

Legal 500

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Malaysia

Intellectual Property

Contributor

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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).

| Types | Scope | Examples | Governing Laws | Registration & Enforceability |
|---------------------------------------|--|---|--|--------------------------------------|
| Patents | Invention that solves technical problems, new and involves an inventive step | Invention with MORE THAN 1 claim | Patents Act 1983 | Must be registered to be enforceable |
| Utility Innovations | Minor Invention that may not involve an inventive step but is new | Invention with ONLY 1 claim | Patents Act 1983 | Must be registered to be enforceable |
| Confidential Information | Information/Data | Sensitive Information/Data, Know-How, Trade Secrets, Personal Information | Common law and contractual agreements | No registration required |
| Trademarks | Marks | Trademarks, signs, insignia, certification marks | Trademarks Act 2019 | Must be registered to be enforceable |
| Passing Off | Business/Reputation | Misrepresentation of business or reputation | Common law | No registration required |
| Unfair Competition/Trade Practice | Business/Reputation | Counterfeit products, false advertising, misleading packaging | Competition Act 2010, Trade Description Act 2011, Consumer Protection Act 1999 | No registration required |
| Copyright | Works | Literary works, artistic works, derivative works such as books, music, films etc. | Copyright Act 1987 | Voluntary registration |
| Industrial Design | Designs | Product shapes, pattern, ornaments etc. | Industrial Design Act 1996 | Must be registered to be enforceable |
| Geographical Indication | Product origin | Referencing of products to specific area | Geographical Indications Act 2022 | Must be registered to be enforceable |
| Layout-Designs of Integrated Circuits | 3-D disposition of elements of an integrated circuit | Semiconductor chip layout | Layout-Design of an Integrated Circuit Act 2000 | No registration required |
| Plant Variety Rights | New variety of plant | New fruit/flower varieties | Protection of New Plant Varieties Act 2004 | Must be registered to be enforceable |

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?

| Types | Duration | Renewal Process | Late Renewal |
|--------------------------|---|--|---|
| Patents | Valid for one year, subject to yearly renewal up to 20 years from filing date | To be renewed yearly May be renewed 12 months preceding the renewal due date Filing of the requisite forms and paying the prescribed fee Takes about 3-6 months for renewal to be recorded | Renewal During Grace Period May be renewed within 6 months grace period after renewal due date, subject to surcharges Filing of requisite forms and paying the prescribed fee and surcharges Takes about 3-6 months for renewal to be recorded Reinstatement post Grace Period May be reinstated within 6 months from the expiry of grace period (which is 12 months from the notice of lapse), subject to surcharges Filing of statutory declaration providing valid reasons to failure to renew Notice of reinstatement will be published Takes about 6-9 months to be reinstated, during which if any 3 rd parties have acquired rights, such 3 rd parties' rights shall not be prejudiced, and no infringement proceedings can be taken |
| Utility Innovations | Valid for 10 years, and may be further extended twice for a period of 5 years each (10+5+5) | To be renewed upon expiry of first 10 years, and 1 st extension of 5 years (if applicable) Annual renewal required to maintain the certificate of utility innovation Filing of the requisite forms and paying the prescribed fee Takes about 3-6 months for renewal to be recorded | Renewal During Grace Period May be renewed within 6 months grace period after renewal due date, subject to surcharges Filing of requisite forms and paying the prescribed fee and surcharges Takes about 3-6 months for renewal to be recorded Reinstatement post Grace Period May be reinstated within 6 months from the expiry of grace period, subject to surcharges Filing of statutory declaration providing valid reasons to failure to renew Notice of reinstatement will be published Takes about 6-9 months to be reinstated, during which if any 3 rd parties have acquired rights, such 3 rd parties' rights shall not be prejudiced, and no infringement proceedings can be taken |
| Confidential Information | Indefinite, subject to contractual terms | - | - |
| Trademarks | Valid for a period of 10 years, subject to renewal every 10 years indefinitely | To be renewed upon expiry of 10 years May be renewed within 6 months before the renewal due date Filing of the requisite forms and paying the prescribed fee Takes about 3-6 months for renewal to be recorded | Renewal During Grace Period May be renewed within 6 months grace period after renewal due date, subject to surcharges Filing of requisite forms and paying the prescribed fee and surcharges Takes about 3-6 months for renewal to be recorded Restoration post Grace Period May be restored within 6 months from the expiry of grace period, subject to surcharges Takes about 6-9 months to be restored |

| | | | |
|---------------------------------------|--|---|--|
| Passing Off | Indefinite, depending on business and reputation | – | – |
| Unfair Competition/Trade Practice | Depending on business and reputation | – | – |
| Copyright | Author's lifetime + 50 years after | – | – |
| Industrial Design | Valid for a period of 5 years, and may be extended for another 5 years up to a maximum of 25 years (5+5+5+5+5) | To be renewed upon expiry of 5 years, and every extension (of a period of 5 years), where applicable May be renewed within 6 months before the renewal due date Filing of the requisite forms and paying the prescribed fee Takes about 3-6 months for renewal to be recorded | Renewal During Grace Period May be renewed within 6 months grace period after renewal due date, subject to surcharges Filing of requisite forms and paying the prescribed fee and surcharges Takes about 3-6 months for renewal to be recorded Restoration post Grace Period May be restored within 6 months from the expiry of grace period, subject to surcharges Filing of statutory declaration providing valid reasons to failure to renew Notice of intention to restore will be published for three months for opposition by any third parties If no opposition filed during the publication period, the notice of restoration will be published Takes about 6-9 months to be restored, during which no infringement proceedings can be taken |
| Geographical Indication | Valid for a period of 10 years, subject to renewal every 10 years indefinitely | To be renewed upon expiry of 10 years May be renewed within 6 months before the renewal due date Filing of the requisite forms and paying the prescribed fee Takes about 3-6 months for renewal to be recorded | Renewal During Grace Period May be renewed within 6 months grace period after renewal due date, subject to surcharges Filing of requisite forms and paying the prescribed fee and surcharges Takes about 3-6 months for renewal to be recorded Restoration post Grace Period May be restored within 6 months from the expiry of grace period, subject to surcharges and additional information as may be required by the examiner Takes about 6-9 months to be restored No infringement proceeding upon removal |
| Layout-Designs of Integrated Circuits | Valid for 10 years from the date of commercial exploitation or 15 years from the date of creation, whichever lapse earlier | – | – |
| Plant Variety Rights | 15 years for new distinct and identifiable plant 20 years for new, distinct, uniform and stable plant 25 years for trees, vines and perennial plants | – | – |

| Types | First Owner | Exceptions |
|---------------------------------------|------------------------|---|
| Patents | Inventor | Employer, if the invention is during the course of employment/ if the inventor is commissioned for such invention |
| Utility Innovations | Inventor | Employer, if the invention is during the course of employment/ if the inventor is commissioned for such invention |
| Trademarks | First Registered Owner | First Common Law proprietor, subject to other external factors such as use, distinctiveness, secondary meaning etc. |
| Passing Off | First User | Subject to other external factors such as use, distinctiveness, secondary meaning etc. |
| Copyright | Author | Employer, if the invention is during the course of employment/ if the inventor is commissioned for such invention |
| Industrial Design | Inventor | Employer, if the invention is during the course of employment/ if the inventor is commissioned for such invention |
| Geographical Indication | Registered Owner | Subject to other external factors such as use, distinctiveness, recognition etc. |
| Layout-Designs of Integrated Circuits | Inventor | Employer, if the invention is during the course of employment/ if the inventor is commissioned for such invention |
| Plant Variety Rights | Breeder | Employer, if the invention is during the course of employment/ if the inventor is commissioned for such invention |

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

Patents, Utility Innovations, Trademarks, Industrial Design, Geographical Indication, Plant Variety Rights are intellectual property rights that exists only upon registration to be enforceable.

That aside, copyright may be registered on a voluntary basis. Registration is not a requirement for copyright to exist.

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

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?

| Types | Who can Apply | Procedure for Registration |
|-------------------------|--|---|
| Patents | Inventor/Employer, depending on arrangement | Upon filing, the patent application undergoes formality examination after which a clear of formalities notice will be issued. The Applicant then has 18 months from the filing date (or 4 years from the international filing date for National Phase Entry Applications) to file for a request for substantive examination/modified substantive examination. The application will then undergo substantive examination. If there are no adverse report/office action issued, the application will be granted and published. Generally, a smooth application takes about 2 years. |
| Utility Innovations | Inventor/Employer, depending on arrangement | Upon filing, the utility innovation application undergoes formality examination after which a clear of formalities notice will be issued. The Applicant then has 18 months from the filing date (or 4 years from the international filing date for National Phase Entry Applications) to file for a request for substantive examination/modified substantive examination. The application will then undergo substantive examination. If there are no adverse report/office action issued, the application will be granted and published. Generally, a smooth application takes about 2 years. |
| Trademarks | Individual, company or any entity owning the trademark | Upon filing, the trademark application undergoes formality and substantive examination. If no office action is issued, the trademark application is accepted for publication. Should there be no opposition filed by any third parties during the 2-months publication period, the trademark application will proceed to registration. Generally, a smooth trademark application takes about 9 months till registration. |
| Copyright | Author/Employer, depending on arrangement | Upon filing, the voluntary copyright notification application will be examined to ensure formality compliance. Should there be no office action issued, a certificate of voluntary copyright notification will be issued. Typically, a smooth application takes about 6 months. |
| Industrial Design | Inventor/Employer, depending on arrangement | Upon filing, the industrial design application undergoes formality and substantive examination. Should no office action be issued, the industrial design will be granted and published. Typically, a smooth application takes about 9 months. |
| Geographical Indication | Usually, government authority/association | Upon filing, the geographical indication application undergoes formality and substantive examination. If no office action is issued, the application is accepted for publication. Should there be no opposition filed by any third parties during the 2-months publication period, the application will proceed to registration. Generally, a smooth trademark application takes about 12 months till registration. |
| Plant Variety Rights | Breeder/Employer, depending on arrangement | Upon filing, the application will be preliminary examined by the plant varieties board in Malaysia. Upon receiving the clear report issued, the request for substantive examination must be filed by the applicant within 30 days. The application will then undergo substantive examination. Should there be no office action issued, the application will be accepted and published for 3 months. If no opposition is filed, the applicant is required to deposit the sample to the designated approved centre and a certificate of grant will be issued. Generally, a smooth plant variety protection application takes about 2-3 years. |

6. How long does the registration procedure usually take?

| Types | Usual Time Taken (in a smooth application) |
|-------------------------|--|
| Patents | ~ 3 to 4 years |
| Utility Innovations | ~ 2 years |
| Trademarks | ~ 9 months |
| Copyright | ~ 6 months |
| Industrial Design | ~ 9 months |
| Geographical Indication | ~ 12 months |
| Plant Variety Rights | ~ 2 to 3 years |

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

| Types | 3 rd Party's right to take part/comment during registration process |
|-------------------------|---|
| Patents | Yes, via opposition within 6 months after the patent grant is being published |
| Utility Innovations | Yes, via opposition within 6 months after the utility innovation grant is being published |
| Trademarks | Yes, during the 2-months publication period |
| Copyright | No |
| Industrial Design | No |
| Geographical Indication | Yes, during the 2-months publication period |
| Plant Variety Rights | Yes, during the 3-months publication period |

Notwithstanding the above, any third parties (adverse parties) may still file an application in court to invalidate and/or revoke the registration of the above intellectual property registrations.

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

Where an application is refused, the applicant may file an appeal to the High Court against the registrar's decision.

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

| Types | Official Fee for Filing of One New Application | Official Fee for Renewal within the Renewal Due date |
|-------------------------|---|---|
| Patents | MYR490 (for less than 10 claims), subject to handling fees where applicable | MYR290 for 2 nd year after grant MYR360 for 3 rd year after grant MYR440 for 4 th year after grant MYR530 for 5 th year after grant MYR630 for 6 th year after grant MYR730 for 7 th year after grant MYR830 for 8 th year after grant MYR910 for 9 th year after grant MYR990 for 10 th year after grant MYR1,020 for 11 th year after grant MYR1,140 for 12 th year after grant MYR1,280 for 13 th year after grant MYR1,450 for 14 th year after grant MYR1,550 for 15 th year after grant MYR1,900 for 16 th year after grant MYR2,100 for 17 th year after grant MYR2,400 for 18 th year after grant MYR2,700 for 19 th year after grant MYR2,900 for 20 th year after grant |
| Utility Innovations | MYR340, subject to handling fee where applicable | Extension Fee: MYR150 Annual Certificate Renewal Fee: MYR170 for 3 rd year after grant MYR240 for 4 th year after grant MYR290 for 5 th year after grant MYR350 for 6 th year after grant MYR350 for 7 th year after grant MYR420 for 8 th year after grant MYR420 for 9 th year after grant MYR480 for 10 th year after grant MYR670 for 11 th year after grant MYR940 for 12 th year after grant MYR1,090 for 13 th year after grant MYR1,270 for 14 th year after grant MYR1,550 for 15 th year after grant MYR1,650 for 16 th year after grant MYR1,820 for 17 th year after grant MYR1,930 for 18 th year after grant MYR2,090 for 19 th year after grant MYR2,200 for 20 th year after grant |
| Trademarks | MYR1,120 | MYR1,000 |
| Copyright | MYR280 | N/A |
| Industrial Design | MYR800 | MYR800 |
| Geographical Indication | MYR730 | MYR420 |
| Plant Variety Rights | MYR600 to MYR2,600 depending on the type of examination selected | N/A |

The official fees above are exclusive of any handling fee that may be imposed by the IP office and any other add-on charges that may be applicable if any add-on services

are selected.

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?

Generally, as provided in our answer to Question 2, in most cases, a 6-months grace period post renewal due date will be given whereby a renewal could still be filed subject to paying the applicable surcharge.

In the event where the renewal is not filed within a grace period, the registration may still be reinstated within 6 months from the lapse of the grace period subject to the filing of the requisite documents and payment of the prescribed fee.

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

Generally, as provided in our answer to Question 2, in most cases, a 6-months grace period post renewal due date will be given whereby a renewal could still be filed subject to paying the applicable surcharge.

In the event where the renewal is not filed within.

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?

Generally, assignment of intellectual property rights must be recorded particularly in Patents, Utility Innovations, Trademarks, Industrial Designs, Geographical Indication, and Plant Variety Rights must be recorded in order for an effective enforcement rights against any third parties.

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

In Malaysia, licensing of intellectual property rights to third parties are usually governed under contractual agreements between parties. As such, the elements of contract (i.e., offer, acceptance, intention to create legal relation, legal capacity, certainty and consideration) need to be fulfilled for contracts to be valid and enforceable.

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?

It is not compulsory for licensing to be recorded with the IP office in Malaysia however it is recommended to do so to ensure that the information reflected in the IP office aligns to give public notice. This would also ease the process of enforcement by the licensee on the licensor's behalf (if any).

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?

Exclusive and non-exclusive licensees are usually given different rights particularly in the context of scope of rights and ability to commence legal action against any infringers.

Usually, an exclusive licensee is given the first right of refusal where the licensor is obliged to give priority to the exclusive licensee is distributing/manufacturing/selling its goods and/or services prior to offering such goods and/or services to any other third party. The exclusive licensee may also be given rights to sub-license the intellectual property rights subject to the terms and conditions laid out in the agreement. On the contrary, non-exclusive licensees are not given any exclusivity hence the licensor is at liberty to appoint any other licensees.

Further, exclusive licensees are usually given the right to sue any infringers however a non-exclusive licensee will have to rely on the licensor to sue any infringers.

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

Some notable criminal sanctions for infringement of the following intellectual property rights in Malaysia are as below.

It is noted that the laws of Malaysia does not provide for criminal sanctions for patent infringements, utility innovations infringement, industrial design infringement, geographical indication infringement, layout-designs of integrated circuits infringement, and new plant variety rights infringement hence only civil remedies are

available.

| Types | Offence | Penalty |
|-----------------------------------|---|--|
| Confidential Information | Non-compliance with applicable code of practice | Fine not exceeding MYR100,000 or imprisonment not exceeding 1 year or both |
| Trademarks | Counterfeiting of registered trademark Falsely applying of registered trademark to goods/services Making or possessing articles that may be mistaken for that of a registered trademark Importing or selling of goods with falsely applied trademark | Fine not exceeding MYR1,000,000 or imprisonment not exceeding 5 years, or both For body corporate: Fine not exceeding MYR15,000 for each goods, and for 2 nd or subsequent offence a fine not exceeding MYR100,000 for services; For Individual: fine not exceeding MYR10,000 for each goods or imprisonment not exceeding 3 years or both, and for 2 nd or subsequent offence, a fine not exceeding MYR20,000 for each goods or imprisonment not exceeding 5 years or both, or a fine not exceeding MYR70,000 or imprisonment not exceeding 3 years or both for services Fine not exceeding MYR1,000,000 or imprisonment not exceeding 5 years or both For body corporate: Fine not exceeding MYR15,000 for each goods and for 2 nd or subsequent offence, a fine not exceeding MYR30,000 each goods; or For Individual: Fine not exceeding MYR10,000 each goods, or imprisonment not exceeding 3 years, or both and for 2 nd or subsequent offence, a fine not exceeding MYR20,000 each goods or imprisonment not exceeding 5 years or both. |
| Unfair Competition/Trade Practice | False trade description by way of counterfeiting trademark | For body corporate: Fine not exceeding MYR15,000 each goods and for second or subsequent offence, fine not exceeding MYR30,000 each goods. For individual: Fine not exceeding MYR10,000 each goods or imprisonment not exceeding 3 years or both, and for second or subsequent offence, fine not exceeding MYR20,000 each goods or imprisonment not exceeding 5 years or both |
| Copyright | For infringing acts under copyright law where a person during the subsistence of copyright in a work or performer's right:- makes for sale or hire any infringing copy; sells, lets for hire or by way of trade, exposes or offers for sale or hire any infringing copy; distributes infringing copies; has in his possession, custody or control, otherwise than for his private and domestic use, any infringing copy; by way of trade, exhibits in public any infringing copy; imports into Malaysia, otherwise than for his private and domestic use, an infringing copy; makes or has in his possession any contrivance used or intended to be used for the purposes of making infringing copies; circumvents or causes or authorizes the circumvention of any effective technological measures; manufactures, imports, sells or lets for hire, offers or exposes for sale or hire, advertises for sale or hire, possesses or distributes any technology or device for the purpose of the circumvention of technological protection measure; removes or alters any electronic rights management information without authority; distributes, imports for distribution or communicates to the public, without authority, works or copies of works in respect of which electronic rights management information has been removed or altered without authority; or provides or shares access to an online location of any works or copies of works to any other person without authority; cam-cording in a screening room attempting to cam-cord in a screening room committing or facilitating infringement of copyright via streaming technology | For (i) to (vi): Fine not less than MYR2,000 and not more than MYR20,000 for each infringing copy, or an imprisonment not exceeding 5 years or both, and for any subsequent offence, a fine not less than MYR4,000 and not more than MYR40,000 for each infringing copy, or an imprisonment not exceeding 10 years or both For (vii) and (ix): Fine not less than MYR4,000 and not more than MYR40,000 for each contrivance, or an imprisonment not exceeding 10 years or both, and for any subsequent offence, fine not less than MYR8,000 and not more than MYR80,000 for each contrivance, or an imprisonment not exceeding 20 years or both For (viii), (x), (xi) and (xii): Fine not less than MYR250,000 or imprisonment not exceeding 5 years or both, and for any subsequent offence, fine not less than MYR500,000 or imprisonment not exceeding 10 years or both For (xiii): Fine not less than MYR10,000 and not more than MYR100,000 or imprisonment not exceeding 5 years or both For (xiv): Fine not less than MYR5,000 and not more than MYR50,000 or imprisonment not exceeding 1 year or both For (xv): Fine not less than MYR10,000 and not more than MYR200,000 or imprisonment not exceeding 20 years or both |

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.

| Types | Enforcement Options |
|---------------------------------------|--|
| Patents | Opposition proceeding at the IP office Invalidation proceeding at the civil court Infringement proceeding at the civil court |
| Utility Innovations | Opposition proceeding at the IP office Invalidation proceeding at the civil court Infringement proceeding at the civil court |
| Confidential Information | Infringement proceeding at the civil court |
| Trademarks | Opposition proceeding at the IP office Revocation proceeding at the civil court (Non-use cancellation proceeding) Invalidation proceeding at the civil court Infringement proceeding at the civil court Lodging a complaint to the Malaysian Ministry of Domestic Trade and Consumer Affairs (KPDNHEP) for infringing/counterfeiting goods whereby the enforcement officer will search and seize the infringing/counterfeiting goods, followed by criminal prosecution if deemed necessary |
| Passing Off | Infringement proceeding by way of passing off action at the civil court |
| Unfair Competition/Trade Practice | Lodging a complaint to the Malaysian Ministry of Domestic Trade and Consumer Affairs (KPDNHEP) for infringing/counterfeiting goods whereby the enforcement officer will search and seize the infringing/counterfeiting goods, followed by criminal prosecution if deemed necessary |
| Copyright | Infringement proceeding at the civil court Lodging a complaint to the Malaysian Ministry of Domestic Trade and Consumer Affairs (KPDNHEP) for infringing/counterfeiting goods whereby the enforcement officer will search and seize the infringing/counterfeiting goods, followed by criminal prosecution if deemed necessary |
| Industrial Design | Revocation proceeding at the civil court Cancellation proceeding at the civil court Infringement proceeding at the civil court Lodging a complaint to the Malaysian Ministry of Domestic Trade and Consumer Affairs (KPDNHEP) for infringing/counterfeiting goods whereby the enforcement officer will search and seize the infringing/counterfeiting goods, followed by criminal prosecution if deemed necessary |
| Geographical Indication | Opposition proceeding at the IP office Cancellation proceeding at the civil court Lodging a complaint to the Malaysian Ministry of Domestic Trade and Consumer Affairs (KPDNHEP) for infringing/counterfeiting goods whereby the enforcement officer will search and seize the infringing/counterfeiting goods, followed by criminal prosecution if deemed necessary |
| Layout-Designs of Integrated Circuits | Infringement proceeding at the civil court Lodging a complaint to the Malaysian Ministry of Domestic Trade and Consumer Affairs (KPDNHEP) for infringing/counterfeiting goods whereby the enforcement officer will search and seize the infringing/counterfeiting goods, followed by criminal prosecution if deemed necessary |
| Plant Variety Rights | Opposition proceeding with the Malaysian Plant Varieties Board Invalidation proceeding at the civil court Lodging a complaint to the Malaysian Ministry of Domestic Trade and Consumer Affairs (KPDNHEP) for infringing/counterfeiting goods whereby the enforcement officer will search and seize the infringing/counterfeiting goods, followed by criminal prosecution if deemed necessary |

Further to the above, the owners may also enforce its IP rights by way of arbitration proceeding, which is governed by the Arbitration Act 2005. However, an arbitration proceeding requires the existence of a written arbitration clause or a separate arbitration agreement as evidence in support of the parties' consent for resolving the dispute by way of arbitration.

In addition, the owners may also opt to resolve IP disputes by way of mediation, which is governed by the Mediation Act 2012. However, mediation is not applicable to proceedings involving the remedy of temporary or permanent injunctions, hence the resolution of IP disputes through mediation will not impose a mandatory injunction against the infringer.

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

Generally, a proceeding at the IP office and/or board takes about 12 months however delays are not unusual due to the high number of backlog cases being handled by the IP office and board.

Meanwhile, a proceeding at the civil court takes about 6~12 months depending on the complexity of the matter and the civil court's availability. In the event where the matter requires urgency, a certificate of urgency may be filed subject to the court's discretion.

The cost (official fees) for an opposition proceeding is dependent upon the types of intellectual property. The official fee to file an opposition usually ranges between MYR300 to MYR950. This fee is exclusive of any attorney fees, applicable tax and disbursements.

The cost (official fees) for court proceeding is dependent on the complexity of the matter. For example, the official fees for a simple infringement proceeding in court may be in the region of MYR1,500.

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.

For invalidation, revocation, and cancellation proceedings, the Malaysian High Courts generally have jurisdiction. Invalidation proceedings commence by way of filing of the originating summons supported by an affidavit setting out the grounds for invalidation, revocation and cancellation. Thereafter, the respondent is required to reply to the affidavit within 14 days from the date of receipt of the applicant's affidavit. The applicant is then given 14 days from the date of receipt of the respondent's affidavit to file a further reply. A hearing would be fixed by the court for parties to submit legal arguments before which parties will be directed to file their respective written submissions (for legal arguments) and reply (if any). The court will thereafter fix a decision date to deliver its decision. A typical smooth invalidation, revocation and cancellation proceeding takes about 6~12 months depending on the court's availability. In the event if any party is dissatisfied with the court's decision, the dissatisfied party may file an appeal to the court of appeal.

Similarly, the Malaysian High Courts generally deal with infringement proceedings related to intellectual property rights. Infringement proceedings usually begin by way of a filing of writ summons and statement of claim. The defendant (infringer) is then given 14 days from the date of receipt of the writ and statement of claim to file a memorandum of appearance, and subsequently another 14 days to file his defence (and counterclaim, if any). The plaintiff (party suing) is then given 14 days from the date of receipt of the defence to file a reply. Thereafter, the pleadings will be deemed closed. The Court will then fix a date for pre-trial case management, whereby directions will be issued to parties on the pre-trial documents and witness statement to be exchanged prior to the trial date, as well as the full trial dates for the examination of witnesses. After the examination of all the witnesses, the Court will fix the dates for parties to exchange the written submissions and written reply submissions. Subsequent to the exchange of submissions, the Court will fix a decision date, whereby parties may be allowed to submit further by way of oral submission (which is subjected to the Judge's discretion), and a decision will generally be delivered on the decision date itself. In the event that either party is dissatisfied with the decision given, party may file an appeal to the Court of Appeal.

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

Pursuant to Section 31 of the Customs Act 1967 and Part XIII of the Trademarks Act 2019, there are existing border measures in Malaysia which serve to prohibit the importation of infringing goods into Malaysia.

First, the registered proprietor is required to file an application to the Trademark Registrar of MYIPO which shall provide the time and place whereby the infringing goods are expected to be imported into Malaysia for the purpose of trade. The application is to be supported by all necessary documents and information which include but not limited to the details of the importer, the shipment number, the infringing goods, the registration number of the vehicle/ship, and the anticipated date of arrival, that would enable the officers from the Royal Malaysian Customs Department ("Customs") to identify the infringing goods.

Once approved, the Trademark Registrar will notify the Customs to take the necessary actions in prohibiting the import of infringing goods stipulated in the application, whereby the Customs may conduct necessary raids, seizures, and detention of the infringing goods. At the same time, the registered proprietor is also required to

provide a deposit as security for the border measure.

Upon the seizure of the infringing goods by the Customs, the Customs will then notify the Trademark Registrar, the importer, as well as the registered proprietor, providing details of the infringing goods and their locations. The notice by Customs will specify that the infringing goods will be released to the importer unless an infringing proceeding at the civil court is commenced within a specific period from the date of the notice.

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.

Presently, the non-court enforcement options or dispute resolution mechanisms available in Malaysia are opposition proceedings to be filed at MYIPO (subject to types of intellectual property), the lodging of complaints with KDNPHEP Enforcement Division (limited to infringing and counterfeit goods only where no civil remedies are furnished), arbitration proceeding (subject to parties' consent) and mediation (subject to parties' consent). It is however important to note that these non-court enforcement options have limited jurisdictions to grant remedies.

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

Settlement of IP disputes can be conducted in the following manner:-

- i. By way of court proceeding;
- ii. Conducted privately between the parties through negotiation and settlement agreement;
- iii. Conducted through mediation; or
- iv. Conducted through arbitration.

However, the remedies sought for should determine the options available for selection.

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

| Types | Requirements to establish infringement | Evidence that is necessary |
|-------------------|---|---|
| Patents | The feature/integer of the patented claim is used without authorisation The infringing product works the same way as the plaintiff's patented claims | Certificate of grant of the patented claim Comparative analysis of the similarity of the infringing product and patented claim Infringer's unauthorised use |
| Trademarks | The infringing mark is likely to cause confusion amongst consumers There was no authorised use | Certificate of registration of registered trademark Infringer's unauthorised use |
| Copyright | The infringing work is substantially similar There was no authorised use | Infringer's unauthorised use Evidence portraying the author's/owner's publication of work Evidence portraying the author's/owner's authorship of work |
| Industrial Design | The infringing design is substantially similar There was no authorised use | Certificate of grant of registered industrial design Infringer's unauthorised use |

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?

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?

In Malaysia, the judges presiding at the high court are not required to have an engineering background. In the event that an expert opinion is required, the Court may on its own initiative, or upon the application by the parties to the proceeding, allow for expert witnesses to be called to provide their expert opinions on the subject matter of the suit. The decision however remains with the judge to decide whether to be stand guided by the expert's opinion.

b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

In Malaysia, a party may file the following interlocutory application to obtain the evidence prior to the trial:-

- i. Anton Piller Order
- ii. Norwich Pharmacal Orders
- iii. Discovery Application
- iv. Interrogatories Application
- v. Inspection of Document Application

These applications may be filed on a case-by-case basis.

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?

Generally, in an infringement proceeding, information and evidence submitted to the Court are scrutinised through witness examination by the opponent. An evidence-in-chief of a witness shall be given by way of witness statement, and the attendance of a witness to trial shall be mandatory. During the trial, the witness shall be subject to cross-examination by the opponent and re-examination (if any). In the event of default of attendance, the impugned witness statement will not be received in evidence by the Court. It is also a usual practice for documents to be tendered as evidence by a witness in court. As such, examination of witness is a practice frequently employed in Malaysia.

Meanwhile, in an invalidation, non-use cancellation, and revocation proceeding, information and evidence are submitted via affidavit. As such, no examination of witnesses is usually conducted in such cases.

26. What defences to infringement are available?

The common defences (amongst others) raised by an alleged infringer in the following intellectual property areas are as below.

In relation to patent:

- i. it is not new and is anticipated by a prior art
- ii. it does not involve an inventive step and is obvious to a person having ordinary skill in the art
- iii. it is not industrially applicable and cannot be made or used in any kind of industry
- iv. it is not an invention
- v. it is a discovery, scientific theory and mathematical method

In relation to trademark:

- i. Not visually, phonetically and/or conceptually similar
- ii. No identity and/or similarity to the goods/services
- iii. No likelihood of confusion amongst consumers
- iv. Used in good faith of the infringer's own name / name of place of business or the predecessor's name / name of the predecessor's place of business
- v. Prior use before the date of registration of the registered trademark
- vi. Used for non-commercial/description purpose

In relation to copyright:

- i. the acts were done by way of fair dealing for purposes of research, private study, criticism, review, reporting of news or current events accompanied by acknowledgements
- ii. the acts were done by parody, pastiche or caricature
- iii. the reproduction made in schools, universities or educational institutions of a work included in a broadcast intended for such schools, universities or educational institutions
- iv. the performance, showing or playing of a work by a non-profit making club or institution where such performance, showing or playing is for charitable or educational purpose and is in a place where no admission fee is charged

In relation to industrial designs:

- i. the registration of the industrial design ought to be revoked/cancelled
- ii. it is not imported for use of trade or business

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

Generally, anyone who is an aggrieved party has a cause of action to challenge the intellectual property rights or file an action.

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)?

(A) Patents

- i. Opposition proceeding at MYIPO – 6 months after the date of publication of the grant of the patent.
- ii. Invalidation proceeding at the civil court – Invalidation action to be filed after the grant of patent and during the subsistence of the patent.
- iii. Infringement proceeding at the civil court – Infringement action to be filed after the grant of patent and during the subsistence of the patent, but not after 6 years from the act of infringement.

(B) Trademarks

- i. Opposition proceeding at MYIPO – Opposition to be filed within 2 months from the date of publication of the trademark in the IP Journal
- ii. Revocation proceeding at the civil court – Generally, revocation for non-use of trademark is filed after 3 years from the date of registration of the trademark

- iii. Invalidation proceeding at the civil court – Invalidation action to be filed after the registration of trademark and during the subsistence of the trademark.
- iv. Infringement proceeding at the civil court – Infringement action to be filed after the registration of trademark and during the subsistence of the trademark, but not after the expiry or removal of the trademark.

(C) Copyrights

- i. Infringement proceeding at the civil court – Infringement action to be filed during the subsistence of the copyright.

(D) Industrial Designs

- i. Revocation proceeding at the civil court – Revocation action to be filed after the registration of industrial design and during the subsistence of the industrial design.
- ii. Cancellation proceeding at the civil court – Invalidation action to be filed after the registration of industrial design and during the subsistence of industrial design.
- iii. Infringement proceeding at the civil court – Infringement action to be filed after the registration of industrial design and during the subsistence of the industrial design, but not after 5 years from the act of infringement.

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?

For patent and trademarks, the owner may commence opposition proceeding at MYIPO by way of filing of Notice of Opposition and Grounds of Opposition by the opponent against the applicant of the impugned patent, and an Affidavit of Service shall be filed within 14 days to prove service. After that, the applicant is required to file a Counterstatement within 2 months. Subsequently, the opponent is required to file the evidence by way of Statutory Declaration in support of the Grounds of Opposition within 2 months. Then, the applicant is required to file the evidence by way of Statutory Declaration in support of the application for grant of patent within 2 months. The opponent then may file such evidence in reply by way of Statutory Declaration within 2 months. Next, the opponent and applicant will file their respective written submissions within 2 months from the date of notice by MYIPO. After the filing of written

submissions, the Trademark Registrar shall consider the evidence, exhibit and written submissions filed and may within 2 months communicate to parties his decision and the grounds of decision in writing.

Some examples of grounds for opposition that may be raised are that the applicant's mark is identical and/or closely similar to the opponent's marks or that the applicant's mark was applied in bad faith.

On the other hand, for patents, trademarks and industrial designs, which provides for invalidation, revocation and/or cancellation proceedings, these proceedings are commenced at the Malaysian High Court through the filing of Originating Summons and Affidavit in Support by the applicant. Upon receipt of the Affidavit in Support, the respondent is required to file an Affidavit in Reply within 14 days. Then, upon receipt of the Affidavit in Reply, the applicant is required to file an Affidavit in Further Reply within 14 days. After that, the applicant and the respondent are required to file written submissions and written reply submissions, which are generally completed within 1 to 2 months. After the exchange of submissions, a hearing date will be fixed by the Court, whereby parties may be allowed to submit further by way of oral submission (which is subjected to the Judge's discretion), and a decision will generally be delivered on the hearing date itself. The relevant grounds for invalidation, revocation and/or cancellation proceedings are as mentioned above.

Infringement proceeding is commenced at the Malaysian High Court through the filing of a Writ and Statement of Claim by the plaintiff. Upon service of the Statement of Claim, the defendant is required to enter into appearance through the filing of a Memorandum of Appearance within 14 days. Thereafter, the defendant is required to file the Statement of Defence (as well as Counterclaim, if desired) within 14 days after the time limited for appearing or after the Statement of Claim is served on him, whichever is the later. Upon service of the Statement of Defence, the plaintiff is required to file a Reply to Defence (as well as Defence to Counterclaim, if necessary) within 14 days. If the defendant has pleaded for Counterclaim, the defendant may opt to file a Reply to Defence to Counterclaim within 14 days from date of service of the Defence to Counterclaim. Thereafter, the pleadings will be deemed closed. The Court will then fix a date for pre-trial case management, whereby directions will be issued to parties on the pre-trial documents and witness statement to be exchanged prior to the trial date, as well as the full trial dates for the examination of witnesses. Generally, evidence-in-chief of a witness shall be submitted by way of a written witness statements, whereby cross-examination and re-examination will subsequently be

conducted orally during the trial. After the examination of witnesses, the Court will fix the dates for parties to exchange the written submissions and written reply submissions. Subsequent to the exchange of submissions, the Court will fix a decision date, whereby parties may be allowed to submit further by way of oral submission (which is subjected to the Judge's discretion), and a decision will generally be delivered on the decision date itself. The relevant grounds for infringement proceeding are as mentioned above.

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?

In Malaysia, a person may seek to obtain a declaration of non-infringement of existing patents, trademarks, copyrights or industrial designs, either through private negotiation with the owner of the IP rights, or through commencement of legal proceeding at the Malaysian High Court. Further, a person may also seek to obtain consent, approval and/or licence from the owner of the existing IP, whether express or implied, through payment of licensing fees.

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

In an infringement proceeding, should there be a real risk of dissipation of assets, the plaintiff may file an interlocutory application to obtain an interim remedy, namely, a Mareva injunction, which serves to freeze the assets of the defendant pending the disposal of the action.

If the owner successfully proved that infringement has been committed before the civil court, the owner may be entitled to the following final remedies, subject to the Court's discretion:-

- i. Declaration of infringement;
- ii. Injunction to prohibit further infringement;
- iii. Injunction to deliver the infringing materials;
- iv. Injunction to destroy the infringing materials;
- v. Monetary compensation in a lump sum or based on an account for profit;
- vi. Aggravated damages;
- vii. Exemplary damages; and
- viii. Punitive damages.

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?

The cost for enforcement of IP rights is on a case-by-case basis depending on the complexity of the matter.

Generally, the successful litigant in the court proceeding will be awarded with costs however, the costs awarded are often minimal that covers only the official fees and disbursements to a certain extent.

In relation to security for costs, the defendant to an action may apply for the same from the plaintiff, under the following circumstances:-

- i. that the plaintiff is ordinarily resident out of the jurisdiction;
- ii. that the plaintiff (not being a plaintiff who is suing in a representative capacity) is a nominal plaintiff who is suing for the benefit of some other person and that there is reason to believe that he will be unable to pay the costs of the defendant if ordered to do so;
- iii. that the plaintiff's address is not stated in the writ or originating summons or is incorrectly stated therein; or
- iv. that the plaintiff has changed his address during the course of the proceedings with a view to evading the consequences of the litigation.

As such, since the owner who is commencing the enforcement proceedings against the infringer is the plaintiff of the action, the owner is not entitled to apply for security of costs from the infringer.

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