

**Council for Trade-Related Aspects
of Intellectual Property Rights**

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**MAIN DEDICATED INTELLECTUAL PROPERTY LAWS AND REGULATIONS
NOTIFIED UNDER ARTICLE 63.2 OF THE AGREEMENT**

MALAYSIA

The present document reproduces the text¹ of the following laws and regulations, as notified by Malaysia under Article 63.2 of the Agreement (see document IP/N/1/MYS/1):

	<u>Page</u>
- <u>Patents Act 1983 (Act 291) and Regulations</u>	2
- <u>Patents (Amendment) Act 2000 (Act A1088)</u>	120
- <u>Patents Regulations (Amendment) 2001</u>	127

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES À LA PROPRIÉTÉ
INTELLECTUELLE NOTIFIÉES AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD**

MALAISIE

Le présent document contient le texte¹ des lois et réglementations ci-après, notifiées par la Malaisie au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/MYS/1):

	<u>Page</u>
- <u>Loi de 1983 sur les brevets (Loi n° 291) et réglementation</u>	2
- <u>Loi de 2000 sur les brevets (modification) (Loi n° A1088)</u>	120
- <u>Réglementation de 2001 sur les brevets (modification)</u>	127

**Consejo de los Aspectos de los Derechos de Propiedad
Intellectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA PROPIEDAD INTELECTUAL
NOTIFICADOS EN VIRTUD DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO**

MALASIA

En el presente documento se reproduce el texto¹ de las leyes y reglamentos notificados por Malasia en virtud de lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo (véase el documento IP/N/1/MYS/1):

	<u>Página</u>
- <u>Ley de Patentes de 1983 (Ley 291) y Reglamentos</u>	2
- <u>Ley de Patentes (Modificación) de 2000 (Ley A1088)</u>	120
- <u>Reglamento sobre Patentes (Modificación) de 2001</u>	127

¹ Distributed in English only. The texts of these laws in the original language are available for consultation by interested Delegations at the WTO Secretariat./En anglais seulement. Les délégations intéressées peuvent consulter les textes de ces lois, dans leur langue d'origine, au Secrétariat de l'OMC./Distribuido en inglés solamente. Las delegaciones interesadas podrán consultar en la Secretaría de la OMC los textos de estas leyes en su idioma original.

PATENTS ACT 1983
(ACT 291) &
REGULATIONS

(AS AT 15TH JULY 2000)

PATENTS ACT, 1983

(ACT 291)

ARRANGEMENT OF SECTIONS

PART I PRELIMINARY

1. Short title, commencement and application.
2. Extent of application.
3. Interpretation.

PART II PATENTS BOARD

4. Establishment and composition of Patents Board.
5. Appointment of alternate member of Board.
6. Remuneration of members.
7. Schedule to apply to Board and members.
- 7A. Protection in respect of acts done in pursuance of this Act.

PART III ADMINISTRATION

8. Registrar, Deputy Registrar and Assistant Registrar.
9. Patent Registration Office.
10. Patent information service.

PART IV PATENTABILITY

11. Patentable inventions.
12. Meaning of “invention”.
13. Non-patentable inventions.
14. Novelty.
15. Inventive step.
16. Industrial application.

PART IVA UTILITY INNOVATIONS

- 17. Definition.
- 17A. Application.
- 17B. Conversion from an application for a patent into an application for a certificate for a utility innovation, and *vice versa*.
- 17C. Patent and certificate for a utility innovation cannot both be granted for the same invention.

PART V RIGHTS TO A PATENT

- 18. Right to a patent.
- 19. Judicial assignment of patent application or patent.
- 20. Inventions made by an employee or pursuant to a commission.
- 21. Inventions by Government employee.
- 22. Joint owners.

PART VI APPLICATION, PROCEDURE FOR GRANT AND DURATION

- 23. Requirements of application.
- 23A. Applications by residents to be filed in Malaysia first.
- 24. Application fee.
- 25. Withdrawal of application.
- 26. Unity of invention.
- 26A. Amendment of application.
- 26B. Division of application.
- 27. Right of priority.
- 27A. Priority date.
- 28. Filing date.
- 29. Preliminary examination.
- 29A. Request for substantive examination or modified substantive examination.
- 30. Substantive examination and modified substantive examination.
- 30A. Prohibition of publication of information which might be prejudicial to the nation.
- 31. Grant of patent.
- 32. Register of Patents.
- 32A. Notice of a trust not to be registered.

- 33. Examination of Register and certified copies.
- 33A. Certified copies of or extracts from Register, etc. admissible as evidence in court.
- 33B. Amendments to the Register.
- 33C. Court may order rectification of the Register.
- 34. Inspection of files.
- 35. Duration of patent.
- 35A. Reinstatement of a lapsed patent.

PART VII

RIGHTS OF OWNER OF PATENT

- 36. Rights of owner of patent.
- 37. Limitation of rights.
- 38. Rights derived from prior manufacture or use.

PART VIII

ASSIGNMENT AND TRANSMISSION OF PATENT APPLICATIONS AND PATENTS

- 39. Assignment and transmission of patent applications and patents.
- 40. Joint ownership of patent applications or patents.

PART IX

LICENCE CONTRACTS

- 41. Meaning of licence contract.
- 42. Entry in the Register.
- 43. Rights of the licensee.
- 44. Rights of the licensor.
- 45. Invalid clauses in licence contracts.
- 46. Effect of patent application not being granted or patent being declared invalid.
- 47. Expiry, termination or invalidation of licence contract.

PART X

COMPULSORY LICENCES

- 48. Definition.
- 49. Application for compulsory licences.
- 49A. Application for compulsory licence based on inter-dependence of patents
- 50. Request for grant of compulsory licence.
- 51. Decision by the Board.

- 52. Scope of compulsory licence.
- 53. Limitation of compulsory licence.
- 54. Amendment, cancellation and surrender of compulsory licence.

PART XI

SURRENDER AND INVALIDATION OF PATENT

- 55. Surrender of patent.
- 56. Invalidation of patent.
- 57. Date and effect of invalidation.

PART XII

INFRINGEMENT

- 58. Acts deemed to be infringement.
- 59. Infringement proceedings.
- 60. Injunction and award of damages.
- 61. Infringement proceedings by licensee and beneficiary of compulsory licence.
- 62. Declaration of non-infringement.
- 62A. Applications in contravention of Section 23A.
- 62B. Publication of information in contravention of Registrar's directions.

PART XIII

OFFENCES

- 63. Falsification of Register, etc.
- 64. Unauthorised claim or patent.
- 65. Unauthorised claim that patent has been applied for.
- 66. Misuse of title "Patent Registration Office".
- 66A. Unregistered persons practising, etc., as a patent agent.
- 67. Offences by corporation.

PART XIV

POWERS RELATING TO ENFORCEMENT

- 68. Authorization of officer to exercise powers under this Part.
- 69. Powers of arrest.
- 70. Search with warrant.
- 71. List of things seized.
- 72. Return of things seized.
- 73. Power of investigation.
- 74. Examination of witnesses.

- 75. Admission of statements in evidence.
- 76. Obstruction to search, etc.
- 77. Conduct of prosecution.
- 78. Jurisdiction of subordinate Court.

PART XV

MISCELLANEOUS

- 79. Power of Registrar to amend patent application.
- 79A. Power of Registrar to amend patent.
- 80. Other powers of Registrar.
- 81. Exercise of discretionary power.
- 82. Extension of time.
- 83. Extension of time by reason of error in Patent Registration Office.
- 83A. Certificate by the Registrar.
- 84. Rights of Government.
- 85. Refusal to grant patent by the Registrar.
- 86. Patent agents.
- 87. Regulations.
- 88. Appeal.
- 89. Repeal and saving provisions.
- 90. Transitional.

FIRST SCHEDULE.

SECOND SCHEDULE.

PATENTS ACT, 1983*

(Act 291)

An Act to make better provisions in the law relating to patents and for other matters connected therewith.

[1.10.1986]

BE IT ENACTED by the Duli Yang Maha Mulia Seri Paduka Baginda Yang di-Pertuan Agong with the advice and consent of the Dewan Negara and Dewan Rakyat in Parliament assembled, and by the authority of the same, as follows:

PART I PRELIMINARY

1. Short title, commencement and application.

(1) This Act may be cited as the **Patents Act, 1983** and shall come into force on such date as the Minister may, by notification in the *Gazette*, appoint.

(2) This Act shall apply throughout Malaysia.

2. Extent of application.

This Act shall apply to patent applications made after the commencement of this Act and to the registration of patents made on such applications.

3. Interpretation.

In this Act, unless the context otherwise requires—

“authorized officer” means an officer authorized under section 68;

“Board” means the Patents Board established under this Act;

“Court” means the High Court, or Judge thereof;

“employee” means a person who works or has worked under a contract of employment, or who is in employment under, or for the purposes of, any individual or organization;

*As amended by Act A648, A863.

“employer”, in relation to an employee, means the person by whom the employee is or was employed;

“Examiner” means any person, government department, unit, organization, or any foreign or international patent office or organization, appointed by the Board to whom the Registrar may refer questions concerning patents;

“filing date” means the date recorded by the Registrar as the filing date under section 28;

“owner of the patent” or “owner of a patent” means the person for the time being recorded in the Register as the grantee of a patent;

“patented invention” means an invention for which a patent is granted and “patented process” shall be construed accordingly;

“patented product” means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied;

“prescribed” means prescribed by regulations made under this Act;

“priority date” means the date prescribed in section 27A;

“process” includes an art or a method;

“product” means any thing which appears in tangible form, and includes any apparatus, article, device, equipment, handicraft, implement, machine, substance and composition;

“Register” means the Register of Patents and the Register for Certificates for Utility Innovations kept under this Act;

“Registrar” means the Registrar of Patents;

“right”, in relation to any patent application or patent, includes an interest in the patent application or patent and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent.

PART II
PATENTS BOARD

4. Establishment and composition of Patents Board.

(1) There shall be established a Patents Board which shall be a body corporate with perpetual succession and a common seal and which may sue and be sued and whose functions shall be—

- (a) to issue certificates for utility innovations;
- (b) to consider applications for compulsory licences under subsection (2) of section 51;
- (c) to appoint Examiners; and
- (d) to advise the Minister generally on matters pertaining to this Act.

(1A) The Board may delegate any of its functions under paragraphs (a) and (b) of subsection (1) to any person it deems fit.

(2) The Board shall consist of the following members:

*[Subs. Act
A863]*

- (a) the Secretary-General of the Ministry charged with the responsibility for industrial property, who shall be the Chairman;
- (b) a Deputy Chairman, who shall be appointed by the Minister from amongst persons who, in the opinion of the Minister, by reason of their knowledge and experience would be of substantial service to the development of industrial property;
- (c) a representative of the Ministry charged with the responsibility for industrial property, to be appointed by the Secretary-General of that Ministry;
- (d) a representative of the Ministry charged with the responsibility for industry, to be appointed by the Secretary-General of that Ministry;
- (e) a representative of the Ministry charged with the responsibility for science and technology, to be appointed by the Secretary-General of that Ministry;
- (f) a representative of the National Scientific Council for Research and Development, to be appointed by that Council;
- (g) a representative of the representing research institutes, to be appointed by the Minister;
- (h) a representative of the institutions of higher learning, to be appointed by the Minister; and
- (i) not more than three other persons whom the Minister considers fit and proper persons to be members of the Board, to be appointed by the Minister.

(3) Any member of the Board appointed under paragraph (b), (g), (h) or (i) of subsection (2) shall, unless his appointment is sooner revoked or he sooner resigns, hold office for such period not exceeding two years as the Minister may determine and shall be eligible for reappointment.

5. Appointment of alternate member of Board.

[Am. Act
A863]

(1) The Minister may in respect of each member of the Board appointed under paragraph (g), (h) or (i) of subsection (2) of section 4 appoint another person representing the same interest as that member to be that member's alternate and such alternate member may attend the meetings of the Board in place of that member if that member is for any reason unable to attend.

[Ins. Act
A863]

(1A) Another person from the same Ministry or body as a member appointed under paragraph (c), (d), (e), or (f) of subsection (2) of section 4 may be appointed by the respective appointing authorities mentioned in those paragraphs to be that member's alternate and such alternate member may attend the meetings of the Board in place of that member if that member is for any reason unable to attend.

(2) When attending a meeting of the Board in the absence of the member in respect of whom he is appointed to be an alternate, an alternate member shall for all purposes be deemed to be a member of the Board.

(3) An alternate member shall, unless his appointment is sooner revoked or he sooner resigns, cease to be an alternate member when the member in respect of whom he is an alternate is deemed to have vacated his office or otherwise ceases to be a member of the Board pursuant to the provisions of this Act but this shall be without prejudice to such alternate member being appointed as a member or reappointed as an alternate member.

6. Remuneration of members.

The members and alternate members of the Board may be paid such remuneration as the Minister may determine.

7. Schedule to apply to Board and members.

The provisions of the First Schedule shall apply in respect of the Board, its members and alternate members.

7A. Protection in respect of acts done in pursuance of this Act.

A member of the Board or an Examiner shall not be personally liable for or in respect of any act, matter or thing done or omitted to be done in good faith and in the proper exercise of any of his duties or functions as a member of the Board or an Examiner under this Act.

PART III
ADMINISTRATION

8. Registrar, Deputy Registrar and Assistant Registrar.

(1) The Minister may appoint a Registrar of Patents who shall be conferred with powers and functions for the proper administration of this Act.

(2) The Minister may give the Registrar any direction not inconsistent with the provisions of this Act as to the exercise and performance of the powers and functions in relation to any matter which appears to him to concern the development of industrial property and other matters connected therewith and the Registrar shall give effect to any such direction.

(3) The Minister may appoint such number of Deputy Registrars of Patents as may be necessary for carrying out the provisions of this Act and the Deputy Registrars shall, subject to the control of the Registrar, have all the powers and functions of the Registrar under this Act except the power of delegation referred to in subsection (5).

(4) The Minister may appoint such number of Assistant Registrars of Patents as may be necessary for carrying out the provisions of this Act and the powers and functions of an Assistant Registrar shall be as prescribed by the Minister or delegated by the Registrar pursuant to subsection (5).

(5) The Registrar may, in relation to a particular matter or class of matters by writing under his hand, delegate all or any of his powers or functions under this Act, except his power of delegation, to an Assistant Registrar so that the delegated powers and functions may be exercised by the Assistant Registrar so delegated but a delegation made under this subsection is revocable at the discretion of the

Registrar and does not prevent the exercise of that power or function by the Registrar or Deputy Registrar.

(6) The Registrar shall have a seal of such device as may be approved by the Minister and the impressions of such seal shall be judicially noticed and admitted in evidence.

9. Patent Registration Office.

(1) For the purposes of this Act there shall be established a Patent Registration Office which would be the office of the Registrar.

(2) The Patent Registration Office shall be the secretariat to the Board.

(3) The Registrar shall be responsible for the administration of the Patent Registration Office.

(4) The Minister may, by notification in the *Gazette*, establish such number of branch offices of the Patent Registration Office as he may deem necessary for the purposes of this Act.

(5) Any application or other document required or permitted to be filed at the Patent Registration Office may be filed at any branch office of the Patent Registration Office and such application or other document shall be deemed to have been filed at the Patent Registration Office.

10. Patent information service.

[Subs. Act
A863]

There shall be a patent information service which provides information to the public upon payment of the prescribed fee.

PART IV

PATENTABILITY

11. Patentable inventions.

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

12. Meaning of “invention”.

(1) An invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.

(2) An invention may be or may relate to a product or process.

13. Non-patentable inventions.

(1) Notwithstanding the fact that they may be inventions within the meaning of section 12, the following shall not be patentable:

- (a) discoveries, scientific theories and mathematical methods;
- (b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes;
- (c) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (d) methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body:

Provided that this paragraph shall not apply to products used in any such methods.

(2) For the purpose of subsection (1), in the event of uncertainty as to whether the items specified therein shall be patentable or not, the Registrar may refer the matter to the Examiner for an opinion and the Registrar shall thereafter give a decision as to whether to include or exclude such item as being patentable, as the case may be.

14. Novelty.

(1) An invention is new if it is not anticipated by prior art.

*[Am. Act
A863]*

(2) Prior art shall consist of—

(a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention;

(b) the contents of a domestic patent application having an earlier priority date than the patent application referred to in paragraph (a) to the extent that such contents are included in the patent granted on the basis of the said domestic patent application.

(3) A disclosure made under paragraph (a) of subsection (2) shall be disregarded—

(a) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title;

(b) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title;

(c) if such disclosure is by way of a pending application to register the patent in the United Kingdom Patent Office as at the date of coming into force of this Act.

*[Ins. Act
A863]*

(4) The provisions of subsection (2) shall not exclude the patentability of any substance or composition, comprised in the prior art, for use in a method referred to in paragraph (d) of subsection (1) of section 13, if its use in any such method is not comprised in the prior art.

15. Inventive step.

An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under paragraph (a) of subsection (2) of section 14, such inventive step would not have been obvious to a person having ordinary skill in the art.

16. Industrial application.

An invention shall be considered industrially applicable if it can be made or used in any kind of industry.

PART IVA UTILITY INNOVATIONS

17. Definition.

[Subs. Act
A863]

For the purposes of this Part and any regulations made under this Act in relation to this Part, “utility innovation” means any innovation which creates a new product or process, or any new improvement of a known product or process, which can be made or used in any kind of industry, and includes an invention.

17A. Application.

(1) Except as otherwise provided in this Part, the provisions of this Act, subject to the modifications in the Second Schedule, shall apply to utility innovations in the same manner as they apply to inventions.

(2) Sections 11, 15, 16, 26, Part X, and sections 89 and 90 shall not apply to utility innovations.

17B. Conversion from an application for a patent into an application for a certificate for a utility innovation, and *vice versa*. [Ins. Act A863]

(1) An application for a patent may be converted into an application for a certificate for a utility innovation.

(2) An application for a certificate for a utility innovation may be converted into an application for a patent.

(3) A request to convert an application for a patent into an application for a certificate for a utility innovation or to convert an application for a certificate for a utility innovation into an application for a patent shall be filed by the applicant and shall comply with regulations made under this Act.

(4) A request for conversion under this section shall be filed not later than six months from the date the Registrar makes known to the applicant the report made by the Examiner in accordance with subsection (1) or (2) of section 30.

(5) A request for conversion under this section shall not be entertained unless the prescribed fee has been paid to the Registrar.

(6) An application which has been converted shall be deemed to have been filed at the time the initial application was filed.

17c. Patent and certificate for a utility innovation cannot both be granted for the same invention. *[Ins. Act
A863]*

(1) If an applicant for a patent has also—

(a) made an application for a certificate for a utility innovation;
or

(b) been issued with a certificate for a utility innovation,

and the subject-matter of the application for a patent is the same as the subject-matter of the application mentioned in paragraph (a) or of the certificate mentioned in paragraph (b), a patent shall not be granted until the application mentioned in paragraph (a) has been

withdrawn or the certificate mentioned in paragraph (b) has been surrendered.

(2) If an applicant for a certificate for a utility innovation has also—

(a) made an application for a patent; or

(b) been granted a patent,

and the subject-matter of the application for a certificate for a utility innovation is the same as the subject-matter of the application mentioned in paragraph (a) or of the patent mentioned in paragraph (b), a certificate for a utility innovation shall not be granted until the application mentioned in paragraph (a) has been withdrawn or the patent mentioned in paragraph (b) has been surrendered.

PART V

RIGHTS TO A PATENT

18. Right to a patent.

(1) Any person may make an application for a patent either alone or jointly with another.

(2) Subject to section 19, the rights to a patent shall belong to the inventor.

(3) Where two or more persons have jointly made an invention, the rights to a patent shall belong to them jointly.

*[Ins. Act
A863]* (4) If two or more persons have separately and independently made the same invention, and each of them has made an application for a patent, the right to a patent for that invention shall belong to the person whose application has the earliest priority date.

19. Judicial assignment of patent application or patent.

Where the essential elements of the invention claimed in a patent application or patent have been unlawfully derived from an invention for which the right to the patent belongs to another person, such other person may apply to the Court for an order that the said patent application or patent be assigned to him:

Provided that the Court shall not entertain an application for the assignment of a patent after five years from the date of the grant of the patent.

20. Inventions made by an employee or pursuant to a commission.

(1) In the absence of any provisions to the contrary in any contract of employment or for the execution of work, the rights to a patent for an invention made in the performance of such contract of employment or in the execution of such work shall be deemed to accrue to the employer, or the person who commissioned the work, as the case may be:

Provided that where the invention acquires 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, as the case may be, the inventor shall be entitled to equitable remuneration which may be fixed by the Court in the absence of agreement between the parties.

(2) 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:

Provided that the employee shall be entitled to equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court taking into account his emoluments, the economic value of the invention and any benefit derived from it by the employer.

(3) The rights conferred on the inventor under subsections (1) and (2) shall not be restricted by contract.

21. Inventions by Government employee.

Notwithstanding the provisions of subsection (3) of section 20, the provisions of that section shall apply to a Government employee or an employee of a Government organisation or enterprise unless otherwise provided by rules or regulations of such Government organisation or enterprise.

22. Joint owners.

Where the right to obtain a patent is owned jointly, the patent may only be applied for jointly by all the joint owners.

PART VI

APPLICATION, PROCEDURE FOR GRANT AND DURATION

23. Requirements of application.

Every application for the grant of a patent shall comply with the regulations as may be prescribed by the Minister under this Act.

23A. Applications by residents to be filed in Malaysia first.

No person resident in Malaysia shall, without written authority granted by the Registrar, file or cause to be filed outside Malaysia an application for a patent for an invention unless—

- (a) an application for a patent for the same invention has been filed in the Patent Registration Office not less than two months before the application outside Malaysia; and
- (b) either no directions have been issued by the Registrar under section 30A in relation to the application or all such directions have been revoked.

24. Application fee.

An application for the grant of a patent shall not be entertained unless the prescribed fee has been paid to the Registrar.

25. Withdrawal of application.

[Subs. Act
A863]

An applicant may withdraw his application at any time during its pendency by submitting a declaration in the prescribed form to the Registrar, and such withdrawal may not be revoked.

26. Unity of invention.

An application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

26A. Amendment of application.

The applicant may amend the application:

Provided that the amendment shall not go beyond the disclosure in the initial application.

26B. Division of application.

(1) The applicant may within the prescribed time, divide the application into two or more applications (“divisional applications”): *[Am. Act A863]*

Provided that each divisional application shall not go beyond the disclosure in the initial application.

(2) Each divisional application shall be entitled to the priority date of the initial application.

27. Right of priority.

(1) An application may contain a declaration claiming the priority, pursuant to any international treaty or Convention, of one or more earlier national, regional or international applications filed, during the period of twelve months immediately preceding the filing date of the application containing the declaration, by the applicant or his predecessor in title in or for any party to the said international treaty or Convention. *[Am. Act A863]*

(1A) The period of twelve months mentioned in subsection (1) may not be extended under the provisions of section 82. *[Ins. Act A863]*

(2) Where the application contains a declaration under subsection (1), the Registrar may require that the applicant furnish, within the prescribed time, a copy of the earlier application, certified as correct by the office with which it was filed or where the earlier application is an international application filed under any international treaty, by the International Bureau of the World Intellectual Property Organization.

(3) The effect of the declaration referred to in subsection (1) shall be as provided in the treaty or Convention referred to therein.

(4) Where any of the requirements of this section or any regulations pertaining thereto have not been complied with, the declaration referred to in subsection (1) shall be deemed to be invalid.

27A. Priority date.

[Ins. Act A863]

(1) Subject to subsection (2), the priority date of an application for a patent is the filing date of the application.

(2) Where an application contains the declaration mentioned in section 27, the priority date of the application shall be the filing date of the earliest application whose priority is claimed in that declaration.

28. Filing date.

(1) The Registrar shall record as the filing date the date of receipt of the application:

Provided that the application contains—

(a) the name and address of the applicant;

- (b) the name and address of the inventor;
- (c) a description;
- (d) a claim or claims; and
- (e) that at the time of receipt of the application the prescribed fee has been paid.

(2) Where the Registrar finds that, at the time of receipt of the application, the provisions of subsection (1) are not fulfilled, he shall request the applicant to file the required correction.

(3) Where the applicant complies with the request referred to in subsection (2), the Registrar shall record as the filing date the date of receipt of the required correction and where the applicant does not so comply, the Registrar shall treat the application as invalid.

(4) Where the application refers to drawings which in fact are not included in the application, the Registrar shall request the applicant to furnish the missing drawings.

(5) Where the applicant complies with the request referred to in subsection (4), the Registrar shall record as the filing date the date of receipt of the missing drawings and where the applicant does not so comply, the Registrar shall record as the filing date the date of receipt of the application and make no reference to the said drawings.

29. Preliminary examination.

[Subs. Act
A863]

(1) Where an application for a patent has a filing date and is not withdrawn, the Registrar shall examine the application and determine whether it complies with the requirements of this Act and the regulations made under this Act which are designated by such regulations as formal requirements for the purposes of this Act.

(2) If the Registrar, as a result of the examination under subsection (1), finds that not all the formal requirements are complied with, he shall give an opportunity to the applicant to make any observation on such finding and to amend the application within the prescribed period so as to comply with those requirements, and if the applicant fails to do so the Registrar may refuse the application.

29A. Request for substantive examination or modified substantive examination.

[Ins. Act
A863]

(1) If an application for a patent has been examined under section 29 and is not withdrawn or refused, the applicant shall file, within the prescribed period, a request for a substantive examination of the application.

(2) If a patent or other title of industrial property protection has been granted to the applicant or his predecessor in title in a prescribed country outside Malaysia or under a prescribed treaty or Convention for an invention which is the same or essentially the same as the invention claimed in the application, the applicant may, instead of requesting for a substantive examination, request for a modified substantive examination.

(3) A request for a substantive examination or a modified substantive examination shall be made in the prescribed form and shall not be deemed to have been filed until the prescribed fee has been paid to the Registrar and any other prescribed requirement has been complied with.

(4) The Registrar may require the applicant to provide, at the time of filing a request for a substantive examination—

- (a) any prescribed information or prescribed supporting document concerning the filing of any application for a patent or other title of industrial property protection filed outside Malaysia by such applicant or his predecessor in title with a national, regional or international industrial property office;
- (b) any prescribed information concerning the results of any search or examination carried out by an International Searching Authority under the Patent Cooperation Treaty, relating to the same or essentially the same invention as that claimed in the application for which the request for a substantive examination is being filed.

(5) If the applicant—

- (a) fails to file either a request under subsection (1) for a substantive examination or a request under subsection (2) for a modified substantive examination; or
- (b) fails to provide the information or document referred to in subsection (4) as required by the Registrar,

within the prescribed period, the application for a patent shall, subject to subsection (6), be deemed to be withdrawn at the end of that period.

(6) Notwithstanding subsection (5), the Registrar may, upon the request of the applicant, grant a deferment of the filing of a request for examination referred to in subsection (1) or (2) or a deferment of the provision of the information or document referred to in subsection (4), and such deferment may be granted only on the grounds that—

- (a) the patent or title referred to in subsection (2) has not been granted or is not available; or

- (b) the information or document referred to in subsection (4) would not be available,

by the expiration of the prescribed period for the filing of a request under subsection (1) or (2).

(7) No deferment shall be granted under subsection (6) unless the request for such deferment is filed before the expiration of the prescribed period for the filing of a request under subsection (1) or (2) and no deferment may be sought nor granted for a period greater than that prescribed in the regulations made under this Act.

(8) Without prejudice to the power of the Registrar to grant a deferment, the period prescribed for the purposes of this section may not be extended under the provisions of section 82.

30. Substantive examination and modified substantive examination.

[Subs. Act
A863]

(1) Where a request for substantive examination has been filed under subsection (1) of section 29A, the Registrar shall refer the application to an Examiner who shall—

- (a) determine whether the application complies with those requirements of this Act and the regulations made under this Act which are designated by such regulations as substantive requirements for the purposes of this Act; and

(b) report his determination to the Registrar.

(2) Where a request for a modified substantive examination has been filed under subsection (2) of section 29A, the Registrar shall refer the application to an Examiner who shall—

- (a) determine whether the application complies with those requirements of this Act and the regulations made under this

Act which are designated by such regulations as modified substantive requirements for the purposes of this Act; and

(b) report his determination to the Registrar.

(3) If the Examiner reports, in accordance with subsection (1) or (2), that any of the requirements referred to in subsection (1) or (2), as the case may be, are not complied with, 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, and if the applicant fails to satisfy the Registrar that those requirements are complied with, or to amend the application so as to comply with them, the Registrar may refuse the application.

(4) The Registrar may grant an extension of the prescribed period referred to in subsection (3) but such extension may be granted only once and no subsequent extension may be granted under the provisions of section 82.

(5) If the Examiner reports, in accordance with subsection (1) or (2), that the application, whether as originally filed or as amended, complies with the requirements referred to in subsection (1) or (2), as the case may be, the Registrar shall notify the applicant of that fact and, subject to subsection (6), shall process the application accordingly.

(6) Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the Registrar may on that ground refuse to grant a patent in pursuance of more than one of the applications.

(7) The Registrar may waive, as he deems fit, the requirement of referring an application or any part of it for substantive examination under subsection (1):

Provided that he shall notify in the *Gazette* his intention to waive such requirement and shall allow any party who would be aggrieved by such waiver to be heard on the matter.

30A. Prohibition of publication of information which might be prejudicial to the nation.

(1) Subject to any direction of the Minister, where an application for a patent is filed or is deemed to have been filed at the Patent Registration Office and it appears to the Registrar that the application contains information the publication of which might be prejudicial to the interest or security of the nation, he may issue directions prohibiting or restricting the publication of that information or its communication whether generally or to a particular person or class of persons.

(2) Subject to any direction by the Minister, the Registrar may revoke any direction issued by him under subsection (1) prohibiting or restricting the publication or communication of any information contained in an application for a patent if he is satisfied that such publication or communication is no longer prejudicial to the interest or security of the nation.

(3) Where directions issued by the Registrar under subsection (1) are in force in respect of an application, the application may proceed to the stage where it is in order for the grant of a patent but no patent shall be granted in pursuance of such application.

(4) Nothing in this section prevents the disclosure of information concerning an invention to a Ministry or a Government department or authority for the purpose of obtaining advice as to whether directions under this section should be made, amended or revoked.

31. Grant of patent.

(1) The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the performance of any act in respect of the claimed invention is prohibited by any law or regulation, except where the performance of that act would be contrary to public order.

(2) Where the Registrar is satisfied that the application complies with sections 23, 29 and 30, he shall grant the patent and shall forthwith—

(a) issue to the applicant a certificate of grant of the patent and a copy of the patent together with a copy of the Examiner's final report; and

(b) record the patent in the Register.

[Ins. Act
A863]

(2A) Where two or more persons have separately and independently made the same invention and each of them has made an application for a patent having the same priority date, a patent may be granted on each application.

(3) As soon as possible thereafter the Registrar shall—

(a) cause to be published in the *Gazette* a reference to the grant of the patent; and

(b) make available to the public, on payment of the prescribed fee, copies of the patent.

(4) The patent shall be deemed to be granted on the date that the Registrar performs the acts referred to in subsection (2).

32. Register of Patents.

(1) The Registrar shall keep and maintain a register called the Register of Patents. [Subs. Act
A863]

(2) The Register of Patents shall contain all such matters and particulars relating to patents as may be prescribed.

(3) The Register of Patents shall be kept in such form and on such medium as may be prescribed.

32A. Notice of a trust not to be registered.

[Ins. Act
A863]

Notice of a trust, express, implied or constructive, shall not be entered in the Register or be accepted by the Registrar.

33. Examination of Register and certified copies.

Any person may examine the Register and may obtain certified extracts therefrom on payment of the prescribed fee.

33A. Certified copies of or extracts from Register, etc. admissible as evidence in court. [Ins. Act
A863]

(1) The Register shall be *prima facie* evidence of all matters required or authorized by this Act to be entered therein.

(2) Copies of or extracts from the Register, or of or from any document or publication in the Patent Registration Office, if certified by the Registrar in writing under his hand, shall be admissible in evidence in all courts without further proof or production of the original.

33B. Amendments to the Register. [Ins. Act
A863]

(1) The Registrar may, on request made in the prescribed manner by the owner of a patent, amend the Register—

- (a) by correcting any error in the name or address of the owner of the patent; or
- (b) by entering any change in the name or address of the owner of the patent.

(2) Where the Register has been amended under this section, the Registrar may require the certificate of grant of the patent to be submitted to him, and may—

- (a) revoke the certificate of grant of the patent and issue a new certificate of grant of the patent; or
- (b) make any consequential amendments in the certificate of grant of the patent as are rendered necessary by the amendment of the Register.

(3) Notwithstanding any other provision of this Act or the regulations made under this Act, no fee shall be payable by the owner of a patent in respect of a request to correct any error in the name or address of such owner unless such error is caused or contributed to by such owner.

[Ins. Act
A863]

33c. Court may order rectification of the Register.

(1) The Court may, on the application of any aggrieved person, order the rectification of the Register by directing—

- (a) the making of any entry wrongly omitted from the Register;
- (b) the expunging or amendment of any entry wrongly made in or remaining in the Register; or
- (c) the correcting of any error or defect in the Register.

(2) Notice of every application under this section shall be served on the Registrar who shall have the right to appear and be heard, and who shall appear if so directed by the Court.

(3) Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing signed by him—

- (a) giving particulars in relation to the matter in issue;
- (b) of the grounds of any decision given by him affecting the matter in issue;
- (c) of the practice of the Patent Registration Office in like cases; or
- (d) of such other matters relevant to the issues and within his knowledge as Registrar, as he thinks fit,

and such statement shall be deemed to form part of the evidence in Court.

(4) A sealed copy of an order under this section shall be served on the Registrar who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

34. Inspection of files.

(1) Any person may, after the grant of a patent, inspect the file relating to the patent and, subject to subsection (2), the file relating to any patent application, and may obtain certified extracts therefrom on payment of the prescribed fee.

(2) The file relating to a patent application may be inspected before the grant of the patent only with the written permission of the applicant:

Provided that before the grant of the patent, the Registrar may divulge the following information to any person:

- (a) the name, address and description of the applicant and the name and address of the agent, if any;
- (b) the number of the application;
- (c) the filing date of the application and, if priority is claimed, the priority date, the number of the earlier application and the name of the State in which the earlier application was filed or where the earlier application is a regional or an international application, the name of the country or countries for which and the office at which it was filed;
- (d) the title of the invention;
- (e) any change in the ownership of the application and any reference to a licence contract appearing in the file relating to the application.

(3) No person employed in or at the Patent Registration Office or the office of any examiner may make a patent application or be granted a patent or acquire or hold in any manner whatever any rights relating to a patent during the period of his employment in or at the Patent Registration Office or the office of any examiner and for one year after the termination of such employment.

35. Duration of patent.

(1) Subject and without prejudice to the other provisions of this Act, a patent shall expire fifteen years after the date of its grant.

(2) Where a patentee intends at the expiration of the second year from the date of grant of the patent to keep the same in force he shall, twelve months before the date of expiration of the second and each succeeding year during the term of the patent, pay the prescribed annual fee:

Provided, however, that a period of grace of six months shall be allowed after the date of such expiration, upon payment of such surcharge as may be prescribed.

[Ins. Act
A863]

(3) If the prescribed annual fee is not paid in accordance with subsection (2), the patent shall lapse, and a notice of the lapsing of the patent for non-payment of any annual fee shall be published in the *Gazette*.

[Ins. Act
A863]

35A. Reinstatement of a lapsed patent.

(1) Within two years from the date on which a notice of the lapsing of a patent is published in the *Gazette*—

- (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 prescribed form to have the patent reinstated.

(2) The Registrar may reinstate a patent on an application made under subsection (1)—

- (a) upon payment of all annual fees due and of a prescribed surcharge for reinstatement; and
- (b) upon being satisfied that the non-payment of annual fees was due to accident, mistake or other unforeseeable circumstances.

(3) Where the Registrar reinstates a lapsed patent, he shall cause notice of the reinstatement to be published in the *Gazette*.

(4) The reinstatement of a lapsed patent shall not prejudice the rights acquired by third parties after it is notified in the *Gazette* that the patent has lapsed and before it is notified in the *Gazette* that the patent has been reinstated.

(5) The Minister may make regulations to provide for the protection or compensation of persons who have exploited or taken definite steps, by contract or otherwise, to exploit a patent after it is notified in the *Gazette* that the patent has lapsed and before it is notified in the *Gazette* that the patent has been reinstated, but any such protection shall not extend beyond such exploitation of the lapsed patent as such persons have availed themselves of or have taken definite steps to avail themselves of.

(6) No proceedings shall be taken in respect of an infringement of a patent committed after it is notified in the *Gazette* that the patent has lapsed and before it is notified in the *Gazette* that the patent has been reinstated.

PART VII

RIGHTS OF OWNER OF PATENT

36. Rights of owner of patent.

(1) Subject and without prejudice to the other provisions of this Part, the owner of a patent shall have the following exclusive rights in relation to the patent:

- (a) to exploit the patented invention;
- (b) to assign or transmit the patent;
- (c) to conclude licence contracts.

(2) No person shall do any of the acts referred to in subsection (1) without the consent of the owner of the patent.

(3) For the purpose of this Part, “exploitation” of a patented invention means any of the following acts in relation to a patent:

- (a) when the patent has been granted in respect of a product:
 - (i) making, importing, offering for sale, selling or using the product;
 - (ii) stocking such product for the purpose of offering for sale, selling or using;
- (b) when the patent has been granted in respect of a process:
 - (i) using the process;
 - (ii) doing any of the acts referred to in paragraph (a), in respect of a product obtained directly by means of the process.

(4) For the purposes of this section, if the patent has been granted in respect of a process for obtaining a product, the same product produced by a person other than the owner of the patent or his licensee shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process.

37. Limitation of rights.

(1) The rights under the patent shall extend only to acts done for industrial or commercial purposes and in particular not to acts done only for scientific research.

(2) The rights under the patent shall not extend to acts in respect of products which have been put on the market—

- (i) by the owner of the patent;
- (ii) by a person having the right referred to in section 38;
- (iii) by a person having the right referred to in section 43;
- (iv) by the beneficiary of a compulsory licence within the meaning of section 48.

(3) The rights under the patent shall not extend to the use of the patented invention on any foreign vessel, aircraft, spacecraft or land vehicle temporarily in Malaysia.

(4) The rights under the patent shall be limited in duration as provided for in section 35.

(5) The rights under the patent shall be limited by the provisions of section 35A, by the provisions on compulsory licences as provided in sections 51 and 52 and by the provisions on the rights of Government or any person authorised by the Government as provided in section 84.

38. Rights derived from prior manufacture or use.

(1) Where a person at the priority date of the patent application—

- (a) was in good faith in Malaysia making the product or using the process which is the subject of the invention claimed in the application;
- (b) had in good faith in Malaysia made serious preparations towards the making of the product or using the process referred to in paragraph (a),

he shall have the right, despite the grant of the patent, to exploit the patented invention:

Provided that the product in question is made, or the process in question is used, by the said person in Malaysia:

Provided further that he can prove, if the invention was disclosed under the circumstances referred to in paragraphs (a), (b) or (c) of subsection (3) of section 14 that his knowledge of the invention was not a result of such disclosure.

(2) The right referred to in subsection (1) shall not be assigned or transmitted except as part of the business of the person concerned.

PART VIII

ASSIGNMENT AND TRANSMISSION OF PATENT APPLICATIONS AND PATENTS

39. Assignment and transmission of patent applications and patents.

(1) A patent application or patent may be assigned or transmitted.

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

(3) No such assignment or transmission 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.

(4) No such assignment or transmission shall have effect against third parties unless so recorded in the Register.

40. Joint ownership of patent applications or patents.

In the absence of any agreement to the contrary between the parties, joint owners of a patent application or patent may, separately, assign or transmit their rights in the patent application or patent, exploit the patented invention and take action against any person exploiting the patented invention without their consent, but may only jointly withdraw the patent application, surrender the patent or conclude a licence contract.

PART IX

LICENCE CONTRACTS

41. Meaning of licence contract.

(1) For the purposes of this Part, a “licence contract” means any contract by which the owner of a patent (the “licensor”) grants to another person or enterprise (the “licensee”) a licence to do any or all of the acts referred to in paragraph (a) of subsection (1), and subsection (3), of section 36.

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

42. Entry in the Register.

(1) A licensor may in accordance with the regulations as prescribed by the Minister apply to the Registrar for an entry to be made in the Register to the effect that any person may obtain a licence.

(2) At any time after an entry has been made in the Register, any person may apply to the licensor through the Registrar for a licence.

(3) Where a licence contract is concluded between the parties, the contracting parties shall inform the Registrar accordingly and the Registrar shall record such fact in the Register.

(4) Upon a request in writing signed by or on behalf of the contracting parties, the Registrar shall, on payment of the prescribed fee, record in the Register such particulars relating to the contract as the parties thereto might wish to have recorded:

Provided that the parties shall not be required to disclose or have recorded any other particulars relating to the said contract.

(5) Where a licence contract is terminated, the contracting parties shall inform the Registrar of the termination and the Registrar shall record such termination in the Register.

(6) The licensor may in accordance with the regulations as prescribed by the Minister apply to the Registrar for the cancellation of the entry made under subsection (1).

43. Rights of the licensee.

(1) In the absence of any provision to the contrary in the licence contract, the licensee shall be entitled to do any or all of the acts referred to in paragraph (a) of subsection (1), and subsection (3), of section 36 within the whole geographical area of Malaysia without limitation as to time and through any application of the invention.

(2) In the absence of any provision to the contrary in the licence contract, the licensee may not give to a third person his agreement to perform in Malaysia in respect of the invention any of the acts referred to in paragraph (a) of subsection (1), and subsection (3), of section 36.

44. Rights of the licensor.

(1) In the absence of any provision to the contrary in the licence contract, the licensor may grant a further licence to a third person in respect of the same patent or himself do any or all of the acts referred to in paragraph (a) of subsection (1), and subsection (3), of section 36.

(2) Where the licence contract provides that the licence is exclusive and unless it is expressly provided otherwise in such contract, the licensor shall not grant a further licence to a third person in respect of the same patent or himself do any of the acts referred to in paragraph (a) of subsection (1), and subsection (3), of section 36.

45. Invalid clauses in licence contracts.

Any clause or condition in a licence contract shall be invalid in so far as it imposes upon the licensee, in the industrial or commercial field, restrictions not derived from the rights conferred by this Part on the owner of the patent, or unnecessary for the safeguarding of such rights:

Provided that—

- (a) restrictions concerning the scope, extent or duration of exploitation of the patented invention, or the geographical area in, or the quality or quantity of the products in connection with, which the patented invention may be exploited; and
- (b) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the patent,

shall not be deemed to constitute such restrictions.

46. Effect of patent application not being granted or patent being declared invalid.

Where, before the expiration of the licence contract, any of the following events occur in respect of the patent application or patent referred to in such contract:

- (a) the patent application is withdrawn;
- (b) the patent application is finally rejected;
- (c) the patent is surrendered;

- (d) the patent is declared invalid;
- (e) the licence contract is invalidated,

the licensee shall no longer be required to make any payment to the licensor under the licence contract, and shall be entitled to repayment of the payment already made:

Provided that the licensor shall not be required to make any repayment, or shall be required to make repayment only in part, to the extent that he can prove that any such repayment would be inequitable under all the circumstances, in particular if the licensee has effectively profited from the licence.

47. Expiry, termination or invalidation of licence contract.

The Registrar shall—

- (a) if he is satisfied that a recorded licence contract has expired or been terminated, record that fact in the Register upon a request in writing to that effect signed by or on behalf of the parties thereto;
- (b) record in the Register the expiry, termination or invalidation of a licence contract under any provision of this Part.

PART X

COMPULSORY LICENCES

48. Definition.

For the purpose of this Part—

“beneficiary of the compulsory licence” means the person to whom a compulsory licence has been granted in accordance with this Part; and

“compulsory licence” means the authorisation to perform in Malaysia without the agreement of the owner of the patent in respect of the patented invention any of the acts referred to in paragraph (a) of subsection (1), and subsection (3), of section 36.

49. Application for compulsory licences.

(1) At any time after the expiration of three years from the grant of a patent, any person may apply to the Registrar for a compulsory licence if it appears at the time when such application is filed—

- (a) that there is no production of the patented product or application of the patented process without any legitimate reason;

- (b) that there is no product produced under the patent for sale in any domestic market, or there are some but they are sold at unreasonably high prices or do not meet the public demand without any legitimate reason.

(2) The application for a compulsory licence shall be in compliance with the regulations as may be prescribed by the Minister.

49A. Application for compulsory licence based on inter-dependence of patents.

(1) If the invention claimed in a patent ("later patent") cannot be worked in Malaysia without infringing a patent granted on the basis of an application benefiting from an earlier priority date ("earlier patent"), and if the invention claimed in the later patent constitutes, in the opinion of the Board, an important technical advance in relation to the invention claimed in the earlier patent, the Board, upon the request of the owner of the later patent, the licensee of a licence contract under the later patent or the beneficiary of a compulsory licence under the later patent, may grant a compulsory licence to the extent necessary to avoid infringement of the earlier patent.

(2) If a compulsory licence is granted under subsection (1), the Board, upon the request of the owner of the earlier patent, the licensee of a licence contract under the earlier patent or the beneficiary of a compulsory licence under the earlier patent, may grant a compulsory licence under the later patent.

50. Request for grant of compulsory licence.

(1) In an application for a compulsory licence under section 49 or section 49A, the applicant shall set forth the amount of royalty, the conditions of the exploitation of the patent and the restrictions of the rights of the licensor or the licensee, as the case may be, and a request for the said licence.

(2) Where an application for a compulsory licence is filed pursuant to section 49 or section 49A, and this section, the Registrar shall notify the applicant, the licensor or the licensee, as the case may be, of the date the application shall be considered by the Board.

(3) The licensor or the licensee, as the case may be, shall be furnished with a copy of the application as mentioned in subsection (1).

51. Decision by the Board.

(1) In considering the application for a compulsory licence under section 49 or section 49A, the Board may require the applicant, the licensor or the licensee, as the case may be, to appear before the Board to give a statement or to hand to the Board any document or any other item.

(2) When the application has been considered by the Board and a decision has been made, the applicant, the licensor or the licensee, as the case may be, shall be notified of the decision.

52. Scope of compulsory licence.

Upon the granting of the compulsory licence to the applicant the Board shall fix—

- (a) the scope of the licence specifying in particular for what period the licence is granted and to which of the acts referred to in paragraph (a) of subsection (1), and subsection (3), of section 36 the licence extends except that it may not extend to the act of importation;
- (b) the time limit within which the beneficiary of the compulsory licence shall begin to work the patented invention in Malaysia; and
- (c) the amount and conditions of the royalty due from the beneficiary of the compulsory licence to the owner of the patent.

53. Limitation of compulsory licence.

The beneficiary of the compulsory licence shall not conclude licence contracts with third persons under the patent in respect of which the compulsory licence was granted.

54. Amendment, cancellation and surrender of compulsory licence.

(1) Upon the request of the owner of the patent or of the beneficiary of the compulsory licence, the Board may amend the decision granting the compulsory licence to the extent that new facts justify such amendment.

(2) Upon the request of the owner of the patent, the Board shall cancel the compulsory licence—

- (a) if the ground for the grant of the compulsory licence no longer exists;
- (b) if the beneficiary of the compulsory licence has, within the time limit fixed in the decision granting the licence, neither begun the working of the patented invention in Malaysia nor made serious preparations towards such working;
- (c) if the beneficiary of the compulsory licence does not respect the scope of the licence as fixed in the decision granting the licence;
- (d) if the beneficiary of the compulsory licence is in arrears of the payment due, according to the decision granting the licence.

(3) The beneficiary of the compulsory licence may surrender the licence by a written declaration submitted to the Registrar who shall record the surrender in the Register, publish it, and notify the owner of the patent.

(3A) Where a compulsory licence has been granted in respect of a patent, the Registrar shall not accept or record the said surrender except upon receipt of a signed declaration by which the beneficiary of the compulsory licence consents to the said surrender.

(4) The surrender shall take effect from the date the Patent Registration Office receives the declaration of the surrender.

PART XI

SURRENDER AND INVALIDATION OF PATENT

55. Surrender of patent.

(1) The owner of the patent may surrender the patent by a written declaration submitted to the Registrar.

(2) The surrender may be limited to one or more claims of the patent.

(3) Where a licence contract in respect of a patent is recorded in the Register, the Registrar shall not, in the absence of any provision to the contrary in the licence contract, accept or record the said surrender except upon receipt of a signed declaration by which every licensee or sub-licensee on record consents to the said surrender unless the requirement of his consent is expressly waived in the licence contract.

[Ins. Act
A648]

(3A) Where a compulsory licence has been granted in respect of a patent, the Registrar shall not accept or record the said surrender except upon receipt of a signed declaration by which the beneficiary of the compulsory licence consents to the said surrender.

(4) The Registrar shall record the surrender in the Register and cause it to be published in the *Gazette*.

(5) The surrender shall take effect from the date the Registrar receives the declaration.

56. Invalidation of patent.

(1) Any aggrieved person may institute Court proceedings against the owner of the patent for the invalidation of the patent.

(2) The Court shall invalidate the patent if the person requesting the invalidation proves—

- (a) that what is claimed as an invention in the patent is not an invention within the meaning of section 12 or is excluded from protection under section 13 or subsection (1) of section 31 or is not patentable because it does not comply with the requirements of sections 11, 14, 15 and 16;
- (b) that the description or the claim does not comply with the requirements of section 23;
- (c) that any drawings which are necessary for the understanding of the claimed invention have not been furnished;
- (d) that the right to the patent does not belong to the person to whom the patent was granted; or
- (e) that incomplete or incorrect information has been deliberately provided or caused to be provided to the Registrar under subsection (4) of section 29A by the person to whom the patent was granted or by his agent.

[Ins. Act
A863]

(2A) Notwithstanding subsection (2), the Court shall not invalidate the patent on the ground mentioned in paragraph (d) of subsection (2) if the patent has been assigned to the person to whom the right to the patent belongs.

[Ins. Act
A863]

(3) Where the provisions of subsection (1) apply on only some of the claims or some parts of a claim, such claims or parts of a claim may be declared invalid by the Court and the invalidity of part of a claim shall be declared in the form of a corresponding limitation of the claim in question.

57. Date and effect of invalidation.

(1) Any invalidated patent or claim or part of a claim shall be regarded as null and void from the date of the grant of the patent.

(2) When the decision of the Court becomes final, the Registrar of the Court shall notify the Registrar who shall record the said declaration in the Register and cause it to be published in the *Gazette*.

PART XII

INFRINGEMENT

58. Acts deemed to be infringement.

Subject to subsections (1), (2) and (3) of section 37 and section 38, an infringement of a patent shall consist of the performance of any act referred to in subsection (3) of section 36 in Malaysia by a person other than the owner of the patent and without the agreement of the latter in relation to a product or a process falling within the scope of protection of the patent.

59. Infringement proceedings.

(1) The owner of the patent shall have the right to institute Court proceedings against any person who has infringed or is infringing the patent.

(2) The owner of the patent shall have the same right against any person who has performed acts which make it likely that an infringement will occur, which in this Part is referred to as an “imminent infringement”.

(3) The proceedings in subsections (1) and (2) may not be instituted after five years from the act of infringement.

60. Injunction and award of damages.

(1) If the owner of the patent proves that an infringement has been committed or is being committed, the Court shall award damages and shall grant an injunction to prevent further infringement and any other legal remedy.

(2) If the owner of the patent proves imminent infringement the Court shall grant an injunction to prevent infringement and any other legal remedy.

(3) The defendant in any proceedings referred to in this section may request in the same proceedings the invalidation of the patent, in which case the provisions of subsections (2) and (3) of section 56 shall apply.

61. Infringement proceedings by licensee and beneficiary of compulsory licence.

(1) For the purposes of this section, “beneficiary” means—

(a) any licensee unless the licence contract provides that the provisions of this subsection do not apply or provides different provisions;

(b) the beneficiary of a compulsory licence granted under section 51.

(2) Any beneficiary may request the owner of the patent to institute Court proceedings for any infringement indicated by the beneficiary, who shall specify the relief desired.

(3) The beneficiary may, if he proves that the owner of the patent received the request but refuses or fails to institute the proceedings within three months from the receipt of the request, institute the proceedings in his own name, after notifying the owner of the patent of his intention but the owner shall have the right to join in the proceedings.

(4) Notwithstanding that the three-month period referred to in subsection (3) has not been satisfied, the Court shall, on the request of the beneficiary, grant an appropriate injunction to prevent infringement or to prohibit its continuation, if the beneficiary proves that immediate action is necessary to avoid substantial damage.

62. Declaration of non-infringement.

(1) Subject to subsection (4), any interested person shall have the right to 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.

(2) If the person making the request proves that the act in question does not constitute an infringement of the patent, the Court shall grant the declaration of non-infringement.

(3) (a) The owner of the patent shall have the obligation to notify the licensee of the proceedings and the licensee shall have the right to join in the proceedings in the absence of any provision to the contrary in the licence contract.

(b) The person requesting the declaration of non-infringement shall have the obligation to notify the beneficiaries of the compulsory licence granted under section 51 of the proceedings and the said beneficiaries shall have the right to join in the proceedings.

(4) If the act in question is already the subject of infringement proceedings, the defendant in the infringement proceedings may not institute proceedings for a declaration of non-infringement.

(5) Proceedings for a declaration of non-infringement may be instituted together with proceedings to invalidate the patent, except where invalidation of the patent is requested under subsection (3) of section 60.

62A. Applications in contravention of section 23A.

Any person who files or causes to be filed an application for a patent in contravention of section 23A commits an offence and is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both.

62B. Publication of information in contravention of Registrar's directions.

Any person who publishes or communicates information in contravention of any direction issued by the Registrar under section 30A commits an offence and is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both.

PART XIII
OFFENCES

63. Falsification of Register, etc.

Any person who makes or causes to be made a false entry in any Register kept under this Act, or makes or causes to be made a writing falsely purporting to be a copy or reproduction of an entry in any such Register, or produces or tenders or causes to be produced or tendered in evidence any such false writing, commits an offence and is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both.

64. Unauthorised claim or patent.

(1) Any person who falsely represents that anything disposed of by him for value is a patented product or process commits an offence and, subject to the following provisions of this section, is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both.

(2) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word “patent” or “patented” or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

(3) Subsection (1) does not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has, expired or been invalidated and before the end of a period which is reasonably sufficient to enable that person to take steps to ensure that the representation is not made or does not continue to be made.

(4) In proceedings for an offence under this section, it shall be a defence for any person to prove that he used due diligence to prevent the commission of the offence.

65. Unauthorised claim that patent has been applied for.

(1) Any person who represents that a patent has been applied for in respect of any article disposed of for value by him and—

(a) no such application has been made, or

(b) any such application has been refused or withdrawn,

commits an offence and, subject to the following provisions of this section, is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both.

(2) Paragraph (b) of subsection (1) does not apply where the representation is made or continues to be made before the expiry of a period which commences with the refusal or withdrawal and which is reasonably sufficient to enable that person to take steps to ensure that the representation is not made or does not continue to be made.

(3) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words “patent pending”, or anything expressing or implying that a patent has been applied for in respect of the article, shall be taken to represent that a patent has been applied for in respect of the article.

(4) In any proceedings for an offence under this section, it shall be a defence for any person to prove that he used due diligence to prevent the commission of the offence.

66. Misuse of title “Patent Registration Office”.

Any person who uses on his place of business or any document issued by him or otherwise, the words “Patent Registration Office” or any other words suggesting that his place of business is, or is officially connected with, the Patent Registration Office commits an offence and is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both.

66A. Unregistered persons practising, etc., as a patent agent.

Any person who carries on business, practises, acts, describes himself, holds himself out, or permits himself to be described or held out, as a patent agent without being registered under this Act commits an offence and is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both.

67. Offences by corporation.

(1) Where an offence under this Act which has been committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of a director, manager, secretary or other similar officer of the body corporate, or any person who was purporting to act in any such capacity, he, as well as the body corporate, commits that offence and is liable to be prosecuted against and punished accordingly as provided by the Act.

(2) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he was a director of a body corporate.

PART XIV
POWERS RELATING TO ENFORCEMENT

68. Authorization of officer to exercise powers under this Part.

(1) The Minister may authorize in writing any public officer to exercise the powers under this Part.

(2) Any such officer shall be deemed to be a public servant within the meaning of the Penal Code.

(3) In exercising any of the powers under this Part, an officer shall on demand produce to the person against whom he is acting under this Act the authority issued to him by the Minister.

69. Powers of arrest.

(1) Any authorized officer or police officer may arrest without warrant any person whom he sees or finds committing or attempting to commit or abetting the commission of an offence or whom he reasonably suspects of being engaged in committing or attempting to commit or abetting the commission of any offence against this Act if such person refuses or fails to furnish his name and residence or there are reasonable grounds for believing that he has furnished a false name or residence or that he is likely to abscond.

(2) Any authorized officer or police officer making an arrest without warrant shall, without unnecessary delay, bring the person arrested to the nearest police station.

(3) No person who has been arrested by an authorized officer or police officer shall be released except on his own bond or on bail or on the special order in writing of a Magistrate.

70. Search with warrant.

(1) Whenever it appears to any Magistrate upon written information on oath and after any enquiry which he may think necessary that there is reasonable cause to believe that in any dwelling house, shop, building or place there is being committed an offence against this Act, or any regulations made thereunder, he may issue a warrant authorizing any authorized officer or police officer named therein, by day or night and with or without assistance to enter the dwelling house, shop, building or place and there search for and seize or take copies of all books, accounts, documents or other articles which contain or are suspected to contain information as to any offence so suspected to have been committed or any other thing relating to the offence.

(2) Any such officer may if it is necessary so to do—

- (a) break open any outer or inner door of the dwelling house, shop, building or place, and enter therein;
- (b) forcibly enter the dwelling house, shop, building or place and every part thereof;
- (c) remove by force any obstruction to enter, search, seize and remove as he is empowered to effect; and
- (d) detain every person found therein until the dwelling house, shop, building or place has been searched.

71. List of things seized.

The authorized officer or police officer seizing any books, accounts, documents or other articles under this Part shall prepare a list of the things seized and forthwith deliver a copy signed by him to the occupier or his agents or servants present in the premises.

72. Return of things seized.

Where under this Part possession has been taken of any books, accounts, documents or other articles, then the authorized officer or police officer shall within four weeks of the seizure, where no criminal proceedings have been instituted, restore possession to the owner.

73. Power of investigation.

(1) An authorized officer or police officer shall have the power to investigate the commission of any offence under this Act or regulations made thereunder.

(2) Every person required by an authorized officer or police officer to give information or produce any book, account, document or other article relating to the commission of such offence which it is in the person's power to give shall be legally bound to give the information or to produce the book, account, document or other article.

74. Examination of witnesses.

(1) An authorized officer or police officer making an investigation under section 73 may examine orally any person supposed to be acquainted with the facts and circumstances of the case and shall reduce into writing any statement made by the person so examined.

(2) Such person shall be bound to answer all questions relating to such case put to him by such officer:

Provided that such person may refuse to answer any question the answer to which have a tendency to expose him to a criminal charge or penalty or forfeiture.

(3) A person making a statement under this section shall be legally bound to state the truth, whether or not such statement is made wholly or partly in answer to questions.

(4) An authorized officer or police officer examining a person under subsection (1) shall first inform that person of the provisions of subsections (2) and (3).

(5) A statement made by any person under this section whether or not a caution has been administered to him under section 75 shall, whenever possible, be reduced into writing and signed by the person making it or affixed with his thumb-print, as the case may be, after it has been read to him in the language in which he made it and after he has been given an opportunity to make any correction he may wish.

75. Admission of statements in evidence.

Where any person is charged with any offence under this Act or any regulations made thereunder, any statement whether the statement amounts to a confession or not or is oral or in writing, made at any time, whether before or after the person is charged and whether in the course of investigations made under section 74 or not and whether or not wholly or partly in answer to questions by that person to or in the hearing of any authorized officer or police officer of or above the rank of Inspector and whether or not interpreted to him by another authorized officer, police officer or other person, shall be admissible in evidence at his trial and, if the person charged tenders himself as a witness, any such statement may be used in cross-examination and for the purpose of impeaching his credit:

Provided that—

(a) no such statement shall be admissible or used as aforesaid—

- (i) if the making of the statement appears to the Court to have been caused by any inducement, threat or promise having reference to the charge proceeding from a person in authority and sufficient in the opinion of the Court to give the person charged grounds which would appear to him reasonable for supposing that by making it he would gain any advantage or avoid any evil of a temporal nature in references to the proceedings against him; or
- (ii) in the case of a statement made by the person after his arrest, unless the Court is satisfied that a caution was administered to him in the following words or words to the like effect:

“It is my duty to warn you that you are not obliged to say anything or to answer any question, but anything you say, whether or not in answer to a question, may be given in evidence”; and

- (b) a statement made by any person before there is time to caution him shall not be rendered inadmissible in evidence merely by reason of no such caution having been administered if it had been administered as soon as possible.

(2) Notwithstanding anything to the contrary contained in any written law, a person accused of an offence to which subsection (1) applies shall not be bound to answer any questions relating to the case after any such caution as aforesaid has been administered to him.

76. Obstruction to search, etc.

Any person who—

- (a) refuses any authorized officer or police officer access to any place;
- (b) assaults, obstructs, hinders or delays any authorized officer or police officer in effecting any entrance which he is entitled to effect under this Act, or in the execution of any duty imposed or power conferred by this Act; or
- (c) refuses or neglects to give any information which may reasonably be required of him and which he has it in his power to give,

commits an offence and is liable on conviction to a fine not exceeding three thousand ringgit or to imprisonment for a term not exceeding one year or to both.

77. Conduct of prosecution.

Any prosecution in respect of an offence against this Act may be conducted by an authorised officer.

78. Jurisdiction of subordinate Court.

(1) Notwithstanding any other written law, a subordinate Court shall have power to try any offence under this Act and on conviction to impose the full penalty therefor.

(2) For the purpose of subsection (1), “subordinate Court” means a Sessions Court or a Magistrate’s Court.

PART XV
MISCELLANEOUS

79. Power of Registrar to amend patent application.

[Subs. Act
A863]

(1) The Registrar may, upon a request made by an applicant for a patent in accordance with regulations made under this Act, amend the applicant's patent application, or any document submitted at the Patent Registration Office in connection with the application, for the purpose of correcting a clerical error or an obvious mistake.

(2) Every request under subsection (1) shall be accompanied by the prescribed fee.

[Ins. Act
A863]

79A. Power of Registrar to amend patent.

(1) The Registrar may, upon a request made by the owner of a patent in accordance with regulations made under this Act, amend the description, the claim or claims, or the drawings, of the patent, or amend any other document associated with the patent, for the purpose of correcting a clerical error or an obvious mistake or for any other reason acceptable to the Registrar.

(2) The Registrar shall not make an amendment under this section if the amendment would have the effect of disclosing a matter which extends beyond that disclosed before the amendment or if the amendment would have the effect of extending the protection conferred at the time of grant of the patent.

(3) The Registrar shall not make an amendment under this section if there are pending before any Court proceedings in which the validity of the patent may be put in issue.

(4) Every request under subsection (1) shall be accompanied by the prescribed fee.

(5) Notwithstanding subsection (4), no fee shall be payable by the owner of a patent in respect of a request to correct a mistake or an error in any document issued by the Patent Registration Office unless such mistake or error is caused or contributed to by such owner.

80. Other powers of Registrar.

(1) The Registrar may, for the purpose of this Act—

- (a) summon witnesses;
- (b) receive evidence on oath;
- (c) require the production of any document or article; and
- (d) award costs as against a party to proceedings before him.

(2) Any person who without any lawful excuse fails to comply with any summons, order or direction made by the Registrar under paragraphs (a), (b) and (c) of subsection (1) commits an offence and is liable on conviction to a fine not exceeding two thousand ringgit or to imprisonment for a term not exceeding six months or to both.

(3) Costs awarded by the Registrar may in default of payment be recovered in a Court of competent jurisdiction as a debt due by the person against whom the costs were accorded to the person in whose favour they were accorded.

81. Exercise of discretionary power.

Where any discretionary power is given to the Registrar by this Act or any regulations made thereunder, he shall not exercise the power on any person who may be adversely affected by his decision without giving to the person an opportunity of being heard.

82. Extension of time.

Subject to subsection (1A) of section 27, subsection (8) of section 29A and subsection (4) of section 30, where, by this Act or any regulations made thereunder a time is specified within which an act or thing is to be done the Registrar may, unless otherwise expressly directed by the Court, extend the time either before or after its expiration upon payment of the prescribed fee. [Am. Act
A863]

83. Extension of time by reason of error in Patent Registration Office.

(1) Where by reason of—

- (a) circumstances beyond the control of the person concerned;
or
- (b) an error or action on the part of the Patent Registration Office,

an act in relation to an application for a patent or in proceedings under this Act, not being proceedings in a Court, required to be done within a certain time has not been so done, the Registrar may extend the time for doing the act.

(2) The time required for doing an act may be extended under this section although that time has expired.

[Ins. Act
A863]

83A. Certificate by the Registrar.

The Registrar may certify, by writing under his hand, that an entry, matter or thing required by or under this Act to be made or done, or not to be made or done, has or has not been made or done, as the case may be, and such certificate shall be *prima facie* evidence of the truth of the facts stated therein and shall be admissible in evidence in all courts.

84. Rights of Government.

Notwithstanding anything contained in this Act—

(a) the Government of the Federation or of any State, a Ministry or Government department or any person authorised by such Government, Ministry or Government department may make, use and exercise any invention registered or in respect of which exclusive privileges have been granted in accordance with the provisions of this Act or do any act which would otherwise be an infringement of the privileges or rights mentioned in this Act;

(b) the Government of the Federation or any State, Ministry or Government department or person authorised by such Government, Ministry or Government department shall pay reasonable compensation for making, using or exercising the said invention or arising out of any act which would otherwise be an infringement of the privileges or rights mentioned in this Act.

85. Refusal to grant patent by the Registrar.

The Registrar in the exercise of his powers shall have the right to refuse to grant a patent for products or processes scheduled under regulations made by the Minister under this Act where it appears to the Registrar that the granting of such a patent would be prejudicial to the interest or security of the nation.

86. Patent agents.

(1) There shall be kept at the Patent Registration Office a Register of Patents Agents.

(2) No person shall carry on business, practise, act, describe himself, hold himself out, or permit himself to be described or held out, as a patent agent unless he is registered in the Register of Patents Agents.

(3) The registration of a patent agent mentioned in subsection (2) shall be in accordance with the regulations as may be prescribed by the Minister under this Act.

(4) The appointment or change of a patent agent shall not be effective against any third person unless it is registered in the Register of Patents Agents.

(5) A person who has neither his domicile nor residence in Malaysia may not proceed before the Patent Registration Office under the provisions of this Act in respect of his patent except through a patent agent.

87. Regulations.

(1) Subject to the provisions of this Act, the Minister may make regulations for the purpose of carrying into effect the provisions of this Act.

(2) In particular and without prejudice to the generality of subsection (1), such regulations may provide for all or any of the following:

- (a) to regulate the procedure to be followed in connection with any proceeding or other matter before the Registrar or the Patent Registration Office under this Act including the service of documents;
- (b) to classify goods including methods and processes for the purpose of registration of patents;
- (c) to make or require duplication of patents or other documents;
- (d) to secure and regulate the publishing, selling or distributing, in such manner as the Minister may think fit, of copies of patents and other documents;
- (e) to prescribe the fees payable for applications for patents and other fees payable for other matters prescribed under this Act;
- (f) to prescribe forms, books, registers, documents and other matters to be used under this Act;
- (g) to regulate generally on matters pertaining to the business of patents carried on in the Patent Registration Office whether or not specially prescribed under this Act.

88. Appeal.

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

(2) The same rules of procedure on appeal shall apply to appeals made under subsection (1) as to appeals to the High Court from a decision of a subordinate Court in civil matters.

89. Repeal and saving provisions.

The Registration of United Kingdom Patents Act 1951, the Patents Ordinance of Sarawak, the Registration of United Kingdom Patents Ordinance of Sabah and the Patents (Rights of Government) Act 1967 are repealed:

Provided that:

- (a) any subsidiary legislation made under the repealed laws shall in so far as such subsidiary legislation is not inconsistent with the provisions of this Act continue in force and have effect as if it had been made under this Act and may be repealed, extended, varied or amended accordingly;
- (b) any appointment made under the repealed laws or subsidiary legislation made thereunder shall continue in force and have effect as if it had been made under this Act unless the Minister otherwise directs;
- (c) any certificate or grant issued or made, in respect of a patent, under the repealed laws and in force immediately prior to the coming into force of this Act shall remain in force—*[Subs. Act A863]*
 - (i) so long as the original patent remains in force in the United Kingdom; or
 - (ii) until the expiration of twenty years from the date of application,whichever is the earlier.

90. Transitional.

(1) Where an application has been made under an Act or Ordinance repealed under section 89, the Registrar may issue a certificate or make a grant on such application as if the Act or Ordinance had not been repealed, and such certificate or grant shall remain in force—*[Am. Act A863]*

- (a) so long as the original patent remains in force in the United Kingdom; or
- (b) until the expiration of twenty years from the date of application,

whichever is the earlier.

(2) Where a patent has been granted under the United Kingdom Patents Act 1977 not earlier than twenty-four months before the coming into force of this Act, the owner of the patent may, within a period of twelve months from the coming into force of this Act, make an application for a certificate or a grant and the Registrar may issue a certificate or make a grant on such application as if the Act or Ordinance repealed under section 89 had not been repealed, and such certificate or grant shall remain in force—*[Am. Act A863]*

- (a) so long as the original patent remains in force in the United Kingdom; or
- (b) until the expiration of twenty years from the date of the application,

whichever is the earlier.

[Act A863] (3) *(Deleted)*.

(4) Where, prior to the coming into force of this Act, an application for a patent has been made under the United Kingdom Patents Act 1977 or an application designating the United Kingdom has been filed at the European Patent Office, the applicant may, within a period of twelve months from the coming into force of this Act, make an application for the grant of a patent under this Act, and such application shall be accorded the filing date and the right of priority which have been accorded to it in the United Kingdom.

FIRST SCHEDULE

(Section 7)

1. Persons disqualified from being appointed members of the Board.

The following persons shall be disqualified from being appointed or being members of the Board:

- (a) a person who is of unsound mind or is otherwise incapable of performing his duties;
- (b) a bankrupt;
- (c) a person who has been convicted of an offence and sentenced to imprisonment for a term of one year or more.

2. When member deemed to have vacated office.

A member of the Board shall be deemed to have vacated his office if he is absent from three consecutive meetings of the Board without the prior approval in writing of the Minister.

3. Quorum and presiding officer.

(1) The Chairman, or any member presiding in the absence of the Chairman, and six other members shall form a quorum at a meeting of the Board.

(2) In the absence of the Chairman, the Deputy Chairman shall preside at a meeting of the Board and in the absence of both of them, the members present shall choose one of their number to preside and such member may exercise all the powers of the Chairman in respect of that meeting.

4. Chairman to have casting vote.

If on any question to be determined there is an equality of votes, the Chairman shall have the casting vote in addition to his deliberative vote.

5. Board to determine its procedure.

Subject to this Act, the Board shall determine its own rules and procedure.

6. Board may appoint committees.

(1) The Board may with the approval of the Minister appoint such committees of its members with or without other persons as it may determine.

(2) Any committee so appointed shall conform to instructions that may from time to time be given to it by the Board and the Board may with the approval of the Minister at any time discontinue or alter the constitution of such committee.

(3) Subject to the directions of the Board, the quorum and procedure of a committee shall be determined by the committee.

SECOND SCHEDULE

(Section 17A)

**MODIFICATIONS TO THE PROVISIONS OF THE ACT
APPLICABLE TO UTILITY INNOVATIONS**

(1)	(2)
Provisions of the Act	Modifications
Section 3	... Substitute “certificate for a utility innovation” and “application for a certificate for a utility innovation” for “patent” and “patent application” respectively in the definition of “right”.
Section 13	... 1. Substitute “utility innovations” for “inventions”. 2. Substitute “eligible for a certificate for a utility innovation” for “patentable”.
Section 14	... Substitute therefor the following: “Novelty. 14. (1) A utility innovation is new to Malaysia if it is not anticipated by prior art. (2) Prior art shall consist of— (a) everything disclosed to the public by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the application for a certificate for a utility innovation claiming the utility innovation;

(1) Provisions of the Act	(2) Modifications
	<p>(b) the contents of a domestic application for a certificate for a utility innovation having an earlier priority date than the application referred to in paragraph (a) to the extent that such contents are included in the certificate for a utility innovation granted on the basis of the said domestic application.</p>
	<p>(3) A disclosure made under paragraph (a) of subsection (2) shall be disregarded—</p>
	<p>(a) if such disclosure occurred within one year preceding the date of the application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title;</p>
	<p>(b) if such disclosure occurred within one year preceding the date of the application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title.”.</p>
<p>PART V ... (except as otherwise provided below)</p>	<ol style="list-style-type: none"> 1. Substitute “certificate for a utility innovation” for “patent”. 2. Substitute “innovator” for “inventor”. 3. Substitute “utility innovation” for “invention”. 4. Substitute “a utility innovation” for “an invention”.

(1) Provisions of the Act	(2) Modifications
Section 19 ...	<p data-bbox="635 320 1046 353">Substitute therefor the following:</p> <p data-bbox="635 383 810 584">“Judicial assignment of application for a utility innovation or a certificate for a utility innovation.</p> <p data-bbox="828 383 1327 450">19. Where the essential elements of the utility innovation claimed in—</p> <p data-bbox="887 472 1327 539">(a) an application for a certificate for a utility innovation; or</p> <p data-bbox="887 562 1327 629">(b) a certificate for a utility innovation,</p> <p data-bbox="828 651 1327 943">have been unlawfully derived from an invention or a utility innovation for which the right to the patent or the certificate for a utility innovation belongs to another person, such other person may apply to the Court for an order that the said application or certificate be assigned to him:</p> <p data-bbox="828 976 1327 1155">Provided that the Court shall not entertain an application for the assignment of a certificate for a utility innovation after three years from the date of the grant of the certificate.”.</p>
PART VI ... (except as otherwise provided below)	<p data-bbox="635 1189 1327 1256">1. Substitute “certificate for a utility innovation” for “patent”.</p> <p data-bbox="635 1301 1158 1335">2. Substitute “innovator” for “inventor”.</p> <p data-bbox="635 1357 1262 1391">3. Substitute “utility innovation” for “invention”.</p> <p data-bbox="635 1413 1327 1480">4. Substitute “an application for a certificate for a utility innovation” for “a patent application”.</p>
Section 28 ...	Substitute “the claim” for “a claim or claims” in paragraph (d) of subsection (1).
Section 29 ...	<i>(Deleted).</i>
Section 31 ...	<p data-bbox="635 1682 935 1715">1. In subsection (2)—</p> <p data-bbox="691 1738 1174 1771">(a) substitute “Board” for “Registrar”;</p> <p data-bbox="691 1794 1142 1827">(b) substitute “the Board” for “he”;</p> <p data-bbox="691 1850 1327 1962">(c) substitute “a certificate for a utility innovation” for “a certificate of grant of the patent and a copy of the patent” in paragraph (a);</p>

(1)
Provisions of the Act

(2)
Modifications

(d) substitute the following paragraph for paragraph (b):

“(b) direct the Registrar to record the certificate for a utility innovation in the Register for Certificates for Utility Innovations.”.

2. In subsection (4), substitute “Board” for “Registrar”.

Section 32 ... 1. Substitute “Register for certificates for Utility Innovations” for “Register of Patents”.

2. Substitute “certificate for utility innovations” for “patents”.

Section 33B ... Substitute “certificate for utility innovation” for “certificate of grant of the patent”.

Section 34 ... Substitute “any application for a certificate for a utility innovation” for “any patent application”.

Section 35 ... Substitute therefor the following:

“Duration of certificate for a utility innovation. 35. (1) Subject and without prejudice to the provisions of this Act, a certificate for a utility innovation shall expire five years after the date of its grant.

(2) Notwithstanding subsection (1), the owner of a certificate for a utility innovation may, before the expiration of the period of five years mentioned in subsection (1), apply for an extension for an additional period of five years and may, before the expiration of the second period of five years, apply for an extension for a further period of five years.

(3) An application for extension under subsection (2) shall be accompanied by an affidavit of the owner of the certificate for the utility innovation showing that the utility innovation is in commercial or industrial use in Malaysia, or satisfactorily explaining its non-use, and shall also be accompanied by the prescribed fee.

(1) Provisions of the Act	(2) Modifications
	(4) Where the owner of a certificate for a utility innovation intends to keep the certificate in force, he shall, twelve months before the date of expiration of the third and each succeeding year during the term of the certificate, pay the prescribed annual fee: Provided, however, that a period of grace of six months shall be allowed after the date of such expiration upon payment of such surcharge as may be prescribed. (5) If the annual fee is not paid in accordance with subsection (4) the certificate for the utility innovation shall lapse, and a notice of the lapsing of the certificate for non-payment of any annual fee shall be published in the <i>Gazette</i> ."
PART VII (except as otherwise provided below)	<p>1. Substitute "certificate for a utility innovation" for "patent".</p> <p>2. Substitute "utility innovation for which a certificate has been granted" for "patented invention".</p> <p>3. Substitute "application for a certificate for a utility innovation" for "patent application".</p> <p>4. Substitute "utility innovation" for "invention".</p>
Section 37	<p>1. In subsection (2)—</p> <p>(a) substitute a full stop for the semicolon at the end of paragraph (iii);</p> <p>(b) delete paragraph (iv).</p> <p>2. Delete ", by the provisions on compulsory licenses as provided in sections 51 and 52" in subsection (5).</p>
Section 38	<p>In subsection (1)—</p> <p>(a) substitute a full stop for the colon at the end of the first proviso;</p> <p>(b) delete the second proviso.</p>

(1) Provisions of the Act	(2) Modifications
PART VIII	<p>... 1. Substitute “An application for a certificate for a utility innovation or a certificate for a utility innovation” for “A patent application or patent”.</p> <p>2. Substitute “an application for a certificate for a utility innovation or a certificate for a utility innovation” for “a patent application or patent”.</p> <p>3. Substitute “the application for a certificate for a utility innovation” for “the patent application”.</p> <p>4. Substitute “certificate for a utility innovation” for “patent”.</p> <p>5. Substitute “utility innovation for which a certificate has been granted” for “patented invention”.</p>
PART IX	<p>... 1. Substitute “certificate for a utility innovation” for “patent”.</p> <p>2. Substitute “utility innovation” for “invention”.</p> <p>3. Substitute “utility innovation for which a certificate has been granted” for “patented invention”.</p> <p>4. Substitute “application for a certificate for a utility innovation” for “patent application”.</p>
PART XI (except as otherwise provided below)	<p>... 1. Substitute “certificate for a utility innovation” for “patent”.</p> <p>2. Substitute “utility innovation” for “invention”.</p>
Section 55	<p>... Delete subsections (2) and (3A).</p>
Section 56	<p>... 1. Substitute the following paragraph for paragraph (a) of subsection (2):</p> <p style="padding-left: 40px;">“(a) that what is claimed as a utility innovation in the certificate for a utility innovation is not a utility innovation within the meaning of section 17 or is excluded from protection under section 13 or subsection (1) of section 31;”.</p> <p>2. Substitute “some parts of a claim, such parts of a claim” for “some of the claims or some parts of a claim, such claims or parts of a claim” in subsection (3).</p>

(1) Provisions of the Act	(2) Modifications
PART XII ... (except as otherwise provided below)	Substitute “certificate for a utility innovation” for “patent”.
Section 59 ...	Substitute “two” for “five” in subsection (3).
Section 61 ...	Substitute the following subsection for subsection (1): “(1) For the purposes of this section, “benefi- ciary” means any licensee unless the licence con- tract provides that the provision of this subsection do not apply or provides different provisions.”.
Section 62 ...	1. Delete “(a)” after “(3)” in subsection (3). 2. Delete paragraph (b) of subsection (3).
PART XIII ... (except as otherwise provided below)	1. Substitute “certificate for a utility innovation” for “patent”. 2. Substitute “product in respect of which a certifi- cate for a utility innovation has been granted” for “patented product”. 3. Substitute “utility innovation” for “invention”.
Section 64 ...	1. Substitute “product or process in respect of which a certificate for a utility innovation has been granted” for “patented product or process” in subsection (1). 2. Delete ‘the word “patent” or “patented” or’ in subsection (2).
PART XV ... (except in section 86)	1. Substitute “certificate for a utility innovation” for “patent”. 2. Substitute “utility innovation” for “invention”. 3. Substitute “certificates for utility innovations” for “patents”.
Section 86 ...	Substitute “his certificate for a utility innovation” for “his patent” in subsection (5).

PATENTS REGULATIONS, 1986

ARRANGEMENT OF REGULATIONS

PART I PRELIMINARY

Regulation

1. Citation and commencement.
2. Fees.
3. Forms.

PART II APPLICATION AND PROCEDURE FOR GRANT AND DURATION OF PATENT

4. Interpretation.
5. Application for grant of patent.
6. Name and declaration of inventor.
7. Request for the grant of a patent.
8. Names and addresses.
9. Nationality and residence.
10. Applicant's right to patent.
11. Common representative.
12. Description.
13. Claims.
14. Dependent claims.
15. Drawings.
16. Abstract.
17. Measures, terminology and signs.
18. Physical requirements.
19. Unity of invention.
- 19A. Division of application.
20. Disclosures to be disregarded for prior art purposes.
21. Declaration claiming priority.
22. Copy of earlier application.
23. Corrections in declaration claiming priority.
24. Withdrawal of application.
25. Filing date.
26. Preliminary examination.
27. Request for substantive examination.
- 27A. Request for modified substantive examination.

- 27B. Deferment of filing of request for substantive examination and modified substantive examination.
- 27C. Substantive examination.
- 27D. Modified substantive examination.
- 28. Notification of refusal of application.
- 29. Certificate of grant of patent.
- 30. Contents of patent.
- 31. Register.
- 31A. Request for certified copies of or extract from Register, etc.
- 31B. Amendment of Register.
- 32. Contents of reference to grant of patent published in *Gazette*.
- 33. Annual fees.
- 33A. Reinstatement of lapsed patent.
- 33B. Protection of persons who exploit lapsed patents.
- 33C. Conversion of applications.

PART III RIGHTS OF OWNER OF PATENT

- 34. Application to record assignment or transmission.
- 35. Entry in Register that any person may obtain a licence.
- 36. Request to record particulars of licence contracts.
- 37. Request to record expiry or termination of recorded licence contracts.

PART IV COMPULSORY LICENCES

- 38. Application for compulsory licence.
- 39. Procedure for grant of compulsory licence.
- 40. Notification of the Board's decision.
- 41. Amendment and cancellation of compulsory licence.
- 42. Surrender of compulsory licence.

PART V SURRENDER AND INVALIDATION

- 43. Surrender of patent.
- 44. Invalidation of patent.

PART VI UTILITY INNOVATIONS

- 45. Certificate for a utility innovation.

PART VIA
PATENT AGENTS

- 45A. Interpretation.
- 45B. Representation in proceedings.
- 45C. Registration of patent agents.
- 45D. Examination for patent agents.
- 45E. Renewal of registration of patent agents.
- 45F. Cancellation of registration of patent agents.
- 45G. Board of Examiners of Patent Agents.
- 45H. Setting, assessing and marking of examination questions and answers.

PART VII
MISCELLANEOUS

- 46. Amendment of application.
- 46A. Amendment of patent.
- 47. Hearing.
- 48. *(Deleted)*.
- 49. *(Deleted)*.
- 50. Signatures by partnerships, companies and associations.
- 51. Address for service.
- 52. Service by post.
- 53. Request for extension of time.

SCHEDULES.

PATENTS REGULATIONS, 1986*

In exercise of the powers conferred by section 87 of the Patents Act 1983, the Minister makes the following regulations:

PART I PRELIMINARY

1. Citation and commencement.

These Regulations may be cited as the **Patents Regulations 1986** and shall come into force on the 1st October 1986.

2. Fees.

(1) The fees to be paid in respect of all matters arising under the Act and these Regulations shall be as specified in Schedule I.

(2) The fees shall be paid to the Patents Registration Office by such means and in such manner as the Registrar may direct.

3. Forms.

The forms referred to in these Regulations are those set out in Schedule II.

PART II APPLICATION AND PROCEDURE FOR GRANT AND DURATION OF PATENT

4. Interpretation.

In this Part, unless the context otherwise requires, “application” means an application for the grant of a patent and “applicant” shall be construed accordingly.

5. Application for grant of patent.

- (1) An application shall contain—
- (a) a request for the grant of a patent;
 - (b) a description;
 - (c) a claim or claims;

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- (d) a drawing or drawings, where required; and
- (e) an abstract.

(2) The application shall be filed at the Patent Registration Office.

6. Name and declaration of inventor.

(1) The application shall contain the name and address of the inventor.

(2) An inventor who does not wish to be named in a patent may, by declaration in writing signed by him and submitted to the Registrar, indicate that he does not wish to be so named.

7. Request for the grant of a patent.

(1) A request for the grant of a patent shall be made to the Registrar on Form 1 together with the payment of the prescribed fee.

(2) The title of the invention shall indicate clearly and concisely the subject-matter to which the invention relates.

8. Names and addresses.

Names and addresses given in the application shall in all cases be the full names and addresses.

9. Nationality and residence.

(1) The applicant's nationality shall be indicated by the name of the State of which he is a national or, if the applicant is not a natural person, the name of the State under whose laws it is constituted.

(2) The applicant's residence shall be indicated by the name of the State of which he is a resident.

10. Applicant's right to patent.

(1) Where the applicant is the inventor, the request shall state that fact.

(2) Where the applicant is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent.

11. Common representative.

If an application is submitted by more than one applicant and the applicants have not appointed a patent agent to represent all of them—

- (a) the request shall designate one of the applicants as their common representative; or
- (b) if the request does not designate one of the applicants as their common representative, the applicant first named in the request shall be considered the common representative.

12. Description.

(1) The description shall first state the title of the invention as appearing in the request and shall—

- (a) specify the technical field to which the invention relates;
- (b) indicate the background art which, as far as is known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and wherever possible, cite the documents reflecting such art;
- (c) disclose the invention in such terms that it can be understood and in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person having ordinary skill in the art, and state any advantageous effects of the invention with reference to the background art;
- (d) briefly describe figures in the drawings, if any;
- (e) describe the best mode contemplated by the applicant for carrying out the invention, using examples where appropriate and referring to the drawings, if any; and
- (f) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made and used or, if it can only be used, the way in which it can be used.

(2) The description shall be presented in the manner and order specified in subregulation (1) unless, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more economical presentation.

(3) The description shall not contain drawings.

13. Claims.

(1) The claims shall be clear and concise and fully supported by the description; and the number of the claims shall be reasonable taking into consideration the nature of the invention.

(2) If there are several claims they shall be numbered consecutively in arabic numerals.

(3) Claims shall not contain drawings and shall not, unless necessary, rely, in respect of the technical features of the invention, on references to the description or drawings.

(4) Where the application contains drawings, the technical features mentioned in the claims shall, wherever possible be followed by reference signs relating to such features and placed between parentheses, subject to the following:

- (a) reference signs which do not particularly facilitate quicker understanding of a claim should not be included;
- (b) the same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs.

(5) The claims shall define the invention in terms of the technical features of the invention.

(6) Whenever appropriate, claims shall contain—

- (a) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art;
- (b) a characterizing portion, preceded by the words “characterized in that”, “characterized by”, “wherein the improvement comprises”, or any other words to the same effect stating concisely the technical features which, in combination with the features stated under paragraph (a), it is desired to protect.

14. Dependent claims.

(1) Any claim which includes all the features of one or more other claims (“dependent claim”) shall contain, if possible at the beginning, a reference to the other claim or claims and shall then state the additional features claimed.

(2) (*Deleted*).

(3) A dependent claim shall be construed as including all the limitations contained in the claims to which it refers or, if the dependent claim is a multiple dependent claim, all the limitations contained in the particular claim in relation to which it is considered.

(4) All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most practical way possible.

15. Drawings.

(1) Subject to subregulation (2), drawing shall be required when they are necessary for the understanding of the invention.

(2) Notwithstanding subregulation (1), where the nature of the invention admits of illustration by drawings the applicant may include drawings in the application when filed.

(3) Flow sheets and diagrams shall be considered drawings for the purposes of these Regulations.

16. Abstract.

(1) The abstract shall commence with a title for the invention.

(2) The abstract shall contain—

- (a) a summary of the disclosure as contained in the description and the claims and drawings, if any; and
- (b) where applicable, the chemical formula which, among all the formulae contained in the application, best characterizes the invention.

(3) The summary mentioned in subregulation (2)(a) shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention.

(4) The abstract shall be as concise as the disclosure permits and shall preferably not contain more than one hundred and fifty words.

(5) The abstract shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(6) Each main technical feature mentioned in the abstract and illustrated by a drawing in the application shall be followed by the reference sign used in that drawing placed between parentheses.

(7) The abstract shall not contain drawings but shall be accompanied by the most illustrative of any drawings furnished by the applicant.

(8) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the description, the claims or the drawings.

17. Measures, terminology and signs.

(1) Units of weight and measures shall be expressed in terms of the metric system.

(2) Temperatures shall be expressed in degrees Celsius.

(3) Densities shall be expressed in metric units.

(4) For heat, energy, light, sound, and magnetism, as well as for mathematical formulae and electrical units, the rules of international practice shall be observed.

(5) For chemical formulae, the symbols, atomic weights, and molecular formulae in general use shall be employed.

(6) In general, only such technical terms, signs and symbols as are generally accepted in the field in question should be used.

(7) The terminology and the signs shall be consistent throughout the application.

18. Physical requirements.

(1) Unless provided otherwise, the application and any accompanying statements or documents shall be filed in duplicate, but the Registrar may require that they be filed in more than two copies.

(2) All documents of the application shall be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset and microfilming.

(3) All sheets shall be free from cracks, creases and folds and only one side of each sheet contained in the application shall be used.

(4) All documents of the application shall be on A4 paper (29.7 cm × 21 cm) which shall be strong, white, smooth, non-shiny and durable.

(5) Notwithstanding subregulation (4), the Registrar may accept sheets of sizes other than A4.

(6) The minimum margins of sheets shall be 2 cm.

(7) All sheets shall be numbered at the top of the sheet and in the middle, in consecutive arabic numerals.

(8) The text matter of the application shall be typed or printed in a dark, indelible colour in at least 1½ line spacing, but graphic symbols, chemical or mathematical formulae and certain characters may, if necessary, be hand written or drawn.

(9) In the application, every fifth line of each sheet of the description and the claims shall be numbered in arabic numerals placed to the left of the relevant lines but to the right of the margin.

(10) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes without colouring.

(11) The application and any associated statement or document shall be filed in the national language or in the English language.

19. Unity of invention.

(1) For the purposes of section 26 of the Act, the same patent application may include—

- (a) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for a use of the product; or
- (b) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the process; or
- (c) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for an apparatus or means specifically designed for carrying out the process.

(2) Subject to section 26 of the Act, an application may contain two or more independent claims of the same category which cannot be covered readily by a single generic claim.

(3) Subject to section 26 of the Act, an application may contain a reasonable number of dependent claims claiming specific forms of the invention claimed in an independent claim even when the features of any dependent claim could be considered as constituting in themselves an invention.

19A. Division of application.

For the purposes of section 26B(1) of the Act—

- (a) where an application is divided pursuant to an objection in an Examiner's report made under section 30(1) or 30(2) of the Act for non-compliance with section 26 of the Act, the request for the division of the application shall be made within three months from the date of mailing of such report;
- (b) in any other case, the applicant may, of his own volition, request for the division of the application not later than three months from the date of mailing of the Examiner's first report made under section 30(1) or 30(2) of the Act.

20. Disclosures to be disregarded for prior art purposes.

An applicant shall state in the request or at any other time any disclosure which he is aware of and which in his opinion should be disregarded for prior art purposes under section 14(3) of the Act and shall state the facts in an accompanying statement.

21. Declaration claiming priority.

(1) A declaration claiming priority under section 27(1) of the Act shall state—

- (a) the date of each earlier application;
- (b) subject to subregulation (2), the number of each earlier application;
- (c) subject to subregulation (3), the symbol, if any, of the International Patent Classification which has been allocated to each earlier application;
- (d) the name of the State in which each earlier application was filed or, where the earlier application is a regional or an international application, the name of the State or States for which it was filed; and
- (e) where the earlier application is a regional or an international application, the office with which it was filed.

(2) Where at the time of filing the declaration referred to in subregulation (1) the number of any earlier application is not known, that number shall be furnished within three months from the date on which the application containing the declaration was filed.

(3) When a symbol of the International Patent Classification has not been allocated to the earlier application or had not yet been allocated at the time of filing the declaration referred to in subregulation (1), the applicant shall state this fact in the declaration.

(4) Where the priorities of two or more earlier applications are claimed in accordance with subregulation (1), the information relating to those earlier applications may be included in a single declaration.

(5) *(Deleted).*

22. Copy of earlier application.

(1) Where section 27(2) of the Act applies, the applicant shall furnish the certified copy of each earlier application within three months from the date of the Registrar's request.

(2) Where the copy referred to in subregulation (1) has already been furnished for another application, the applicant may make a reference to that other application.

(3) Where the earlier application referred to in subregulation (1) is in a language other than the national language or the English language, the Registrar may require the applicant to furnish him, within three months from the date of the Registrar's request, with a translation of the earlier application in the national language or in the English language.

23. Corrections in declaration claiming priority.

(1) If the Registrar finds that the requirements of regulations 21 and 22 have not been complied with he shall request the applicant to file the required particulars, documents or corrections within three months from the date of the request.

(2) If the applicant does not comply with the request referred to in subregulation (1), the Registrar shall inform the applicant in writing that the declaration is deemed to be invalid under section 27(4) of the Act and shall state the reasons.

24. Withdrawal of application.

(1) An applicant may withdraw his application by a declaration on Form 2 addressed to the Registrar and signed by the applicant or his agent so authorized for that specific purpose.

(2) In the case of several applicants the declaration referred to in subregulation (1) shall be signed by all the applicants or on behalf of all the applicants by their agent so authorized for that specific purpose.

(3) Where a declaration is signed by an agent, such declaration shall be accompanied by the letter authorizing him to sign the declaration.

25. Filing date.

(1) When the Registrar records the filing date of the application he shall send to the applicant a certificate of filing in the form of a copy of the request with the filing date and application number marked thereon.

(2) The required correction under section 28(2) of the Act shall be filed within three months from the date of the Registrar's request.

(3) Where the Registrar treats the application as invalid in accordance with section 28 (3) of the Act, he shall inform the applicant in writing of the reasons.

(4) The drawings under section 28(4) of the Act shall be furnished within three months from the date of the Registrar's request.

26. Preliminary examination.

(1) The requirements of regulations 5, 6, 7(1), 8, 9, 11, 18 and 51 shall be formal requirements for the purposes of section 29(1) of the Act.

(2) Where section 29(2) of the Act applies, the Registrar shall notify the applicant of his findings and the applicant shall make any observation on such finding or any amendment to the application or both within three months from the date of mailing of the Registrar's notification.

27. Request for substantive examination.

(1) A request for a substantive examination shall be made to the Registrar on Form 5 together with the payment of the prescribed fee within two years from the filing date of the application.

(2) Where an application is divided under regulation 19A more than two years from the filing date of the application, a further request for a substantive examination shall be made at the time of the filing of the request for the division of the application.

(3) A request for a substantive examination shall, where appropriate, be accompanied by—

- (a) information relating to the application number and filing date of any application for a patent or other title of industrial property protection filed with any prescribed industrial property office relating to the same or essentially the same invention as that claimed in the application;
- (b) information relating to the number assigned to a patent or other title of industrial property protection granted for the same or essentially the same invention as that claimed in the application by any prescribed industrial property office;
- (c) the results of any searches or examinations carried out by any prescribed industrial property office relating to the same or essentially the same invention as that claimed in the application.

(4) The Registrar may waive, as he deems fit, any requirement under subregulation (3).

(5) Where an application is deemed to be withdrawn under section 29A(5) of the Act, the Registrar shall inform the applicant in writing of that fact and shall state the reasons therefor.

(6) For the purposes of these Regulations, “prescribed industrial property office” means the Patent Office of Australia, the Patent Office of the United Kingdom, the Patent Office of the United States of America or the European Patent Office, as the case may require, in its capacity as a national office or, where appropriate, as an International Searching Authority or as an International Preliminary Examination Authority under the Patent Cooperation Treaty.

27A. Request for modified substantive examination.

(1) A request for a modified substantive examination shall be made to the Registrar on Form 5A together with the payment of the prescribed fee within two years from the filing date of the application.

(2) Where an application is divided under regulation 19A more than two years from the filing date of the application, a further request for a modified substantive examination shall be made at the time of the filing of the request for the division of the application.

(3) A request for a modified substantive examination shall be accompanied by—

- (a) a certified true copy of the patent or other title of industrial property protection granted to the applicant or his predecessor in title in the prescribed country or under the prescribed treaty or Convention, and where the patent or other title of industrial property protection is not in the English language, a certified translation in the English language thereof;
- (b) where the description, claims or drawings of the invention granted a patent or other title of industrial property protection by the prescribed country or under the prescribed treaty or Convention are not, apart from matters of form, substantially the same as the description, claims or drawings of the invention claimed in the application, the amendments required for the purpose of bringing them into conformity.

(4) Where an application is deemed to be withdrawn under section 29A(5) of the Act, the Registrar shall inform the applicant in writing of that fact and shall state the reasons therefor.

(5) For the purposes of these Regulations—

“prescribed country” means Australia, the United Kingdom or the United States of America, as the case may require;

“prescribed treaty or Convention” means the European Patent Convention.

27B. Deferment of filing of request for substantive examination and modified substantive examination.

(1) A request for a deferment of the filing of a request for a substantive examination under regulation 27 or a modified substantive examination under regulation 27A or a deferment of the provision of information or documents required under regulation 27(3) shall be made to the Registrar on Form 5B.

(2) For the purposes of section 29A(7) of the Act, the maximum period of deferment allowed—

- (a) for the filing of a request under regulation 27, shall be three years from the filing date of the application;
- (b) for the filing of a request under regulation 27A, shall be four years from the filing date of the application;
- (c) for the provision of the information or documents required under regulation 27(3), shall be three years from the filing date of the application.

27c. Substantive examination.

(1) The requirements of sections 13, 14, 15 and 16, Part V, and sections 26, 26A, 26B and 27 of the Act and regulations 7(2), 10, 12 to 17, 21 and 50 shall be substantive requirements for the purposes of section 30(1) of the Act.

(2) For the purpose of determining whether the application complies with the substantive requirements, in particular sections 14 and 15 of the Act, the Examiner shall search such documents as the Registrar deems necessary.

(3) Upon receipt of the Examiner's report under section 30(1)(b) of the Act, the Registrar may request the Examiner to conduct a further search or other investigation to determine whether the requirements of sections 14 and 15 of the Act have been satisfied and subregulation (2) shall apply in relation to such further search or other investigation.

(4) Where section 30(3) of the Act applies, the Registrar shall send a copy of the Examiner's report to the applicant and the applicant shall make any observation on such report or any amendment to the application or both within three months from the date of mailing of the report.

(5) Where the applicant makes any observation on the Examiner's report of any amendment to the application or both within the prescribed period, the Registrar shall refer them to the Examiner who shall report his determination to the Registrar.

(6) Without prejudice to the foregoing provisions the prescribed period for compliance with the substantive requirements shall be five years from the filing date of the application.

27d. Modified substantive examination.

(1) The requirements of sections 13 and 14, Part V, and sections 26A, 26B and 27 of the Act and regulations 10, 21 and 50 shall be substantive requirements for the purposes of section 30(2) of the Act.

(2) In addition, it shall also be a substantive requirement that the description, claims and drawings of the invention claimed in the application, whether as filed or as amended under the Act or these Regulations, apart from matters of form, shall be the same or substantially the same as the description, claims and drawings of the invention granted a patent or other title of industrial property protection by the prescribed country or under the prescribed treaty or Convention.

(3) For the purpose of determining whether the application complies with the substantive requirements, in particular section 14 of the Act, the Examiner shall search such documents as the Registrar deems necessary.

(4) Upon receipt of the Examiner's report under section 30(2)(b) of the Act, the Registrar may request the Examiner to conduct a further search or other investigation to determine whether the requirements of section 14 of the Act have been satisfied and subregulation (3) shall apply in relation to such further search or other investigation.

(5) Where section 30(3) of the Act applies, the Registrar shall send a copy of the Examiner's report to the applicant and the applicant shall make any observation on such report or any amendment to the application or both within three months from the date of mailing of the report.

(6) Where the applicant makes any observation on the Examiner's report or any amendment to the application or both within the prescribed period, the Registrar shall refer them to the Examiner who shall report his determination to the Registrar.

(7) Without prejudice to the foregoing provisions, the prescribed period for compliance with the substantive requirements shall be five years from the filing date of the application.

28. Notification of refusal of application.

Where an application is refused under section 29(2), 30(3), 30(6), 31(1) or 85 of the Act, the Registrar shall notify the applicant in writing of that decision and shall state the reasons therefor.

29. Certificate of grant of patent.

(1) The certificate of the grant of a patent referred to in section 31(2)(a) of the Act shall contain—

- (a) the number of the patent;
- (b) the name and address of the owner of the patent;
- (c) the name of the inventor (except where he has indicated he does not wish to be named);
- (d) the filing date and the priority date, if any, of the application;
- (e) the date of the grant of the patent; and
- (f) the title of the invention.

(2) *(Deleted).*

30. Contents of patent.

The patent granted pursuant to section 31(2) of the Act shall contain—

- (a) the number of the patent;
- (b) the name and address of the owner of the patent;
- (c) the name and address of the inventor (except where he has indicated he does not wish to be named);
- (d) the name and address of the agent, if any;
- (e) the filing date of the application;
- (f) the priority date of the application, if any, and the name of the country or countries in which or for which the earlier application was filed;
- (g) the date of the grant of the patent;
- (h) the title of the invention;
- (i) the symbol of the International Patent Classification;
- (j) the abstract;
- (k) the description;
- (l) the claims; and
- (m) all the drawings, if any.

31. Register.

(1) The Register shall be kept in such form and on such medium as the Registrar may determine.

(2) The Register shall contain the particulars specified in paragraphs (a) to (j) of regulation 30.

31A. Request for certified copies of or extracts from Register, etc.

A request for certified copies or extracts for the purposes of sections 33, 33A(2), 34 and 83A of the Act shall be made to the Registrar on Form 5c together with the payment of the prescribed fee.

31B. Amendment of Register.

(1) A request under section 33B of the Act to amend the Register shall be made to the Registrar on Form 5D together with the payment of the prescribed fee.

(2) The Registrar may require the submission of such information or documents, including a written explanation by the owner of the patent, in support of the request for the amendment.

32. Contents of reference to grant of patent published in *Gazette*.

A reference to the grant of a patent published pursuant to section 31(3)(a) of the Act shall indicate the particulars specified in (a) to (j) of regulation 30 as well as the most illustrative of any drawings.

33. Annual fees.

(1) The prescribed annual fee shall be paid to the Registrar who shall record the payment in the Register.

(2) The lapse of a patent for non-payment of the prescribed annual fee shall be recorded in the Register.

(3) Annual fees paid shall not be refundable.

33A. Reinstatement of lapsed patent.

(1) A request under section 35A(1) of the Act for the reinstatement of a lapsed patent shall be made to the Registrar on Form 5E together with the payment of the prescribed fee.

(2) The Registrar may require the submission of such information or documents, including a written explanation by the person making the request, in support of the request for the reinstatement of the lapsed patent.

(3) Where a case for reinstatement has not been made out to the satisfaction of the Registrar, he shall notify the person making the request in writing of that fact and shall state the reasons therefor and shall give the person making the request an opportunity to be heard.

(4) Upon receipt of a notification under subregulation (3), the person making the request may, within one month from the date of the mailing of the notification, request for a hearing.

(5) Where the Registrar receives a request for a hearing under subregulation (4), he shall give the person making the request an opportunity to present his case and shall thereafter give his decision.

(6) Where no request for a hearing is received within the prescribed period where the person making the request does not appear on the date fixed for the hearing of the request the Registrar shall refuse the request for reinstatement and shall inform the person making the request in writing of that decision.

(7) Where a case for reinstatement has been made out to the satisfaction of the Registrar, he shall notify the person making the request in writing of that fact.

(8) Upon receipt of a notification under subregulation (7), the person making the request shall, within one month from the date of the mailing of the notification, pay to the Registrar all annual fees due and the prescribed surcharge for reinstatement.

(9) The Registrar shall, upon receipt of the annual fees due and the prescribed surcharge for reinstatement, reinstate the patent; and the date of reinstatement shall be recorded in the Register.

33b. Protection of persons who exploit lapsed patents.

(1) Any person who has exploited or taken definite steps, by contract or otherwise, to exploit a patent after it is notified in the *Gazette* that the patent has lapsed and before it is notified in the *Gazette* that the patent has been reinstated may request for a licence to exploit the patented invention.

(2) A request under subregulation (1) shall be made to the Registrar on Form 5F.

(3) A copy of the request shall be served on the owner of the patent.

(4) The Registrar may require the person making the request or the owner of the patent or both to appear before him for the purpose of giving a statement or submitting any document or other information.

(5) The Registrar may, where he is satisfied that a licence to exploit the patented invention should be granted, grant a licence to the person making the request subject to such terms and conditions as the Registrar deems fit and the owner of the patent shall be deemed to have consented to such grant.

(6) The Registrar shall inform the person making the request and the owner of the patent in writing of his decision.

33c. Conversion of applications.

(1) A request under section 17B (3) of the Act to convert an application for a patent into an application for a certificate for a utility innovation or to convert an application for a certificate for a utility innovation into an application for a patent shall be made to the Registrar on Form 5G together with the payment of the prescribed fee.

(2) Where a case for conversion has been made out to the satisfaction of the Registrar, he shall notify the person making the request in writing of that fact.

(3) Upon receipt of a notification under subregulation (2), the person making the request shall, within one month from the date of the mailing of the notification, pay to the Registrar—

- (a) in the case of a request to convert an application for a patent into an application for a certificate for a utility innovation, the prescribed fee payable under regulation 45;
- (b) in the case of a request to convert an application for a certificate for a utility innovation into an application for a patent, the prescribed fee payable under regulation 7.

(4) For the avoidance of doubt it is declared that where an application has been converted in accordance with this regulation, the prescribed fee paid on the original application shall not be refundable.

PART III

RIGHTS OF OWNER OF PATENT

34. Application to record assignment or transmission.

(1) Any application under section 39(2) of the Act to record in the Register the assignment or transmission of a patent application or a patent shall be made to the Registrar on Form 6 together with the payment of the prescribed fee.

(2) The application shall be signed, in the case of an assignment, by or on behalf of the parties to the transfer and, in the case of a transmission, by or on behalf of the person entitled to the patent application or patent.

(3) The application shall be accompanied by documents proving to the satisfaction of the Registrar the change of ownership.

(4) When subregulations (1) to (3) have been complied with, the Registrar shall record the assignment or transmission in the Register.

(5) Where a change in ownership related to a patent, a reference thereto shall also be published in the *Gazette*.

35. Entry in Register that any person may obtain a licence.

(1) An application under section 42(1) of the Act shall be made on Form 7 together with the payment of the prescribed fee.

(2) An application under section 42(6) of the Act shall be made on Form 8 together with the payment of the prescribed fee.

36. Request to record particulars of licence contracts.

A request under section 42(4) of the Act shall be made to the Registrar on Form 9 together with the payment of the prescribed fee.

37. Request to record expiry or termination of recorded licence contracts.

A request under section 47(a) of the Act shall be made to the Registrar on Form 10 together with the payment of the prescribed fee.

PART IV**COMPULSORY LICENCES****38. Application for compulsory licence.**

An application under sections 49 and 49A of the Act shall be made to the Registrar on Form 11 together with the payment of the prescribed fee.

39. Procedure for grant of compulsory licence.

(1) The Registrar shall, within three months from the date of the application, examine whether the requirements of section 50(1) of the Act and regulation 38 are satisfied and, if the requirements are satisfied, send a copy of the application to the licensor and licensee and invite the licensor or licensee, as the case may be, to make any observations.

(2) The Registrar shall give the notice required by section 50(2) of the Act, in writing, not later than three months before the date set for the Board to consider the application.

40. Notification of the Board's decision.

(1) The Registrar shall notify in writing any party required to appear before the Board under section 51(1) of the Act not later than one month before the date set for the appearance.

(2) Within one month from the date the Board makes its decision, the Registrar shall notify the applicant, the licensor or the licensee, as the case may be, of the decision and shall record the decision in the Register setting out the following particulars:

- (a) the name and address of the applicant;
- (b) the date of filing of the application;
- (c) the applicable statutory provision under which the application was made;
- (d) the title of the patented invention;
- (e) the number and date of the grant of the patent in question;
- (f) the date and nature of the decision; and
- (g) if a compulsory licence was granted, the particulars referred to in section 52 of the Act.

(3) The Registrar shall publish the decision of the Board under section 51(1) of the Act in the *Gazette* setting out the particulars mentioned in paragraphs (a) to (f) of subregulation (2).

41. Amendment and cancellation of compulsory licence.

(1) The request under section 54(1) of the Act to amend the decision granting a compulsory licence shall be made to the Registrar on Form 12 together with the payment of the prescribed fee.

(2) The request under section 54(2) of the Act to cancel a compulsory licence shall be made to the Registrar on Form 13 together with the payment of the prescribed fee.

(3) The procedure set out in sections 50 and 51 of the Act and in regulations 38, 39 and 40 shall apply, to the extent relevant, for amending or cancelling a compulsory licence.

42. Surrender of compulsory licence.

(1) The written declaration of surrender of a compulsory licence under section 54 (3) of the Act shall be accompanied by the payment of the prescribed fee.

(2) The Registrar shall record the surrender in the Register and notify the owner of the patent as required by section 54(3) within one month from the date of receipt of the declaration of surrender.

(3) The Registrar shall publish the surrender as required by section 54(3) of the Act in the *Gazette*.

PART V

SURRENDER AND INVALIDATION

43. Surrender of patent.

The written declaration of surrender of a patent under section 55(1) of the Act shall be accompanied by the payment of the prescribed fee.

44. Invalidation of patent.

(1) The owner of the patent shall notify any licensees of any proceedings brought under section 56 of the Act.

(2) The person requesting the invalidation shall notify any beneficiaries of compulsory licences of any proceedings brought under section 56 of the Act.

PART VI

UTILITY INNOVATIONS

45. Certificate for a utility innovation.

(1) An application for the grant of a certificate for a utility innovation under Part IVA of the Act shall be made to the Registrar on Form 14 together with the payment of the prescribed fee.

(2) An application to extend the term of a certificate for a utility innovation shall be made to the Registrar on Form 15 together with the payment of the prescribed fee.

(3) The provisions of these Regulations, except regulation 19 and Part IV, shall apply to utility innovations to the extent relevant.

- (4) In the forms made applicable to utility innovations under subregulation (3), “certificate” means a certificate for a utility innovation.

PART VIA

PATENT AGENTS

45A. Interpretation.

In this Part, unless the context otherwise requires—

“Board of Examiners” means the board of Examiners of Patent Agents established under regulation 45G;

“Secretary-General” means the Secretary-General of the Ministry charged with the responsibility for the development of industrial property.

45B. Representation in proceedings.

(1) Unless the Act or any regulation made thereunder otherwise prescribes, or the Registrar otherwise directs, any person may be represented in proceedings before the Patent Registration Office by a patent agent who may attend, file documents and sign documents on that person's behalf.

(2) The appointment or change of a patent agent shall be made on Form 17, signed by the person or persons to be represented by the agent and submitted to the Registrar.

45C. Registration of patent agents.

(1) An application to be registered as a patent agent in the Register of Patents Agents shall be made to the Registrar on Form 18 together with the payment of the prescribed fee.

(2) In order to be registered in the Register of Patents Agents, the applicant shall satisfy the Registrar—

- (a) that he is domiciled in or is a permanent resident of Malaysia;
- (b) that he is an advocate and solicitor of the High Court in Malaya or an advocate of the High Court in Sabah and Sarawak, or has a relevant degree or its equivalent in an appropriate branch or engineering or science from an institution of higher learning approved by the Board of Examiners, or has qualifications entitling him to graduate membership of a professional engineering or scientific institution or the like recognized by the Board of Examiners; and
- (c) that he has passed the examination specified in regulation 45D.

(3) The Registrar may, at any time, require proof of the matters specified in paragraphs (a), (b) and (c) of subregulation (2).

(4) The Registrar may refuse to register any person who has been convicted of an offence involving fraud or dishonesty.

(5) The Registrar, upon being satisfied that the applicant qualifies to be registered in the Register of Patents Agents, shall register the applicant for a term expiring on the 31st December of that year.

45D. Examination for patent agents.

(1) For the purposes of regulation 42c(2)(c), the board of Examiners shall conduct an examination which shall consist of the following subjects:

- (a) technology;
- (b) Malaysian patent law and practice;
- (c) Malaysian trade mark and designs law and practice; and
- (d) foreign industrial property law and practice.

(2) An application for registration as a candidate for the examination specified in subregulation (1) shall be made to the Board of Examiners on Form 18A together with the payment of the prescribed fee.

(3) An application under subregulation (2) shall be sent to the Secretary to the Board of Examiners at the Patent Registration Office on or before the date determined by the board of Examiners for the submission of such applications.

(4) A candidate shall be required to sit for each of the subjects specified in subregulation (1) at a sitting of the examination.

(5) A candidate who has sat for and failed to pass any of the subjects specified in subregulation (1) may, if he is dissatisfied with his results, appeal to the Secretary-General for re-scrutiny of the results within fourteen days from the date of the notification of such results together with the payment of the prescribed fee.

(6) Upon receipt of an appeal under subregulation (5), the Secretary-General shall consider the appeal and make a decision thereon.

(7) The decision of the Secretary-General shall be final and conclusive.

(8) A candidate who has sat for and failed to pass any or all of the subjects specified in subregulation (1) at an examination may apply to re-sit such subject or subjects, as the case may be, at the next sitting of the examination and such application shall be made to the Board of Examiners on Form 18B together with the payment of the prescribed fee.

(9) Any candidate who has failed to pass all of the subjects specified in subregulation (1) after three attempts shall be deemed to have failed the overall examination and subregulations (5), (6), (7) and (8) shall not apply thereto.

(10) Any candidate who is deemed to have failed the overall examination under subregulation (9) may re-apply to be registered as a candidate under subregulation (2).

45E. Renewal of registration of patent agents.

(1) An application for the renewal of registration as a patent agent shall be made to the Registrar on Form 19 together with the payment of the prescribed fee by the 31st January of each year:

Provided that in the case of a person who immediately before the date of coming into force of this regulation was registered as a patent agent the application for the renewal of registration as a patent agent shall be made within thirty days of the expiry of the registration.

(2) The Registrar shall, upon being satisfied that the conditions specified in regulation 45c continue to be satisfied, renew the registration of the patent agent for a term expiring on the 31st December of that year:

Provided that a person who immediately before the date of coming into force of this regulation was registered as a patent agent shall be deemed to have satisfied the conditions specified in regulation 45c (2)(c).

(3) Notwithstanding subregulation (2), the Registrar may refuse to renew the registration of any person who has been convicted of an offence involving fraud or dishonesty.

45f. Cancellation of registration of patent agents.

(1) The Registrar may cancel the registration of any person who has been convicted of an offence involving fraud or dishonesty.

(2) Where the registration of any person is cancelled under this regulation no fees paid for the purpose of registration or renewal of registration shall be refundable.

45g. Board of Examiners of Patent Agents.

(1) There is established a Board of Examiners of Patent Agents which shall consist of—

- (a) the Registrar of Patents, who shall be Chairman; and
- (b) four other persons proficient in the field of industrial property appointed by the Secretary-General.

(2) An officer of the Patent Registration Office shall be Secretary to the Board of Examiners.

(3) A member of the Board of Examiners appointed under subregulation (1)(b) shall, unless his appointment is sooner revoked or he sooner resigns, hold office for such period not exceeding three years as the Secretary-General may determine and shall be eligible for reappointment.

(4) At a meeting of the Board of Examiners three members shall form a quorum.

(5) In the absence of the Chairman, a member nominated by the Chairman shall preside at the meeting and such member may exercise all the powers of the Chairman in respect of that meeting.

(6) If on any question to be determined there is an equality of votes, the Chairman shall have the casting vote in addition to his deliberative vote.

(7) The Board of Examiners shall be responsible for—

- (a) the conduct of the examination specified in regulation 45d;
- (b) preparing and publishing the examination syllabus and determining the study material to be recommended;
- (c) preparing examination papers;
- (d) registering and admitting candidates;

- (e) determining the time, date and place for the examination;
- (f) awarding certificates; and
- (g) advising the Registrar as to the persons who have satisfied the requirements of paragraphs (b) and (c) of subregulation 45c(2).

(8) The Board of Examiners shall enjoy the prerogative of awarding and withdrawing certificates, withholding and cancelling the results of any candidate, and barring any person from taking the examination.

45H. Setting, assessing and marking of examination questions and answers.

(1) The Board of Examiners may appoint suitably qualified persons to be examiners for the purpose of setting, assessing and marking questions or answers for the examination specified in regulation 45D.

(2) The Board of Examiners may give such instructions in relation to the setting, assessing and marking of questions or answers as it considers necessary.

(3) The examiners appointed under subregulation (1) shall be paid such allowances as the Minister may direct.

PART VII
MISCELLANEOUS

46. Amendment of application.

A request under section 79(1) of the Act to correct a clerical error or obvious mistake in an application for the grant of a patent shall be made to the Registrar on Form 16 together with the payment of the prescribed fee.

46A. Amendment of patent.

A request under section 79A(1) of the Act to correct a clerical error or obvious mistake in a patent or any other document associated with the patent, or to amend a patent or any other document associated with the patent for any other reason shall be made to the Registrar on Form 16A together with the payment of the prescribed fee.

47. Hearing.

(1) The Registrar shall give the person entitled to a hearing pursuant to section 81 of the Act not less than one month's notice of the date of hearing.

(2) Within twenty-one days of the date of the notice, the person notified shall inform the Registrar whether he desires to be heard.

(3) If the person notified fails to inform the Registrar within twenty-one days of his desire to be heard, the Registrar may proceed to exercise his power in the absence of such person.

(4) The Registrar may invite an Examiner to assist him in the hearing.

48. *(Deleted)*.

49. *(Deleted)*.

50. Signatures by partnerships, companies and associations.

(1) A document purporting to be signed for or on behalf of a partnership shall contain the names of all the partners in full and shall be signed—

- (a) by all the partners; or
- (b) by any qualified partner stating that he signs on behalf of the partnership; or
- (c) by any other person who satisfies the Registrar that he is authorized to sign the document.

(2) A document purporting to be signed for or on behalf of a body corporate shall be signed—

- (a) by a director or the secretary or other principal officer of the body corporate; or
- (b) by any other person who satisfies the Registrar that he is authorized to sign the document.

(3) A document purporting to be signed for or on behalf of an association of persons may be signed by any person who appears to the Registrar to be duly qualified.

51. Address for service.

(1) Every person concerned with any proceedings under the Act or any regulation made thereunder and every owner of a patent shall furnish to the Registrar, on Form 20 together with the payment of the prescribed fee, an address for service in Malaysia, which may be treated for all purposes concerning or connected with such proceedings or patent as the address of the person concerned.

(2) Notwithstanding subregulation (1), where a patent agent has been appointed, the address for service shall be the address of the patent agent.

(3) The furnishing of Form 20 is not required if the address for service has already been furnished in any other Form in Schedule II to these Regulations, and that address for service has not changed in any way.

52. Service by post.

(1) Any notice, application or other document sent to the Registrar by post shall be deemed to have been given, made or filed at the time when it would have been delivered in the ordinary course of the post.

(2) For the purpose of proving that a notice, application or other document has been sent to the Registrar by post, it shall be sufficient to prove that the letter containing such notice, application, or other document was addressed and sent by registered post.

53. Request for extension of time.

A request under section 82 of the Act shall be made to the Registrar on Form 21 together with the payment of the prescribed fee.

SCHEDULE I
(Regulation 2(2))

FEES
PART I

(1) <i>Item No.</i>	(2) <i>Matter/ Proceeding</i>	(3) <i>Fee (RM)</i>	(4) <i>Corresponding Form</i>
1.	(a) Request for grant of patent	200.00	Form 1
	(b) Claims		
	(i) for first ten claims	Nil	
	(ii) for every additional claim	10.00 per claim	
2.	Declaration of withdrawal of application	—	Form 2
3.	Request for substantive examination	700.00	Form 5
4.	Request for modified substantive examination	450.00	Form 5A
5.	Request for deferment of filing of request for examination or provision of information	—	Form 5B
6.	Request for certified copies or extracts	50.00	Form 5c
7.	Request to amend Register	50.00	Form 5D
8.	Request for reinstatement of lapsed patent	100.00	Form 5E
9.	Request for licence to exploit patented invention	—	Form 5F
10.	Request to convert application for patent into application for certificate for utility innovation or <i>vice versa</i>	200.00	Form 5G
11.	Application for recording of assignment or transmission	100.00	Form 6
12.	Application for entry in Register that any person may obtain a licence	50.00	Form 7
13.	Application for cancellation of entry in Register that any person may obtain a licence	50.00	Form 8
14.	Request for recording of particulars of licence contract in Register	100.00	Form 9
15.	Request for recording expiry or termination of licence contract in Register	75.00	Form 10
16.	Application for compulsory licence	75.00	Form 11
17.	Request for amendment of decision granting compulsory licence	75.00	Form 12
18.	Request for cancellation of compulsory licence	75.00	Form 13
19.	Application for grant of certificate for utility innovation	100.00	Form 14
20.	Application to extend term of certificate for utility innovation	100.00	Form 15
21.	Request to amend application for grant of patent	50.00	Form 16
22.	Request to amend patent	50.00	Form 16A

<i>(1)</i> <i>Item</i> <i>No.</i>	<i>(2)</i> <i>Matter/ Proceeding</i>	<i>(3)</i> <i>Fee</i> <i>(RM)</i>	<i>(4)</i> <i>Corresponding</i> <i>Form</i>
23.	Appointment or change of patent agent	—	Form 17
24.	Application for registration of patent agent	2000.00	Form 18
25.	Application for registration as candidate for examination	100.00	Form 18A
26.	Application to re-sit examination	100.00	Form 18B
27.	Examination fee	100.00 per subject	
28.	Application for renewal of registration of patent agent	400.00	Form 19
29.	Furnishment of address for service	100.00	Form 20
30.	Request for extension of time	200.00	Form 21

PART II

<i>(1)</i> <i>Item</i> <i>No.</i>	<i>(2)</i> <i>Matter/ Proceeding</i>	<i>(3)</i> <i>Fee</i> <i>(RM)</i>
1.	Copy of patent	30.00
2.	Copy of search report	20.00
3.	Examination of Register	10.00 per hour
4.	Certified extract from Register	10.00 per page
5.	Photocopy of extract from Register	2.00 per page
6.	Inspection of file relating to patent or patent application	10.00 per hour
7.	Certified extracts from file relating to patent or patent application—	
	(a) for first five pages	10.00 per page
	(b) for every additional page	2.00 per page
8.	Annual fee for patent:	
	(a) for second year	200.00
	(b) for third year	250.00
	(c) for fourth year	300.00
	(d) for fifth year	350.00
	(e) for sixth year	400.00
	(f) for seventh year	450.00
	(g) for eighth year	500.00
	(h) for ninth year	550.00
	(i) for tenth year	600.00
	(j) for eleventh year	650.00
	(k) for twelfth year	700.00
	(l) for thirteenth year	800.00
	(m) for fourteenth year	900.00
	(n) for fifteenth year	1100.00
9.	Surcharge for reinstatement	100% of fee for year concerned

(1) Item No.	(2) Matter/ Proceeding	(3) Fee (RM)
10.	Surrender of compulsory licence	60.00
11.	Surrender of patent	60.00
12.	Annual fee for certificate for utility innovation:	
	(a) for third year	120.00
	(b) for fourth year	160.00
	(c) for fifth year	160.00
	(d) for sixth year	200.00
	(e) for seventh year	200.00
	(f) for eighth year	240.00
	(g) for ninth year	240.00
	(h) for tenth year	280.00
	(i) for eleventh year	400.00
	(j) for twelfth year	600.00
	(k) for thirteenth year	700.00
	(l) for fourteenth year	800.00
	(m) for fifteenth year	1000.00
13.	Holding of hearing	100.00
14.	Certificate of grant of a patent	150.00
15.	Certificate for a utility innovation	100.00
16.	Appeal against examination results	200.00 per subject
17.	Extension of time (for every month or part of a month)	50.00 per month

SCHEDULE
(Regulation 29)

FORMS

Patents Form No. 1 Patents Act 1983 REQUEST FOR GRANT OF PATENT (Regulation 7(1)) To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia	<p style="text-align: center;">For Official Use</p> Application received on: Fee received on: Amount: •Cheque/Postal Order/Money Order/Draft/Cash No.:
Please submit this Form in duplicate together with the prescribed fee.	Applicant's file reference

THE APPLICANT (S) REQUEST (S) THE GRANT OF A PATENT IN RESPECT OF THE FOLLOWING PARTICULARS:

I. Title of Invention:

* Delete whichever does not apply.

II. APPLICATION(S) (the data concerning each applicant must appear in this box or, if the space is insufficient, in the space below):

Name:

I.C./Passport No:

Address:

Address for service in Malaysia:

Nationality:

* Permanent residence or principal place of business:

.....

Telephone Number
(if any)

Fax Number
(if any)

.....

Additional Information (if any)

III. INVENTOR:

Applicant is the inventor

Yes ☐

No ☐

If the applicant is not the inventor:

Name of inventor:

Address of inventor:

A statement justifying the applicant's right to the patent accompanies this Form:

Yes ☐

No ☐

Additional Information (if any)

IV. AGENT OR REPRESENTATIVE:

Applicant has appointed a patent agent in accompanying Form
No. 17

Yes ☐

No ☐

Agent's Registration No.:

Applicants have appointed
to be their common representative.

* Delete whichever does not apply.

V. DIVISIONAL APPLICATION:

This application is a divisional application ☐

The benefit of the filing date ☐ priority date ☐

of the initial application is claimed in as much as the subject-matter of the present application is contained in the initial application identified below:

Initial Application No.:

Date of filing of initial application:

VI. DISCLOSURES TO BE DISREGARDED FOR PRIOR ART PURPOSES:

Additional information is contained in supplemental box:

(a) Disclosure was due to acts of applicant or his predecessor in title ☐

Date of disclosure:

(b) Disclosure was due to abuse of rights of applicant or his predecessor in title ☐

Date of disclosure:

A statement specifying in more detail the facts concerning the disclosure accompanies this Form Yes ☐
No ☐

Additional Information (if any)

VII. PRIORITY CLAIM (if any):

The priority of an earlier application is claimed as follows:

Country (if the earlier application is a regional or international application, indicate the office with which it is filed):

.....

Filing Date:

Application No.:

Symbol of the International Patent Classification:

If not yet allocated, please tick ☐

The priority of more than one earlier application is claimed:

Yes ☐ No ☐

The certified copy of the earlier application (s) accompanies this Form:

Yes ☐ No ☐

If No, it will be furnished by (date)

Additional Information (if any)

VIII. CHECK LIST:

A. This application contains the following:

1. request
2. descriptionsheets
3. claimsheets
4. abstractsheets
5. drawingssheets
- Totalsheets

B. This Form, as filed, is accompanied by the items checked below:

- (a) signed Form No. 17 ☐
- (b) declaration that inventor does not wish to be named in the patent ☐
- (c) statement justifying applicant's right to the patent ☐
- (d) statement that certain disclosures be disregarded ☐
- (e) priority document (certified copy of earlier application) ☐
- (f) cash, cheque, money order, banker's draft or postal order for the payment of application fee ☐
- (g) other documents (specify) ☐

IX. SIGNATURE.....

**(Applicant/Agent)

(Date)

If Agent, indicate Agent's Registration No. :.....

For Official Use

1. Date application received :.....
2. Date of receipt of correction, later filed papers or drawings completing the application:

<p>Patents Form No. 2 PATENTS ACT 1983</p> <p>DECLARATION OF WITHDRAWAL OF APPLICATION (Regulations 24 and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No:</p> <p>Filing Date:</p> <p>Declaration received on:</p> <p>Date of mailing:</p>
<p>Please submit this Form in duplicate.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent Application No.: Filing Date:

Certificate Application No.: Filing Date:

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

II. APPLICANT (s):

Name :

Address :

.....

III. DECLARATION:

* I/We declare *my/our desire that the above-identified application be withdrawn under section 25 of the Patents Act 1983.

IV. SIGNATURE.....

** (Applicant/Agent)

(Date)

If Agent, indicate Agent's Registration No:

<p>Patents Form No. 5 PATENTS ACT 1983</p> <p>REQUEST FOR SUBSTANTIVE EXAMINATION (Regulations 27(1) and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>*Cheque/Postal Order/Money Order/Draft/Cash No.:</p> <p>Date of mailing:</p>
<p>Please submit this Form in duplicate together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent Application No.: Filing Date:

Certificate Application No.: Filing Date:

II. APPLICANT (s):

Name :

Address :

.....

III. REQUEST:

The applicant (s) request (s) the Registrar to refer the patent application identified above to an Examiner for a substantive examination in accordance with section 29A(1) of the Patents Act 1983.

* Delete whichever does not apply.

** Type name under signature. Pursuant to regulation 24, a declaration of withdrawal must be signed by the applicant (s) or by the agent so authorized for that specific purpose.

IV. ADDITIONAL INFORMATION accompanies this Form:

Yes

☐

No

☐

IV. SIGNATURE.....

** (Applicant/Agent)

(Date)

If Agent, indicate Agent's Registration No:

Patents Form No. 5A PATENTS ACT 1983 REQUEST FOR MODIFIED SUBSTANTIVE EXAMINATION (Regulations 27A(1) and 45(3)) To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia	For Official Use APPLICATION NO.: Filing Date: Request received on: Fee received on: Amount: *Cheque/Postal Order/Money Order/Draft/Cash No.:
Please submit this Form in duplicate together with the prescribed fee.	Applicant's or Agent's file reference

I. IN THE MATTER OF:

Patent Application No.: Filing Date:

Certificate Application No.: Filing Date:

II. APPLICANT (s):

Name :

Address :

III. REQUEST:

The applicant (s) request (s) the Registrar to refer the patent application identified above to an Examiner for a modified substantive examination in accordance with section 29A(2) of the Patents Act 1983.

IV. PRESCRIBED FOREIGN PATENT:

I provide herewith a certified copy of the specification of Patent No.:

granted in on

Copy of granted patent from: * UK/US/EP/Australia

* Delete whichever does not apply.

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

V. AMENDMENTS:

Amendments in accordance with regulation 27A(3)(b) accompany this form.

Yes

☐

No

☐

VI. SIGNATURE.....

** (Applicant/Agent)

(Date)

If Agent, indicate Agent's Registration No:

Patents Form No. 5b
PATENTS ACT 1983REQUEST FOR DEFERMENT OF FILING OF REQUEST
FOR EXAMINATION OR PROVISION OF INFORMATION
(Regulations 27B(1) and 45(3))To: The Registrar of Patents
Patent Registration Office
Kuala Lumpur
Malaysia

For Official Use

APPLICATION No.:

Filing Date:

Request received on:

Please submit this Form in duplicate.

Applicant's or Agent's file reference

.....

I. IN THE MATTER OF:

Patent Application No.: Filing Date:

Certificate Application No.: Filing Date:

II. APPLICANT (s):

Name :

Address :

.....

III. REQUEST:

*(a) The applicant requests deferment of the filing of a request for examination referred to in
section 29A(1) or 29A(2) of the Patents Act 1983.Particulars of the *patent/certificate application for essentially the same invention referred
to in section 29A(2) of the Patents Act 1983 are as follows:

Name of Country:

Application No.:

* Delete whichever does not apply.

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

Date Application Lodged:

I certify that a *patent/certificate has not been granted in or
is not available in respect of the above application.

or

- (b) The applicant requests deferment of the provision of the *information/supporting document referred to in section 29A(4) of the Patents Act 1983.

I certify that the *information/supporting document is not available in respect of the above application.

IV. ADDITIONAL INFORMATION accompanies this Form:

Yes

☐

No

☐

V. SIGNATURE.....

** (Applicant/Agent)

(Date)

If Agent, indicate Agent's Registration No:

<p>Patents Form No. 5c PATENTS ACT 1983</p> <p>REQUEST FOR CERTIFIED COPIES OR EXTRACTS (Regulations 31A and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>*Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. APPLICANT:

Name :

Address :

II. REQUEST:

The applicant requests the Registrar to issue a certified copy/extract of the matter specified below in accordance with section 33/33A(2)/34/83A of the Patents Act 1983:

.....
.....

III. SIGNATURE.....

** (Applicant/Agent)

(Date)

If Agent, indicate Agent's Registration No:

* Delete whichever does not apply.

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

<p>Patents Form No. 5D PATENTS ACT 1983</p> <p>REQUEST TO AMEND REGISTER (Regulations 31b (1) and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>*Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit this Form in duplicate together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent No.: Date of Grant:

Certificate No.: Date of Grant:

II. OWNER (s):

Name :

Address :

.....

III. REQUEST:

The owner (s) request (s) the Registrar to amend the Register in accordance with section 33B of the Patents Act 1983 by—

*(a) correcting an error in the *name/address of the owner (s); or

(b) changing the *name/address of the owner (s)

in respect of the above identified *patent/certificate.

IV. * CORRECTED/CHANGED * NAME/ADDRESS OF OWNER (s):

Name :

Address :

.....

V. SIGNATURE.....

** (Owner (s)/Agent)

(Date)

If Agent, indicate Agent's Registration No:

* Delete whichever does not apply.

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

<p>Patents Form No. 5e PATENTS ACT 1983</p> <p>REQUEST FOR REINSTATEMENT OF Lapsed PATENT (Regulations 33A (1) and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Surcharge received on:</p> <p>Amount:</p> <p>Annual fees due received on:</p> <p>*Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit this Form in duplicate together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent No.: Date of Grant:

Certificate No.: Date of Grant:

II. OWNER (s):

Name :

Address :

.....

III. REQUEST:

The owner (s) request (s) the Registrar to reinstate the *patent/certificate identified above in
accordance with section 35A of the Patents Act 1983.

IV. EVIDENCE IN SUPPORT accompanies this Form:

Yes ☐ No ☐

V. SIGNATURE..... (Date)

**(Owner (s)/Agent)

If Agent, indicate Agent's Registration No:

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

<p>Patents Form No. 5F PATENTS ACT 1983</p> <p>REQUEST FOR LICENCE TO EXPLOIT PATENTED INVENTION (Regulations 33B(2) and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Application received on:</p>
<p>Please submit this Form in duplicate.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent No.: Date of Grant:

Certificate No.: Date of Grant:

Date of Reinstatement of * Patent/
Certificate:
.....

II. OWNER (S):

Name :

Address :

.....

III. REQUEST:

The applicant applies to the Registrar for a licence under the *patent/certificate identified above in accordance with regulation 33B of the Patents Regulations 1986.

IV. ADDITIONAL INFORMATION accompanies this Form:

Yes ☐ No ☐

V. A COPY OF THIS REQUEST HAS BEEN SERVED ON THE OWNER (S) IDENTIFIED ABOVE:

Yes ☐ No ☐

VI. SIGNATURE.....

.....
(Date)

(** (Applicant(s)/Agent)

If Agent, indicate Agent's Registration No.:

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

<p>Patents Form No. 5G PATENTS ACT 1983</p> <p>REQUEST TO CONVERT APPLICATION FOR PATENT INTO APPLICATION FOR CERTIFICATE FOR UTILITY INNOVATION OR <i>VICE VERSA</i> (Regulations 33c and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION NO.:</p> <p>Filing Date:</p> <p>Application received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>*Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit this Form in duplicate together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

*Patent/Certificate

Application No.: Filing Date:.....

II. APPLICANT (S):

Name :

Address :

III. REQUEST:

The applicant applies to the Registrar for the conversion of the *patent/certificate application identified above into an application for a *certificate for a utility innovation/patent in accordance with section 17B(3) of the Patents Act 1983.

IV. SIGNATURE.....

(Date)

(**(Applicant/Agent)

If Agent, indicate Agent's Registration No.:

* Delete which does not apply.

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

<p>Patents Form No. 6 PATENTS ACT 1983</p> <p>APPLICATION FOR RECORDING OF ASSIGNMENT OR TRANSMISSION (Regulations 34(1) and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Application received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit this Form in duplicate together with the prescribed fee.</p>	<p>Date of mailing:</p> <p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

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

II. *APPLICANT (S)/OWNER (S):

Name :

Address :

III. APPLICATION:

The new *applicant(s)/new owner(s) below *applies/apply to the Registrar to record the *assignment/transmission of the above identified *patent application/patent/certificate application/certificate.

IV. *NEW APPLICANT (S)/NEW OWNER (S):

Name :

Address :

Address for service in Malaysia:

Nationality:

* Permanent residence or principal place of business:

.....

Telephone Number
(if any)

Fax Number
(if any)

V. ADDITIONAL INFORMATION:

The following items accompany this Form:

- (a) the original or a certified copy of the assignment signed by or on behalf of the contracting parties
- (b) other documents evidencing the change of ownership (specify)
- (c) other (specify)

VI. SIGNATURE..... (Date)

***(New Applicant/New Owner/
Agent for New Applicant
or New Owner)*

If Agent, indicate Agent's Registration No.:.....

(in case of assignment).....

***(Applicant/Owner/
Agent for Applicant of Owner)* (Date)

If Agent, indicate Agent's Registration No.:

Patents Form No. 7
PATENTS ACT 1983

APPLICATION FOR ENTRY IN REGISTER THAT
ANY PERSON MAY OBTAIN A LICENCE
(Regulations 35(1) and 45(3))

To: The Registrar of Patents
Patent Registration Office
Kuala Lumpur
Malaysia

For Official Use

APPLICATION No.:
Filing Date:
Application received on:
Fee received on:
Amount:
*Cheque/Postal Order/Money Order/Draft/Cash
No.:

Date of mailing:

Please submit one copy of this Form
together with the prescribed fee.

Applicant's or Agent's file reference
.....

I. IN THE MATTER OF :

Patent No.: Date of Grant :

Certificate No. : Date of Grant :

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

II. * PATENT/CERTIFICATE OWNER (s):

Name :

Address :

.....

III. APPLICATION:

The *patent/certificate owner (s) *applies/apply to the Registrar for an entry to be made in the Register to the effect that any person may obtain a licence under the *patent/certificate identified above. (The *patent/certificate owner (s) *is/are not precluded by contract from granting licences under the *patent/certificate).

IV. ADDITIONAL INFORMATION accompanies this Form :

Yes ☐No ☐

V. SIGNATURE

(Date)

**(Applicant/Agent)

If Agent, indicate Agent's Registration No.:

<p>Patents Form No. 8 PATENTS ACT 1983</p> <p>APPLICATION FOR CANCELLATION OF ENTRY IN REGISTER THAT ANY PERSON MAY OBTAIN A LICENCE (Regulations 35(2) and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION NO.:</p> <p>Filing Date:</p> <p>Application received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>*Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Date of mailing:</p> <p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF :

Patent No. : Date of Grant :

Certificate No. : Date of Grant :

* Delete whichever does not apply.

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

II. LICENSOR:

Name :
 Address :

III. APPLICATION:

The licensor applies to the Registrar for the cancellation of the entry made that any person may obtain a licence.

IV. ADDITIONAL INFORMATION accompanies this Form:

Yes ☐No ☐

V. SIGNATURE..... (Date)

**(Licensor/Agent)

If Agent, indicate Agent's Registration No.:

<p>Patents Form No. 9 PATENTS ACT 1983</p> <p>REQUEST FOR RECORDING OF PARTICULARS OF LICENCE CONTRACT IN REGISTER</p> <p>(Regulations 36 and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p> <p>Date of mailing:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference </p>

I. IN THE MATTER OF :

Patent No. : Date of Grant:

Certificate No. : Date of Grant:

and the licence contract relating thereto.

II. LICENSOR:

Name :
 Address :

* Delete whichever does not apply.

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

III. LICENSEE:

Name :
 Address :

IV. REQUEST:

The above parties request the Registrar to record in the Register the following particulars relating to the licence contract:

.....

V. ADDITIONAL INFORMATION accompanies this Form:

Yes ☐No ☐

VI. SIGNATURE..... (Date)

***(Licensor/Agent for Licensor)*

If Agent, indicate Agent's Registration No.:

..... (Date)

***(Licensee/Agent for Licensee)*

If Agent, indicate Agent's Registration No.:

Patents Form No. 10
 PATENTS ACT 1983

REQUEST FOR RECORDING EXPIRY OR TERMINATION
 OF LICENCE CONTRACT IN REGISTER
 (Regulations 37 and 45(3))

To: The Registrar of Patents
 Patent Registration Office
 Kuala Lumpur
 Malaysia

For Official Use

APPLICATION No.:

Filing Date:

Request received on:

Fee received on:

Amount:

* Cheque/Postal Order/Money Order/Draft/Cash

No.:

Date of mailing:

Please submit one copy of this Form
 together with the prescribed fee.

Applicant's or Agent's file reference

.....

I. IN THE MATTER OF:

Patent No.: Date of Grant:

Certificate No.: Date of Grant:

and the licence contract relating thereto.

* Delete whichever does not apply.

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

II. LICENSOR:

Name :
 Address :
 . :

III. LICENSEE:

Name :
 Address :
 . :

IV. REQUEST:

The parties to the licence contract identified above request the Registrar to record in the Register the

expiry ☐

or termination ☐

of the licence contract

V. ADDITIONAL INFORMATION

The following items accompany this Form:

- (a) documentation evidencing the above fact (specify)
 (b) other (specify)

VI. SIGNATURE.....

*** (Licensor/Agent for Licensor)*

(Date)

If Agent, indicate Agent's Registration No:.....

*** (Licensee/Agent for Licensee)*

(Date)

If Agent, indicate Agent's Registration No:.....

Patents Form No. 11
 PATENTS ACT 1983

APPLICATION FOR COMPULSORY LICENCE
 (Regulations 38)

To: The Registrar of Patents
 Patent Registration Office
 Kuala Lumpur
 Malaysia

For Official Use

APPLICATION No.:

Filing Date:

Application received on:

Fee received on:

Amount:

* Cheque/Postal Order/Money Order/Draft/Cash
 No.:

Date of mailing:

Please submit one copy of this Form
 together with the prescribed fee.

Applicant's or Agent's file reference

I. IN THE MATTER OF:

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

* Delete whichever does not apply.

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

II. APPLICANT:

Name :

Address :

Address for service in Malaysia:.....

Nationality:.....

* Permanent residence or principal place of business:

.....

.....

Telephone Number
(if any)Fax Number
(if any)

.....

.....

III. REQUEST

The above applicant applies to the Registrar to transmit to the Board the request, in respect of the patent identified above, for the grant of a compulsory licence under section 49 and/or 49A of the Patents Act 1983, in accordance with the terms proposed in Part IV of this Form and upon the grounds set out in Part V of this Form.

IV. PROPOSED TERMS:

A statement setting out the amount of royalty, the conditions of the exploitation of the patent and the restriction of the rights of the licensor or licensee, as the case may be, is attached.

V. ** STATEMENT OF GROUNDS attached.

VI. ADDITIONAL INFORMATION

The following items accompany this Form:

(a) evidence that the patent owner has received a request from the applicant to obtain a licence contract but that he has been unable to obtain such a licence on reasonable terms and within a reasonable time

☐

(b) plan according to which the applicant intends to work the patented invention, including evidence that he has the ability to do so in Malaysia

☐

(c) other (specify)

☐

.....

VII. SIGNATURE.....

*** (Applicant/Agent)

(Date)

If Agent, indicate Agent's Registration No.:

* Delete whichever does not apply.

** The ground upon which the request is based shall be indicated by a reference to the statutory provision the applicant considers applicable (section 49(1)(a) and/or 49(1)(b) and/or 49A of the Patents Act 1983) and to the facts he considers as justifying the grant of a compulsory licence.

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

<p>Patents Form No. 12 PATENTS ACT 1983</p> <p>REQUEST FOR AMENDMENT OF DECISION GRANTING COMPULSORY LICENCE (Regulation 41(1))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Date of mailing:</p> <p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent No. Date of Grant :

and the compulsory licence relating thereto.

II. PATENT OWNER (S):

Name :

Address :

III. BENEFICIARY OF COMPULSORY LICENCE:

Name :

Address :

IV. REQUEST

The above *patent owner(s) beneficiary of a compulsory licence ask(s) the Registrar to transmit to the Board the present request for the following amendment of the decision granting the compulsory licence identified above upon the grounds that the new facts set out below justify such amendment.

V. STATEMENT OF GROUNDS, including new facts that justify the amendment are attached.

VI. ADDITIONAL INFORMATION accompanies this Form:

Yes

☐

No

☐

VII. SIGNATURE

**(Patent Owner/Beneficiary/
Agent)

(Date)

If Agent, indicate Agent's Registration No.:

* Delete whichever does not apply.

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

<p>Patents Form No. 13 PATENTS ACT 1983</p> <p>REQUEST FOR CANCELLATION OF COMPULSORY LICENCE (Regulation 41(2))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Date of mailing:</p> <p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent No.: Date of Grant :

and the compulsory licence relating thereto.

II. PATENT OWNER (S):

Name :

Address :

III. REQUEST:

The above patent owner (s) ask (s) the Registrar to transmit to the Board the present request for the cancellation of the compulsory licence identified above upon the grounds set out below.

IV. **STATEMENT OF GROUNDS attached.

V. ADDITIONAL INFORMATION accompanies this Form:

Yes ☐

No ☐

VI. SIGNATURE

(Date)

*** (Patent Owner/Agent)

If Agent, indicate Agent's Registration No.:

* Delete whichever does not apply.

** The ground upon which the request is based shall be indicated by a reference to the statutory provision the applicant considers applicable (section 54(2)(a) or 54(2)(b) or 54(2)(c) or 54(2)(d) of the Patents Act 1983) and to the facts he considers as justifying the cancellation of the compulsory licence.

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

<p>Patents From No. 14 PATENTS ACT 1983</p> <p>APPLICATION FOR GRANT OF CERTIFICATE FOR UTILITY INNOVATION (Regulation 45(1))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Application received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit this Form in duplicate together with the prescribed fee.</p>	<p>Date of mailing:</p> <p>Applicant's or Agent's file reference</p>

THE APPLICANT (S) REQUEST (S) THE GRANT OF A CERTIFICATE FOR A UTILITY INNOVATION IN RESPECT
OF THE FOLLOWING PARTICULARS:

I. TITLE OF INVENTION :

II. APPLICANT(S) (the data concerning each applicant must appear in this box or, if the space is
insufficient, in the space below):

Name :

I.C/Passport No. :

Address :

Address for service in Malaysia:

Nationality :

* Permanent residence or principal place of business:

.....

.....

Telephone Number
(if any)

.....

Fax Number
(if any)

.....

III. INNOVATOR:

Applicant is the innovator

Yes

☐

No

☐

If the applicant is not the innovator:

Name of innovator :

Address of innovator :

.....

A statement justifying the applicant's right to the certificate accompanies this Form:

Yes

☐

No

☐

IV. AGENT OR REPRESENTATIVE:

Applicant has appointed a patent agent in
accompanying Form No. 17

Yes

☐

No

☐

Agent's Registration No:

Applicants have appointed
to be their common representative

V. DIVISIONAL APPLICATION:

This application is a divisional application

☐

The benefit of the

filing date

☐

priority date

☐

of the initial application is claimed in as much as the subject-matter of the present application
is contained in the initial application identified below.

Initial Application No.:

Date of filing of initial application:

VI. DISCLOSURES TO BE DISREGARDED FOR PRIOR ART PURPOSES:

Additional information is contained in supplemental box:

(a) Disclosure was due to acts of applicant
or his predecessor in title

☐

Date of disclosure :

(b) Disclosure was due to abuse of rights of
applicant or his predecessor in title

☐

Date of disclosure :

A statement specifying in more detail the facts
concerning the disclosure accompanies this Form

Yes

☐

No

☐

VII. PRIORITY CLAIM (if any):

The priority of an earlier application is claimed as follows:

Country (if the earlier application is a regional or international application, indicate the office with which it is filed):

.....

Filing Date:.....

Application No:.....

Symbol of the International Patent Classification:

If not yet allocated, please tick

☒

The priority of more than one earlier application is claimed:

Yes

☐

No

☐

The certified copy of the earlier application (s) accompanies this Form:

Yes

☐

No

☐

If No, it will be furnished by (date)

VIII. CHECK LIST:**A. This application contains the following:**

1. request
2. description..... sheets
3. claim..... sheets
4. abstract..... sheets
5. drawings..... sheets
- Total..... sheets

B. This Form, as filed, is accompanied by the items checked below:

(a) signed Form No. 17

☐

(b) declaration that innovator does not wish to be named in the certificate

☐

(c) statement justifying applicant's right to the certificate

☐

(d) statement that certain disclosures be disregarded

☐

(e) priority document (certified copy of earlier application)

☐

(f) cash, cheque, money order, banker's draft or postal order for the payment of application fee

☐

(g) other documents (specify)

☐

IX. SIGNATURE

(Date)

**(Applicant/Agent)

If Agent, indicate Agent's Registration No.:

For Official Use

1. Date application received:.....

2. Date of receipt of correction, later filed papers or drawings completing the application:

.....

<p>Patents Form No. 15 PATENTS ACT 1983</p> <p>APPLICATION TO EXTEND TERM OF CERTIFICATE FOR UTILITY INNOVATION</p> <p>(Regulation 45(2))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION NO.:</p> <p>Filing Date:</p> <p>Application received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:.....</p>
	<p>Date of mailing:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Certificate No.: Date of Grant:

II. APPLICANT (s) (The data concerning each applicant must appear in this box or, if the space is insufficient, in the space below)

Name :

Address :

Address for service in Malaysia :

.....

Telephone Number
(if any)

.....

Fax Number
(if any)

.....

III. APPLICATION:

The owner of the Certificate applies for an extension of the term of the Certificate for an additional period of five years.

* Delete whichever does not apply.

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

IV. AFFIDAVIT:

An affidavit showing that the utility innovation is in commercial or industrial use in Malaysia or satisfactorily explaining its non-use is attached in accordance with section 35 (3) of the Patents Act 1983.

V. ADDITIONAL INFORMATION accompanies this Form:

Yes

☐

No

☐

VI. SIGNATURE.....

** (Owners (s)/Agent)

(Date)

If Agent, indicate Agent's Registration No:

<p>Patents Form No. 16 PATENTS ACT 1983</p> <p>REQUEST TO AMEND APPLICATION FOR GRANT OF PATENT (Regulations 46 and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p> <p>Date of mailing:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent Application No. : Filing Date :

Certificate Application No. : Filing Date :

Other documents (identify) :

II. PERSON (S) MAKING REQUEST:

Name :

Address :

Address for service in Malaysia :

Telephone Number
(if any)

Fax Number
(if any)

* Delete whichever does not apply.

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

III. REQUEST:

The person (s) above-identified request (s) the Registrar that, after * his/their paying the prescribed fee, the clerical error or obvious mistake in the document identified above may, in accordance with section 79 of the Patents Act 1983, be corrected as attached.

IV. ADDITIONAL INFORMATION accompanies this Form:

Yes

☐

No

☐

V. SIGNATURE.....

** (Applicant/Agent)

.....

(Date)

If Agent, indicate Agent's Registration No:

<p>Patents Form No. 16A PATENTS ACT 1983</p> <p>REQUEST TO AMEND PATENT (Regulations 46A and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent No. : Date of Grant:

Certificate No. : Date of Grant :

II. OWNER (s):

Name :

Address :

III. ASSOCIATED DOCUMENT (if any):

Document :

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

IV. REQUEST:

The owner (s) request (s) the Registrar to amend, as attached, the above-identified *patent/
certificate/document in accordance with section 79A(1) of the Patents Act 1983.

V. REASON FOR REQUEST:

*(a) Correction of clerical error

(b) Correction of obvious mistake

(c) Other ** reason.....

VI. ADDITIONAL INFORMATION accompanies this Form:

Yes ☐

No ☐

VII. SIGNATURE.....

(Date)

*** (Applicant/Agent)

If Agent, indicate Agent's Registration No:

<p>Patents Form No. 17 PATENTS ACT 1983</p> <p>APPOINTMENT OR CHANGE OF PATENT AGENT (Regulations 45B (2) and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION NO.:</p> <p>Filing Date:</p> <p>Received on:</p> <p>Date of mailing:</p>
<p>Please submit one copy of this Form.</p>	<p>Applicant's or Agent's file reference</p>

* I/We the undersigned,

Name :

Address :

appoint

Name :

Address :

Telephone Number
(if any)

Fax Number
(if any)

- * Delete whichever does not apply.
 ** Specify other reason.
 *** Type name under signature, and delete whichever does not apply.

to act as *my/our agent in connection with the following matter (s):

.....

ratify all acts done by the agent on *my/ our behalf in connection with *that/those matter (s), and

request that all notices, requisitions and communications relating thereto be sent to the agent at the abovementioned said address.

Any previous appointment in respect of the same matter (s) is revoked.

**SIGNATURE.....

.....
 (Date)

<p>Patents Form No. 18 PATENTS ACT 1983</p> <p>APPLICATION FOR REGISTRATION OF PATENT AGENTS</p> <p>(Regulation 45c (1))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>Application received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Applicant's file reference </p>

I. APPLICANT:

Name :

Address :

.....

Nationality:

* Permanent residence or principal place of business:

.....

.....

Telephone Number
 (if any)

.....

Fax Number
 (if any)

.....

II. APPLICATION:

The above applicant applies for registration as a patent agent in the Register of Patents Agents.

* Delete whichever does not apply.

** Must be signed by the person (s) appointing the agent; type name under signature.

III. QUALIFICATIONS:

The applicant (tick whichever is applicable):

- (a) is an advocate and solicitor of the High Court
- (b) has passed the examination specified in regulation 45D
- (c) has a relevant degree or its equivalent in engineering or science
- (d) has not been convicted of any offence involving fraud or dishonesty
- (e) has been convicted of an offence involving fraud or dishonesty and a record thereof with a statement of explanation accompanies this Form

IV. Proof of the matters specified in paragraphs (a), (b), (c) and (d) of Part III of this Form, if applicable, accompanies this Form.

V. SIGNATURE.....
**(Applicant)
(Date)

<p>Patents Form No. 18A PATENTS ACT 1983</p> <p>APPLICATION FOR REGISTRATION AS CANDIDATE FOR EXAMINATION (Regulation 45D(2))</p> <p>To: The Secretary Board of Examiners of Patent Agents Patent Registration Office Kuala Lumpur Malaysia</p>	<p style="text-align: center;">For Official Use</p> <p>Application Received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit this Form in duplicate together with the prescribed fee.</p>	<p>Applicant's file reference</p>

I. I..... of

 hereby apply for registration as a candidate at the Examination for Registration as Patent Agents to
 be held in the month of 19

II. SIGNATURE
**(Applicant)
(Date)

Telephone Number
Fax Number
(if any)
(if any)
.....
.....

* Delete whichever does not apply.
 ** Type name under signature.

<p>Patents Form No. 18b PATENTS ACT 1983</p> <p>APPLICATION TO RE-SIT EXAMINATION (Regulation 45D(8))</p> <p>To: The Secretary Board of Examiners of Patent Agents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>Application Received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit one this Form in duplicate together with the prescribed fee.</p>	<p>Applicant's file reference</p>

I. I..... of.....
.....

hereby apply to submit myself to re-sit the examination in the following subject (s) at the
Examination for Registration as Patent Agents to be held in the month of 19

Subjects:
.....
.....
.....

II. SIGNATURE..... (Date)
 **(Applicant)

Telephone Number
(if any)

Fax Number
(if any)

<p>Patents Form No. 19 PATENTS ACT 1983</p> <p>APPLICATION FOR RENEWAL OF REGISTRATION OF PATENT AGENT (Regulation 45E(1))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>Application Received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Applicant's file reference</p>

I. APPLICANT:

Name :
Address :
.....

* Delete whichever does not apply.
** Type name under signature.

Nationality :

* Permanent residence or domicile:

.....
.....Telephone Number
(if any)Fax Number
(if any)

.....

.....

II. APPLICATION:

The above applicant applies for renewal of the registration in the Register of Patents Agents.

III. QUALIFICATIONS:

The applicant (tick whichever is applicable):

(a) is an advocate and solicitor of the High Court

☐

(b) has passed the examination specified in regulation 45D

☐

(c) has a relevant degree or its equivalent in engineering or science

☐

(d) has not been convicted of any offence involving fraud or dishonesty

☐(e) has been convicted of an offence involving fraud or dishonesty and
a record thereof with a statement of explanation accompanies this Form☐

IV. ADDITIONAL INFORMATION accompanies this Form:

Yes

☐

No

☐

V. SIGNATURE.....

**(Applicant)

(Date) *

<p>Patents Form No. 20 PATENTS ACT 1983</p> <p>FURNISHMENT OF ADDRESS FOR SERVICE (Regulations 51 and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>Request No:</p> <p>Fee received on:</p> <p>Received on:.....</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:.....</p> <p>Date of mailing:</p>
<p>Please submit one copy of this Form together with the prescribed fee.</p>	<p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

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

Patent No.:..... Date of Grant:.....

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

Certificate No.:..... Date of Grant:.....

* Delete whichever does not apply.

** Type name under signature.

II. APPLICANT (S):

Name :

Address :

.....

III. REQUEST:

The applicant (s) identified above request (s) the Registrar for the *inclusion/addition/alteration/
substitution of an address for service in Malaysia as follows:

.....

.....

IV. ADDITIONAL INFORMATION accompanies this Form:

Yes ☐No ☐

V. SIGNATURE.....

**(Applicant/Agent)

(Date)

If Agent, indicate Agent's Registration No. :

<p>Patents Form No. 21 PATENTS ACT 1983</p> <p>REQUEST FOR EXTENSION OF TIME (Regulations 53(1) and 45(3))</p> <p>To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia</p>	<p>For Official Use</p> <p>APPLICATION No.:</p> <p>Filing Date:</p> <p>Request received on:</p> <p>Fee received on:</p> <p>Amount:</p> <p>* Cheque/Postal Order/Money Order/Draft/Cash No.:</p>
<p>Please submit this Form in duplicate together with the prescribed fee.</p>	<p>Date of mailing:</p> <p>Applicant's or Agent's file reference</p>

I. IN THE MATTER OF:

Patent Application No.: Filing Date:

Patent No.: Date of Grant:

Certificate Application No.: Filing Date:

Certificate No.: Date of Grant:

* Delete whichever does not apply .

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

II. APPLICANT (s):

Name :
Address :

III. REQUEST:

**The applicant (s) request (s) the Registrar to extend the time within which to:

.....
.....

IV. EXTENSION PERIOD SOUGHT:

From: To:

V. ***STATEMENT OF GROUNDS attached

☐

VI. ADDITIONAL INFORMATION accompanies this Form:

Yes

☐

No

☐

VII. SIGNATURE.....

****(Applicant/Agent)

.....
(Date)

If Agent, indicate Agent's Registration No.:

- * Delete whichever does not apply.
- ** Insert brief description of the act or things to be done.
- *** The applicant shall state the facts he considers as justifying the extension.
- **** Type name under signature and delete whichever does not apply.

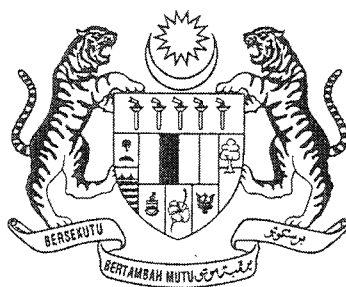
Made 29 June 1995.

Note: The saving and transitional provisions under P.U. (A) 262/95 [w.e.f. 1.8.1995] read as follows:

30 (1) Any registration as a patent agent granted under the principal Regulations and in force immediately before the commencement of these Regulations shall, in so far as its grant is not inconsistent with these Regulations, be deemed to have been granted under these Regulations and shall continue in force until it expires.

(2) Any application for registration as a patent agent or application for renewal of registration as a patent agent made or pending before the date of coming into force of these Regulations shall be deemed to have been made under the principal Regulations and the principal Regulations shall continue to apply to such applications as if the principal Regulations had not been amended:

Provided that the registration of such person as a patent agent shall be for a term expiring on the 31st December 1995 and for the purposes of this proviso the prescribed fee payable shall be proportionate to the term to be renewed.



LAWS OF MALAYSIA

Act A1088

PATENTS (AMENDMENT) ACT 2000

Date of Royal Assent ... 18 August 2000

Date of publication in the
Gazette 31 August 2000

LAWS OF MALAYSIA

Act A1088

PATENTS (AMENDMENT) ACT 2000

An Act to amend the Patents Act 1983.

[]

ENACTED by the Parliament of Malaysia as follows:

Short title and commencement

1. (1) This Act may be cited as the Patents (Amendment) Act 2000.

(2) This Act shall come into operation on a date to be appointed by the Minister by notification in the *Gazette*.

Amendment of section 17

2. The Patents Act 1983 [*Act 291*], which in this Act is referred to as the “principal Act”, is amended in section 17 by substituting for the words “which can be made or used in any kind of industry” the words “which is capable of industrial application”.

Amendment of section 17A

3. Subsection 17A(2) of the principal Act is amended by deleting the words “16,”.

Amendment of section 31

4. Subsection 31(1) of the principal Act is amended by inserting after the words “public order” the words “or morality”.

Amendment of section 35

5. Section 35 of the principal Act is amended—

(a) by substituting for subsection (1) the following subsection:

“(1) The duration of a patent shall be twenty years from the filing date of the application.”; and

(b) by inserting after subsection (1) the following subsection:

“(1A) Without prejudice to subsection (1) and subject to the other provisions of this Act, a patent shall be deemed to be granted and shall take effect on the date the certificate of grant of the patent is issued.”.

Amendment of section 37

6. Section 37 of the principal Act is amended—

(a) by inserting after subsection (1) the following subsection:

“(1A) The rights under the patent shall not extend to acts done 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.”; and

(b) in subsection (2) by substituting for the words “The right” the words “Without prejudice to section 58A, the rights”.

Substitution of section 49

7. The principal Act is amended by substituting for section 49 the following section:

“Applica-
tion for
compul-
sory
licences. 49. (1) At any time after the expiration of three years from the grant of a patent, or four years from the filing date of the patent application, whichever is the later, any person may apply to the Registrar for a compulsory licence under any of the following circumstances:

(a) where there is no production of the patented product or application of the patented process in Malaysia without any legitimate reason;

(b) where there is no product produced in Malaysia under the patent for sale in any domestic market, or there are some but they are sold at unreasonably high prices or do not meet the public demand without any legitimate reason.

(2) A compulsory licence shall not be applied for unless the person making the application has made efforts to obtain authorisation from the owner of the patent on reasonable commercial terms and conditions but such efforts have not been successful within a reasonable period of time.

(3) The application for a compulsory licence shall be in compliance with such regulations as may be prescribed by the Minister.”.

Amendment of section 49A

8. Subsection 49A(1) of the principal Act is amended by inserting after the words “an important technical advance” the words “of considerable economic significance”.

Substitution of section 53

9. The principal Act is amended by substituting for section 53 the following section:

- “Limitation of compulsory licence. 53. (1) A compulsory licence granted by the Board—
- (a) shall not be assigned otherwise than in connection with the goodwill or business or that part of the goodwill or business in which the patented invention is used;
 - (b) shall be limited to the supply of the patented invention predominantly in Malaysia.
- (2) The beneficiary of the compulsory licence shall not conclude licence contracts with third persons under the patent in respect of which the compulsory licence was granted.”.

New section 58A

10. The principal Act is amended by inserting after section 58 the following section:

- “Acts deemed to be non-infringement. 58A. (1) It shall not be an act of infringement to import, offer for sale, sell or use—
- (a) any patented product; or
 - (b) any product obtained directly by means of the patented process or to which the patented process has been applied,
- which is produced by, or with the consent, conditional or otherwise, of the owner of the patent or his licensee.
- (2) For the purposes of this section, “patent” includes a patent granted in any country outside Malaysia in respect of the same or essentially the same invention as that for which a patent is granted under this Act.”.

Substitution of section 84

11. The principal Act is amended by substituting for section 84 the following section:

- “Rights of Government. 84. (1) Notwithstanding anything contained in this Act—
- (a) where there is national emergency or where the public interest, in particular, national security, nutrition, health or the development of other vital sectors of the national economy as determined by the Government, so requires; or

- (b) where a judicial or relevant authority has determined that the manner of exploitation by the owner of the patent or his licensee is anti-competitive,

the Minister may decide that, even without the agreement of the owner of the patent, a Government agency or a third person designated by the Minister may exploit a patented invention.

(2) The owner of the patent shall be notified of the decision of the Minister as soon as is reasonably practicable.

(3) The exploitation of the patented invention shall be limited to the purpose for which it was authorised and shall be subject to the payment to the owner of the patent of an adequate remuneration for such exploitation, taking into account—

- (a) the economic value of the Minister's authorisation as determined in the decision; and
- (b) where a decision has been taken under paragraph (b) of subsection (1), the need to correct anti-competitive practices.

(4) The Minister shall make his decision under subsection (3) after hearing the owner of the patent and any other interested person if they wish to be heard.

(5) The exploitation of a patented invention in the field of semi-conductor technology shall only be authorised either—

- (a) for public non-commercial use; or
- (b) where a judicial or relevant authority has determined that the manner of exploitation of the patented invention, by the owner of the patent or his licensee, is anti-competitive and if the Minister is satisfied that the authorisation would remedy such anti-competitive practice.

(6) The authorisation shall not exclude—

- (a) the continued exercise by the owner of the patent of his rights under subsection (1) of section 36; or
- (b) the issuance of compulsory licences under Part X.

(7) Where a third person has been designated by the Minister, the authorisation may only be transferred with the goodwill or business of that person or with that part of the goodwill or business in which the patented invention is being exploited.

(8) The exploitation of the invention by the Government agency or the third person designated by the Minister shall be predominantly for the supply of the market in Malaysia.

(9) Upon the request of—

- (a) the owner of the patent; or
- (b) the Government agency or the third person authorised to exploit the patented invention,

the Minister may, after hearing the parties, if either or both wish to be heard, vary the terms of the decision authorising the exploitation of the patented invention to the extent that changed circumstances justify such variation.

(10) Upon the request of the owner of the patent, the Minister shall terminate the authorisation if he is satisfied, after hearing the parties, if either or both wish to be heard, that the circumstances mentioned in subsection (1) which led to his decision have ceased to exist and are unlikely to recur or that the Government agency or the third person designated by him has failed to comply with the terms of the decision.

(11) Notwithstanding subsection (10), the Minister shall not terminate the authorisation if he is satisfied that the need for adequate protection of the legitimate interests of the Government agency or the third person designated by him justifies the maintenance of the decision.

(12) The owner of a patent, a Government agency or the third person authorised to exploit a patented invention may appeal to the Court against the decision of the Minister under this section.

(13) In this section “Government agency” means the Federal Government or the Government of a State and includes a Ministry or Department of that Government.”.

Amendment of Second Schedule

12. The Second Schedule to the principal Act is amended—

- (a) by inserting, after the reference in column (1) to section 14 and the modifications in column (2) in respect of section 14, the following provision:

‘Section 16 Substitute “utility innovation” for “invention”.’; and

- (b) in the modifications in column (2) in respect of section 35—

- (i) by substituting for subsection (1) the following subsection:

“(1) The duration of a certificate for a utility innovation shall be ten years from the filing date of the application.”;

- (ii) by inserting after subsection (1) the following subsection:

“(1A) Without prejudice to subsection (1) and subject to the other provisions of this Act, a certificate for a utility innovation shall be deemed to be granted and shall take effect on the date the certificate for utility innovation is issued.”; and

- (iii) in subsection (2) by substituting for the word “five” appearing after the words “expiration of the period of” the word “ten”.

Saving

13. (1) The amendment to section 35 of the principal Act shall not affect any application for the grant of a patent or application for a certificate for utility innovation, as the case may be, made under the principal Act before the commencement of this Act and the provisions of the principal Act relating to such applications shall apply to that application as if those provisions had not been amended by this Act.

(2) Inventions or utility innovations in respect of which patents or utility innovation certificates are granted under the principal Act and are still protected on the commencement of this Act shall remain protected for such duration as was provided for in section 35 of the principal Act as if that section had not been amended by this Act.

PATENTS ACT 1983
PATENTS REGULATIONS (AMENDMENT) 2001

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

Citation and commencement

1. (1) These regulations may be cited as the Patents Regulations (Amendment) 2001.

(2) These Regulations come into operation on 1 August 2001.

Amendment of regulation 29

2. Regulation 29 of the Patents Regulation 1986 [*P.U. (A) 327/86*], which in these Regulations are referred to as the “principal Regulations” are amended-

(a) by substituting for the full stop at the end of paragraph (f) the words “; and ”; and

(b) by inserting after paragraph (f) the following paragraph:

“(g) the date the certificate of grant of the patent is issued.”.

Amendment of regulation 38

3. Regulation 38 of the principal Regulations are amended:

(a) by renumbering regulation 38 as subregulation 38(1); and

- (b) by inserting after subregulation (1) the following subregulation:

“(2) For the purpose of section 49(2) of the Act, the reasonable period of time shall be six months from the initial efforts made to obtain authorization from the owner of the patent.”.

Amendment of Schedule I

4. Part II of Schedule I to the principal Regulations is amended-

- (a) by substituting for item no. 8 the following item:

<i>(1)</i> <i>Item</i> <i>No.</i>	<i>(2)</i> <i>Matter/</i> <i>Proceeding</i>	<i>(3)</i> <i>Fee</i> <i>(RM)</i>
“8.	Annual fee for patent:	
(a)	for second year after grant of patent	200.00
(b)	for third year after grant of patent	250.00
(c)	for fourth year after grant of patent	300.00
(d)	for fifth year after grant of patent	350.00
(e)	for sixth year after grant of patent	400.00
(f)	for seventh year after grant of patent	450.00
(g)	for eight year after grant of patent	500.00
(h)	for ninth year after grant of	

	patent	550.00
(i)	for tenth year after grant of patent	600.00
(j)	for eleventh year after grant of patent	650.00
(k)	for twelfth year after grant of patent	700.00
(l)	for thirteenth year after grant of patent	800.00
(m)	for fourteenth year after grant of patent	900.00
(n)	for fifteenth year after grant of patent	1000.00
(o)	for sixteenth year after grant of patent	1200.00
(p)	for seventeenth year after grant of patent	1400.00
(q)	for eighteenth year after grant of patent	1600.00
(r)	for nineteenth year after grant of patent	1800.00
(s)	for twentieth year after grant of patent	2000.00:

Provided that the duration of a patent shall not exceed twenty years from the filing date of the application.”;

(b) by substituting for item no. 12 the following item:

<i>(1)</i> <i>Item</i> <i>No.</i>	<i>(2)</i> <i>Matter/</i> <i>Proceeding</i>	<i>(3)</i> <i>Fee</i> <i>(RM)</i>
"12.	Annual fee for certificate for utility innovation:	
(a)	for third year after grant of certificate	120.00
(b)	for fourth year after grant of certificate	160.00
(c)	for fifth year after grant of certificate	160.00
(d)	for sixth year after grant of certificate	200.00
(e)	for seventh year after grant of certificate	200.00
(f)	for eighth year after grant of certificate	240.00
(g)	for ninth year after grant of certificate	240.00
(h)	for tenth year after grant of certificate	280.00
(i)	for eleventh year after grant of certificate	400.00
(j)	for twelfth year after grant of certificate	600.00
(k)	for thirteenth year after grant of certificate	700.00
(l)	for fourteenth year after grant of	

	certificate	800.00
(m)	for fifteenth year after grant of certificate	1000.00
(n)	for sixteenth year after grant of certificate	1100.00
(o)	for seventeenth year after grant of certificate	1200.00
(p)	for eighteenth year after grant of certificate	1300.00
(q)	for nineteenth year after grant of certificate	1400.00
(r)	for twentieth year after grant of certificate	1500.00:

Provided that the duration of a certificate for a utility innovation shall not exceed twenty years from the filing date of the application.”; and

(c) by inserting after item no. 17 and the particulars relating to it the following items:

<i>(1)</i> <i>Item</i> <i>No.</i>	<i>(2)</i> <i>Matter/ Proceeding</i>	<i>(3)</i> <i>Fee</i> <i>(RM)</i>
“18.	Surcharge for late payment of annual fee	100% of fee for year concerned
19.	Public search through computer	20.00 per hour
20.	Computer print-out (Bibliography data)	5.00 per page

21	Permitted information (upon request)	100.00 for less than 10 pages and 5.00 for the subsequent pages”.
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Amendment of Schedule II

5. Schedule II to the principal Regulations is amended by substituting for Form 1 the following form:

SCHEDULE
(Regulation 29)
FORM

Patents Form No. 1 PATENTS ACT 1983 REQUEST FOR GRANT OF PATENT (Regulation 7(1)) To: The Registrar of Patents Patent Registration Office Kuala Lumpur Malaysia	For Official Use
	APPLICATION No.:
	Filing Date:
	Request received on:
	*Fee received on:
	Amount:
	*Cheque/Postal Order/Money Order/Draft/Cash No.:

Please submit this Form in duplicate together with the prescribed fee.

Applicant's or Agent's file reference

THE APPLICANT (S) REQUEST (S) THE GRANT OF A PATENT IN RESPECT OF THE FOLLOWING PARTICULARS:

I. TITLE OF INVENTION:

II. APPLICANT(S) (the data concerning each applicant must appear in this box or, if the space is insufficient in the space below)

Name:

H.S.C./Passport No:

Address:

Address for service in Malaysia:

Nationality:

*Permanent residence or principal place of business:

.....

.....

Telephone No.(if any):

Fax No.(if any):

Additional Information (if any):

III. INVENTOR

Applicant is the inventor:

Yes

☐

No

☐

If the applicant is not the inventor:

Name of inventor:

.....

Address of inventor:

.....

A Statement justifying the applicant's right to the patent accompanies this Form:

Yes

☐

No

☐

Additional Information (if any):

IV. AGENT OR REPRESENTATIVE

Applicant has appointed a patent agent in accompanying
Form No.17:

Yes

☐

No

☐

Agent's Registration No.:

Applicants have appointed
to be their common representative.

V. DIVISIONAL APPLICATION

This application is a divisional application

☐

The benefit of the

filing date

☐

priority date

☐

of the initial application is claimed in as much as the subject-matter of the present application is contained in
the initial application identified below:

Initial Application No.:

Date of filing of initial application:

VI. DISCLOSURES TO BE DISREGARDED FOR PRIOR ART PURPOSES

Additional information is contained in supplemental box:

(a) Disclosure was due to acts of applicant or his predecessor in title

☐

Date of disclosure :

(b) Disclosure was due to abuse of rights of applicant or his predecessor in title

☐

Date of disclosure :

A statement specifying in more detail the facts concerning the disclosure
accompanies this form:

Yes

☐

No

☐

Additional Information (if any):

VII. PRIORITY CLAIM (if any)

The priority of an earlier application is claimed as follows:

Country (if the earlier application is a regional or international application, indicate the office with which it is filed):

.....

Filing Date:

Application No:

Symbol of the International Patent Classification:

If not yet allocated, please tick

☐

The priority of more than one earlier application is claimed:

Yes

☐

No

☐

The certified copy of the earlier application (s) accompanies this Form:

Yes

☐

No

☐

If No, it will be furnished by.....(date)

Additional Information (if any):

VIII. CHECK LIST

A. This application contains the following:

- | | | |
|----|-------------------|--------|
| 1. | request | |
| 2. | description | sheets |
| 3. | claim | sheets |
| 4. | abstract | sheets |
| 5. | drawings | sheets |
| | Total | sheets |

B. This Form, as filed, is accompanied by the items checked below (please tick where appropriate):

(a) signed Form No. 17

☐

(b)	declaration that inventor does not wish to be named in the patent	<input type="checkbox"/>
(c)	statement justifying applicant's right to the patent	<input type="checkbox"/>
(d)	statement that certain disclosures be disregarded	<input type="checkbox"/>
(e)	priority document (certified copy of earlier application)	<input type="checkbox"/>
(f)	cash, cheque, money order, banker's draft or postal order for the payment of application fee	<input type="checkbox"/>
(g)	other documents (specify)	<input type="checkbox"/>

IX	SIGNATURE (Date)
	**(Applicant/Agent)	
	If Agent, indicate Agent's Registration No.:.....	

For Official Use	
1.	Date application received:
2.	Date of receipt of correction, later filed papers or drawings completing the application:

- * Delete where inapplicable.
** Type name under signature and delete where inapplicable."

Made 23 July 2001.
[KPDN/BHI/PAT/201JSJ.1 ;PN(PU2)410/V]



TAN SRI DATO' HAJI MUHYIDDIN HAJI MOHD. YASSIN
Minister of Domestic Trade and Consumer Affairs