful owners of intellectual property rights such as patents, utility innovations, trademarks, copyright, industrial designs, trade secret, confidential information, right of privacy and geographical indications in respect of their intellectual property rights against infringers. The owners may enforce their rights against infringer via civil actions: Possible reliefs include declarations (of infringement and non-infringement), injunctions (permanent injunction or interim injunction), damages, search and seizure orders, account of profits and statutory damages, or in suitable cases for additional damages.

The proceedings for patent infringement may not be instituted after 6 years from the act of infringement.

The proceedings for utility innovation infringement may not be instituted after 5 years from the act of infringement.

The proceedings for registered industrial designs infringement may not be instituted after 5 years from the act of infringement.

18. What is the length and cost of such procedures?

Civil proceedings may take between 9 – 12 months. The costs of full trial may varies depending on subject matter and complexity.

19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

High Court has originating jurisdiction to hear all IP disputes. Nature of the dispute will determine if the dispute is to be initiated by way of a Writ of Summons or Originating Summons. Writ of Summons: Where there is substantial dispute as to facts. In this case, the issue of fact will be determined after taking viva voce evidence during trial.

Originating Summons: Where there is unlikely any substantial dispute as to facts. The proceedings will be determined based on affidavit evidence. Time to judgment is approximately 9-12 months. Reliefs available depend on the subject matter and generally includes damages, injunctions and costs. Appeal is possible to the Court of Appeal and finally to the Federal Court.

For example, the TMA 2019 codifies the remedies available to a plaintiff in an infringement action as follows:

1. Mandatory or restraining injunctions;
2. Damages;
3. An account of profit;
4. Additional damages, in an appropriate case, where infringement involves a counterfeit trademark;
5. Order for erasure;
6. Order for delivery up of infringing goods, materials or articles; or
7. Order for disposal of infringing goods, material or articles.

A successful plaintiff in an infringement action may now be awarded both damages and an account of profits (attributable to the infringement that have not been taken into account in computing the damages).

20. What customs procedures are available to stop the import and/or export of infringing goods?

Trademarks: Trademark counterfeiting activities can be combated at the borders of the country through the seizure and detainment of counterfeit goods, which involves both the Registrar of Trademarks and Malaysian

Customs authorities, which is conducted upon application by the registered proprietor or his agent to the Registrar. Border measures do not apply to unregistered trademarks. Part XIII TMA 2019 specifically provides for border measures. A registered proprietor or licensee may file an application with the Registrar if he believes that infringing goods are to be imported. The Registrar will notify the applicant whether his application has been approved. If it has, the applicant must pay a security deposit with the Registrar. The Registrar will notify authorised officers of the particulars of the application, who will then prohibit importation of the infringing goods identified in the application. Any such goods will be seized and detained. Following seizure, the authorised officer will notify the Registrar, importer, and applicant of the seizure and specify a period within which the applicant must institute an action for infringement, failing which the infringing goods will be released to the importer.

Copyright: The enforcement bodies such as the police and the Ministry of Domestic Trade and Cost Of Living Affairs have been granted with wide enforcement powers. They have been granted with the power to enter any premises where there is reasonable cause to suspect that there are infringing goods or equipment for making such goods or equipment for making such goods, and to seize such goods or equipment with a warrant. Seizures can be effected without a warrant if there are reasonable grounds to believe that the infringing goods or equipment may be destroyed or removed from the premises due to a delay in obtaining a warrant. The Copyright (Amendment) Act 2012 has extended the right of the police to gain access to computerised or digitalised data when carrying out investigations.

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

There is no mandatory system in relation to non-court enforcement options or dispute resolution mechanisms to be elected for IP disputes.

22. What options are available to settle intellectual property disputes in your jurisdiction?

Parties may settle IP disputes even after the proceedings is commenced in Court. There is also an option for mediation, which may be explored by parties.

Where there is existing contractual relationship between the parties, and the parties have agreed to determine their disputes by way of arbitration, they are bound by the terms of their agreement.

23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

Patents: Infringement of a patent involves the exploitation of a patented invention by a person other than the owner of the patent and without the consent of the owner in relation to a product or a process falling within the scope of protection of the patent. The exploitation refers to any of the following acts:

1. Making, importing, offering for sale, selling, using the product or stocking such product for the purpose of offering for sale, selling or using when the patent has been granted in respect of a product.
2. Using the process or doing any of the acts referred above in respect of a product obtained directly by means of the process when the patent has been granted in respect of a process.

Utility Innovation: Infringement of a certificate for a utility innovation involves the exploitation of the utility innovation by a person other than the owner of the certificate and without the agreement of the owner in relation to a product or a process falling within the scope of protection of the utility innovation. The exploitation means any of the following acts:

1. Making, importing, offering for sale, selling, using the product or stocking such product for the purpose of offering for sale, selling or using when the certificate has been granted in respect of a product.
2. Using the process or doing any of the acts referred above in respect of a product obtained directly by means of the process when the certificate has been granted in respect of a process.

Confidential information: There is a breach of confidence where the following three elements is established by the plaintiff to the satisfaction of the court:

1. The information which the plaintiff is seeking to protect is of a confidential nature
2. The information in question was communicated in circumstances importing an obligation of confidence; and

3. There must be an unauthorised use of that information to the detriment of the party who communicated it.

Trademarks: The following acts amount to infringement of registered trademark:

1. A person infringes a registered trademark if he uses a sign (in the course of trade, without the consent of the registered proprietor) which is
 2. identical with the registered trademark + identical goods or services, or
 3. identical with the registered trademark + similar goods or services + resulting in the likelihood of confusion on the part of the public, or
 4. similar to the registered trademark + identical/ similar goods or services + resulting in the likelihood of confusion on the part of the public.

Tort of passing off: In order to prove passing off, the plaintiffs must establish:

1. goodwill or reputation attached to his goods or services (goodwill or reputation);
2. a misrepresentation is done by the defendants (misrepresentation); and
3. he has suffered or likely to suffer a loss due to the defendants' misrepresentation (damage).

Copyright: Copyright is infringed by any person who does, or causes any other person to do, without the licence of the owner of the copyright, the following:

1. reproduce in any material form;
2. communicate to the public;
3. perform, show or play to the public;
4. distribute copies to the public by sale or other transfer of ownership; or
5. rent (commercial) to the public, of the whole work or a substantial part thereof, either in its original or derivative form.

Copyright is infringed by any person who, without the consent or licence of the owner of the copyright, imports an article into Malaysia for the purpose of

1. selling, letting for hire, or by way of trade, offering or exposing for sale or hire, the article;
2. distributing the article-

- for the purpose of trade; or
 - for any other purpose to an extent that it will affect prejudicially the owner of the copyright;
- or

3. by way of trade, exhibiting the article in public, where he knows or ought reasonably to know that the making of the article was carried out without the consent or licence of the owner of the copyright.

Industrial Designs: A person infringes the rights conferred by the registration of an industrial design if he, without licence or consent of the owner of the industrial design:

1. applies the industrial design or any fraudulent or obvious imitation of it to any article in respect of which the industrial design is registered;
2. imports into Malaysia for sale, or for use for the purposes of any trade or business any article to which the industrial design or any fraudulent or obvious imitation of it has been applied outside Malaysia without the licence or consent of the owner; or
3. sells, or offers or keeps for sale, or hires or offers or keeps for hire any of the articles as described above while the registration is still in force.

Geographical Indications: Any interested person of goods identified by a geographical indication may institute Court proceedings against any person for carrying out the following act in relation to the geographical indication:

1. the use in the course of trade of a geographical indication by any means in the designation or presentation of any goods that indicates or suggests, in a manner which misleads the public as to the geographical origin of the goods, that the goods in question originate in a geographical area other than the true place of origin of the goods;
2. any use in the course of trade of a geographical indication which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time, as specified in the Schedule;
3. any use in the course of trade of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or a geographical indication identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even if the true origin of the wines or spirits is indicated or the

geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style” or “imitation” or any similar word or expression.

24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties’ expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

The High Court of Malaya at Kuala Lumpur has a specialised Court who hears all IP disputes. Experts may be appointed by the Court or parties. As Malaysia adopts the adversarial system, it is the burden of both parties to present all the facts they intend to rely on. The Malaysian Court system provides for discovery applications to be made.

25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

Writ: Evidence tendered through witnesses and is open to cross examination. It is employed in every case.

Originating Summons: the Court will look at affidavit evidence and rebuttals.

26. What defences to infringement are available?

The following is some of the possible defences. It is not exhaustive.

Patents: The most common defence to patent infringement is that the patent is invalid on the following grounds:

1. The patent is not novel, does not contain an inventive step or the patent is not industrially applicable;
2. The description or the claim of the patent is insufficient to be deemed clear and concise and fully supported by the description;

3. That any drawings which are necessary for the understanding of the claimed invention have not been furnished;

4. That the right to the patent does not belong to the person to whom the patent was granted; or

5. That incomplete or incorrect information has been deliberately provided or caused to be provided to the Registrar.

Other defences to patent infringement include:

1. Monopoly rights of a patentee are confined to activities which are carried out for industrial or commercial purposes only and in particular not to acts done only for scientific research;

2. Patent owners cannot control acts which are carried out in order to make, use, offer to sell or sell a patented invention solely for uses reasonably related to the development and submission of information to the relevant authority which regulates the manufacture, use or sale of drugs;

3. A patentee or any third party who has his consent, who has placed patented products into circulation for the first time in the marketplace cannot thereafter utilise his exclusive rights as a patentee to control subsequent dealings with the products.

4. Where the infringing act has been committed with the conditional or unconditional consent of the patent owner or his licensee.

5. The rights of a patentee do not extend to the use of the patented invention on any foreign vessel, aircraft, spacecraft or land vehicle temporarily in Malaysia.

6. No infringement proceedings can be taken where the patent has lapsed and has not been reinstated.

7. Where the act is done pursuant to a compulsory licence.

8. Where the exploitation is committed by the Government or any person authorised by the Government.

9. Where a person, at the priority date of the patent application, has used the patented product or process in good faith.

10. A purchaser of a patented article has an implied licence to repair it as long as the repair does not amount to the making of a new article.

Utility Innovation: Similar to patents, the most

common defence to utility innovation infringement is invalidation. The grounds to invalidate a utility innovation are similar to the grounds to invalidate a patent, except for lack of inventive step. Reason being inventive step is not a requirement for a certificate for a utility innovation.

Other defence to utility innovation infringement include:

1. Monopoly rights of a certificate owner are confined to activities which are carried out for industrial or commercial purposes only and in particular not to acts done only for scientific research;

2. Certificate owners cannot control acts which are carried out in order to make, use, offer to sell or sell a utility innovation for which a certificate has been granted solely for uses reasonably related to the development and submission of information to the relevant authority which regulates the manufacture, use or sale of drugs;

3. A certificate owner or any third party who has his consent, who has placed the certificated products into circulation for the first time in the marketplace cannot thereafter utilise his exclusive rights as a certificate owner to control subsequent dealings with the products.

4. Where the infringing act has been committed with the conditional or unconditional consent of the owner.

5. The rights of an owner do not extend to the use of the utility innovation on any foreign vessel, aircraft, spacecraft or land vehicle temporarily in Malaysia.

6. No infringement proceedings can be taken where the certificate for a utility innovation has lapsed and has not been reinstated.

7. Where the exploitation is committed by the Government or any person authorised by the Government.

8. Where a person, at the priority date of the application for a certificate for a utility, has used the protected product or process in good faith.

9. A purchaser of an article for which a certificate has been granted has an implied licence to repair it as long as the repair does not amount to the making of a new article.

In the case of **Emerico Sdn Bhd v Maxvigo Solution Sdn Bhd [2020] 1 LNS 206**, the Defendant in that case attempted to move the Court to invalidate a granted utility innovation on the grounds of procedural non-compliance (which is not provided under Section 56 of the PA. The High Court agreed with the submission for

the Plaintiff and held that the grounds to invalidate a patent or utility innovation are as provided under Section 56 of the PA and the Defendant cannot rely on other grounds not provided in that provision. In the recent case of **Emerico Sdn Bhd v Nefcom Technologt Sdn Bhd [2022] 1 LNS, 2724**, the court dismissed the plaintiff's claim by adopting the Essential Integers Test as the test for infringement of utility innovations. Under the Essential Integers Test, the principle is that to constitute infringement, the article must take each and every one of the essential integers of the claim. Non-essential integers may be omitted or replaced by mechanical equivalents. Thus, the court held that ascertaining whether the product infringe the plaintiff's utility innovations involves the product being compared with the plaintiff's utility innovations claim. The product will only infringe the Plaintiff's utility innovations if it contains all of the essential integers of the plaintiff's utility innovations claim.

Confidential information: The common defence:

1. The information is not confidential but is common knowledge
2. The information claimed to be confidential is not clearly identified
3. There is just cause or excuse for the disclosure

Trademarks: The TMA 2019 provides for the defences against infringement:

1. the use in good faith by a person of his own name, or the name of his or his predecessor's business;
2. the use in good faith a sign to indicate the kind, quality, quantity, intended purposes, value, geographical origin or other characters of the goods or services in accordance with honest practices in industrial or commercial matters;
3. the use in good faith a sign to indicate the time of production of goods or the rendering of the services in accordance with honest practices in industrial or commercial matters;
4. the use in good faith by a person to indicate the intended purpose of goods including accessories or spare parts or service in accordance with honest practices in industrial or commercial matters;
5. the owner or his predecessors in business have continuously used his mark from a date before the use of the registered trademark by the registered proprietor, his predecessor in business, or a registered user of the mark or before registration of the trademark, whichever

is earlier;

6. a person uses a trademark in relation to goods or services where the registered proprietor or registered user has expressly or impliedly consented to;
7. the use for a non-commercial purpose;
8. the use for the purpose of news reporting or news commentary;
9. the use of a trademark, which is one of two or more registered trademarks which are substantially identical, in the exercise of the right to the use of that trademark given by registration; and
10. the registered trademark is used by concurrent proprietors.

The Trademarks Act 2019 further provides:

- a) An action for infringement may not be instituted in respect of an act that was done after the registration of trademark has expired or has been deemed removed and before it was renewed or restored.
- b) The registered proprietor is not entitled to recover any relief for infringements or any happening prior to the date on which the application for protection of the trademark is made and become registered in Malaysia.

In addition, the remedy for groundless threats of infringement proceedings is available where any aggrieved person may bring proceedings against a person who threaten him with proceedings for infringement of a registered trademark for relief, namely:

- (a) a declaration that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; or
- (c) damages in respect of any loss he has sustained by the threats

The groundless threat remedy is not available to the person who –

- (a) apply the trademark to goods or to material used or intended to be used for labelling or packaging goods;
- (b) import goods to which, or to the packaging of which, the trademark has been applied; or
- (c) the supply of services under the trademark.

Geographical Indications: The use of a geographical

indication—

1. which is contrary to public order or morality in Malaysia;
2. which is not or has ceased to be protected in its country or territory of origin;
3. in relation to any goods or services which is identical with the term customary in the common language as the common name of the goods or services in Malaysia;
4. which is identical with the customary name of a grape variety existing in Malaysia as of 1 January 1995, with respect to products of the vine of that grape variety; or
5. which is not registered under the Geographical Indications Act 2022, and which has fallen into disuse in its country or territory of origin.

No action shall be brought against any person for the use of a trademark which contains or consists of a geographical indication after the expiry of five years— (a) from the date of such use by the person or his predecessor in title has become generally known in Malaysia; or (b) from the date of registration of the trademark by the person under the Trademarks Act 2019, whichever is earlier. The use by a qualified person of a particular geographical indication of another country identifying wines or spirits in relation to any goods or services if the qualified person has, or he and his predecessor in title have, continuously used that geographical indication in Malaysia in relation to those goods or services or related goods or services either— (a) for at least ten years before 15 April 1994; or (b) in good faith before 15 April 1994.

Copyright: It is not copyright infringement where:

1. Acts restricted by copyright is done by way of fair dealing including for purposes of research, private study, criticism, review or the reporting of news or current events;
2. Incidental inclusion of a copyright work in an artistic work, sound recording, film or broadcast and their reproduction and distribution of copies situated in a place where it can be viewed by the public;
3. Private recording of broadcasts or any of its copyrighted work to be watched later;
4. If the use of the copyright work is made by way of illustration for teaching purposes and is compatible with fair practice;
5. any use of a work for the purpose of an examination by way of setting the questions, communicating the

questions to the candidates or answering the questions or a reproduction of a work included in a broadcast intended for educational institutions;

6. Use made of a work by or under the direction or control of the Government, provided certain conditions are satisfied;

7. Any use of a work for the purposes of any judicial proceedings, a legislative body or for the purpose of the giving professional advice by a legal practitioner;

8. Certain uses in relation to computer programs;

9. The infringing act is done by way of parody, pastiche or caricature;

10. Reading or recitation in public or in a broadcast by a person of any reasonable extract from a published literary work if accompanied by sufficient acknowledgement;

11. The making and issuing of copies of any work into a format to cater for the special needs of people who are visually or hearing impaired and the issuing of such copies to the public by non-profit making bodies or institutions;

12. the performance, showing or playing of a work by a non-profit making club or institution for charitable or educational purpose with no admission fee;

13. Reproduction of work by broadcasting service intended exclusively for lawful broadcasting;

14. the making of quotations from a published work if they are compatible with fair practice, reproduction of articles on current topics or for informatory purposes;

15. The making of a transient and incidental electronic copy of a work made available on a network where such copy is required for the viewing, listening or utilisation of the work.

Industrial Designs

Similar to patents and utility innovations, the most common defence for industrial design infringement is invalidation. An industrial design may be revoked where it was not new at the priority date of the application for registration and where it is contrary to public order or morality. It may be cancelled where the registration has been procured by unlawful means.

27. Who can challenge each of the intellectual property rights described

above?

Generally, an aggrieved person may make an application to the Court to revoke the IP rights described in section A. For example, **section 56 of the Patents Act 1983** provides that “any aggrieved person may institute Court proceedings against the owner of the patent for the invalidation of the patent.” **Section 47 of the Trademarks Act 2019 (“TMA 2019”)** provides that “the registration of trademark may be declared invalid by the Court upon the application by an aggrieved person on the ground that the trademark was registered in breach of section 23”. Section 46 of the TMA 2019 provides that “the registration of a trademark may be revoked by the Court on an application by an aggrieved person on any of the grounds” of non-use. The definition of an “aggrieved person” for trademark matters may be elicited from the case of **McLaren International Ltd v. Lim Yat Meen [2009] 4 CLJ 749** where the Federal Court held: “a person aggrieved is a person who has used his mark as a trade mark- or who has a genuine and present intention to use his mark as a trade mark- in the course of a trade which is the same or similar to the trade of the owner of the registered trade mark that the person wants to have removed from the register.” The same principles above may apply with regards to other intellectual property rights. Only a person with a genuine and present intention to use the IP may make an application to revoke a previously granted IP right. For instance, in the case of **Tan Yock Kuan & Anor v Cew Sin Plastics Pipe Sdn Bhd [2019] 1 LNS 681**, the High Court held that the Defendant was “aggrieved” because the Plaintiff by way of the original action has applied for relief against the Defendant for infringement of the utility innovation. In the recent case of **China Green Food Development Center v Cheong Chong Fong [2023] 5 CLJ 719**, the court laid down that a person is an aggrieved person in a trademark claim when:

- i. he has shown that he used his mark as a trademark;
- ii. he has a genuine and present intention to use his mark as a trademark;
- iii. the use or intention to use of that trademark is in the course of a trade;
- iv. the trade in issue must be one which is the same as or similar to the trade of the owner of the registered trademark that the person wants to have removed from the Register.

Section 24 of the Industrial Designs Act 1996 (“IDA 1996”) enable any person aggrieved to apply to Court for rectification of the Industrial Design Register. **Section 27 of the IDA 1996** enable any person may

apply to the Court for the revocation of the registration of the industrial design. **Section 23 of the Geographical Indications Act 2022** provides that “the Court may, on the application of any person..., cancel the registration of a geographical indication...”

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

For some intellectual property rights, it may be challenged during the registration process and/or after the registration. By way of example, the challenge to the trademark may be mounted after the publication of the Trademark in the IP Journal for opposition. An aggrieved person may apply to Court at any time to revoke a registered trademark on the basis of non-use pursuant to **section 46 of the Trademarks Act 2019 (“TMA 2019”)**. Similarly, an aggrieved person may also apply to Court to invalidate a registered trademark under **section 47 of the TMA**. However, after the expiration of five years from the date of registration, the registered trademark may only be challenged if it is shown that- (a) the original registration was obtained by fraud; (b) the trademark offends sections 23(5)(a), (c), (d) or (e); or (c) the trademark was, at the commencement of the proceedings, devoid of distinctiveness of the goods or services of the registered proprietor. For patent, third party observation process is newly implemented pursuant to **Patents (Amendment) Act 2022 (Act A1649)**. Upon the grant of the patent, any aggrieved person may institute Court proceedings against the owner of the patent for the invalidation of the patent. In respect of industrial design, any aggrieved person or any person may apply to Court for rectification of the Industrial Design Register or revocation of the registration of the industrial design. For geographical indication, any interested person may, within the prescribed period, file a notice of opposition with the Registrar to oppose to the registration of geographical indication. In addition, the Court may, on the application of any person in the prescribed manner, cancel the registration of a geographical indication. There are various types of challenges to intellectual property rights and the challenges may be mounted at different periods in time. The most common challenge to an existing intellectual property right is when an action for infringement is brought against a defendant.

Patents & Utility Innovation: Invalidation proceedings: In an infringement action, the defendant can challenge, in the same action, the validity of the patent/ the certificate for utility innovation. The validity of a patent/the certificate for utility innovation may also

be put in issue in proceedings for a declaration of non-infringement.

Trademarks: In an action for infringement of a trademark, it is common for the defendant to counterclaim with an application for cancellation, which can be an action on its own or as a counterclaim. In the recent case of **Diesel S.P.A. v. Bontton Sdn Bhd [2021] 2 CLJ 65**, the Court of Appeal held that a trademark owner may move the Court to make a declaration of non-infringement. Section 53 of the Trademarks Act 2019 ("TMA 2019") provides that the original registration of the trademark shall, after the expiration of five years from the date of registration be taken to be valid in all respects unless it is shown that- (a) the original registration was obtained by fraud; (b) the trademark offends sections 23(5)(a), (c), (d) or (e) of the TMA 2019; or (c) the trademark was, at the commencement of the proceedings, devoid of distinctiveness of the goods or services of the registered proprietor.

Copyright: The defendant can argue on the subsistence of copyright.

Industrial Designs: Application to rectify the Register by including, making, expunging or varying any entry in the Register or correcting any error or defect in the Register as it deems fit must be made by an aggrieved person or interested party.

29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

There may also be procedures available for challenge to be made at the Intellectual Property Corporation of Malaysia ("IPCM"). For example, for trademark, the challenge may be made at IPCM for registration of a trademark during the opposition proceedings. Section 45 of the Trademarks Act 2019 enable the Registrar to revoke the registration of trademark due to administrative error. In most cases, the forum for challenging these intellectual property rights is in Court. The grounds for a finding of invalidity of each of these intellectual property rights are:

Patents:

1. The invention did not meet the patentability requirements, it is not an invention within the meaning of the PA or is a non-patentable invention or is against public order or morality or prohibited by law or fails to

comply with the requirements under the PA;

2. The description or the claim does not comply with the requirements of the Patents Regulations 1986;

3. The drawings which are necessary for the understanding of the claimed invention have not been furnished;

4. The right to the patent does not belong to the person to whom the patent was granted;

5. The information that was provided to the Registrar under s 29(4) was deliberately incomplete or incorrect.

Utility Innovation:

1. The utility innovation is not a utility innovation within the meaning of the PA read together with the Second Schedule of the PA or is not eligible for a certificate for a utility innovation or is against public order or morality or prohibited by law or fails to comply with the requirements under the PA read together with the Second Schedule of the PA;

2. The description or the claim does not comply with the requirements of the respective regulations prescribed;

3. that any drawings which are necessary for the understanding of the claimed innovation have not been furnished;

4. The right to the certificate of utility innovation does not belong to the person to whom the certificate of utility innovation was granted;

5. The information that was provided to the Registrar under s 29(4) was deliberately incomplete or incorrect.

Confidential information: That the information does not possess the degree of confidentiality as required, or if the information is trivial in nature and available in the public domain.

Trademarks:

Revocation by Court

The Court may revoke a registration upon application by an aggrieved person:

1. where the trademark has not been used in good faith within a period of three years following its registration, and there are no proper reasons for non-use;

2. where the use of the goods or services for which the trademark is registered has been suspended for three years, and there are no proper reasons for non-use;

3. where the trademark has become diluted in the market because of acts of inactivity; or
4. where the trademark is liable to mislead the public, including in respect of the nature, quality or geographical origin of the goods or services for which it is registered.

Invalidation by Court

The Court may invalidate a registration upon application by an aggrieved person on the ground that the registered trademark was registered in breach of section 23 (i.e. absolute grounds for refusal).

Copyright: That the work is not original or there is no copyright.

Industrial Designs: An industrial design may be revoked where it was not new at the priority date of the application for registration and where it is contrary to public order or morality. It may be cancelled where the registration has been procured by unlawful means.

30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

Patents: Any interested person can request by instituting proceedings against the owner of the patent that the Court declare that the performance of a specific act does not constitute an infringement of the patent, which when proven, the Court shall grant the declaration of noninfringement. A compulsory licence allows third parties other than the patentee to exploit the patent in a number of situations. There are three types of compulsory licences:

1. Compulsory licences which are granted due to the act or inaction of the patent owner that is against public interest;
2. Compulsory licences which are granted on the basis of inter-dependence of patents and
3. Compulsory use of the patent by the Government.

Trademarks: By way of example, where the ground of invalidity exists in respect of only some of the goods or services for which the trademark is registered, the trademark shall be declared invalid as regards those goods or services only: **section 47(7) of the Trademarks Act 2019 ("TMA 2019")**. Similarly, where grounds for revocation on the basis of non-use

exist in respect of only some of the goods or services for which the trademark is registered, revocation shall relate to those goods or services only: **section 46 (4) of the TMA 2019**.

Industrial designs: Any person may apply to the court for the grant of a compulsory licence in respect of an industrial design on the ground that the industrial design is not applied in Malaysia by any industrial process or means to the article in respect of which it is registered to such an extent as is reasonable in the circumstances of the case. The court may make such order on the application as it considers just.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

Interim relief: Interlocutory Injunction, Interim Mandatory Injunction, Anton Piller Order, Mareva Injunction

Final relief: General damages, special damages, permanent injunctions, account of profits, costs (partial), exemplary damages, statutory damages, declaration, an order for delivery up or obliteration (if applicable)

32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

There are no fixed costs. The costs would depend on the type and manner of enforcement. Costs are generally awarded to the winning party, but this is at the discretion of the Court.

A defendant in any action may apply for security of costs. This would be at the discretion of the Court and would normally be awarded in cases where the Plaintiff is a foreign entity with no assets within the jurisdiction.

33. The Unified Patent Court ("UPC") [came into] [will come into] existence in certain European states on 1 June 2023, as did the introduction of European patents with unitary effect ("unitary patents"). Have industry-specific trends developed in your country in terms of the number of patent

applicants seeking unitary patent protection and/or enforcing European patents or unitary patents before the UPC?

For Malaysian applicants who owns a business in Europe, applying for a European patent has always been the most popular and cost-effective way to get patent protection in Europe. Once a patent is given for a single application filed at the European Patent Office, it can be used in all the European countries that were chosen at the time of filing.

With the European patent with unitary effect (EPUE), which is more commonly known as the Unitary Patent, applicants will have an alternative to the above validation process: a single registration mechanism. Its unitary effect will mean a single renewal fee, a single owner, a single property object, a single court (the Unified Patent Court), and uniform protection. This also means that revocation and infringement proceedings will be decided for the unitary patent as a whole instead of for each country separately. The unitary patent can still be licenced for a part of the unitary region, though.

The European region already has a set of property systems that work well together. This new system will make them even better. Even though the patent laws in the different ASEAN countries have changed a lot since the first regional patent work-sharing scheme, ASPEC, was created, the national patent laws of the countries that are part of ASEAN are still different. For example, Singapore and Brunei have systems that are similar, but

Myanmar is just getting ready to accept its first patent application.

Utility models are easy to file in Malaysia, Indonesia, and Vietnam, but not in all ASEAN countries. In Malaysia, they are called "Utility Innovation Certificates," in Indonesia they are called "Simple Patents," and in Vietnam they are called "Utility Solution Patents." For example, Singapore only has one type of property that is recognised by the law. To get it, an idea must be new, have an inventive step (which isn't needed for utility models), and be useful in industry.

The cost of translations is another problem for Malaysians who want to be protected in the region because different places have different language standards. The applicant usually has to pay most of the translation costs when entering the national phase (for foreign applications) or claiming priority from an earlier national application. On the other hand, the upcoming Unitary Patent will require that the patent be translated into English if the application is in French or German, or into any EU official language if the application is in English, after the European patent is given.

Patent laws in these ASEAN countries can be approved, just like any other law made by people. All of the countries in the region except Myanmar are members of the Patent Co-operation Treaty (PCT). This means that, despite their obvious differences, the patent systems in the ASEAN region may have more in common and that the region may already be on its way to creating a single, unified patent system.

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