

Patents Act 1983

LAWS OF MALAYSIA

REPRINT

Act 291

PATENTS ACT 1983

Incorporating all amendments up to 1 May 2006

PUBLISHED BY

THE COMMISSIONER OF LAW REVISION, MALAYSIA

UNDER THE AUTHORITY OF THE REVISION OF LAWS ACT 1968 IN COLLABORATION WITH

PERCETAKAN NASIONAL MALAYSIA BHD

2006

Laws of Malaysia2 ACT 291

PATENTS ACT 1983

Date of Royal Assent 28 November 1983 Date of publication
in the Gazette ... 15 December 1983 PREVIOUS REPRINT

First Reprint 2001

Patents 3

LAWS OF MALAYSIA

Act 291

PATENTS ACT 1983

ARRANGEMENT OF SECTIONS

PART I

PRELIMINARY

Section

1. Short title application
2. Extent of application
3. Interpretation PART II

PATENTS BOARD

4-7A. (Deleted)

PART III

ADMINISTRATION

8. Registrar, Deputy Registrars and Assistant Registrars
9. Patent Registration Office 9A. Examiners
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 Laws of Malaysia4 ACT 291

PART IVA

UTILITY INNOVATIONS

Section

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 Patents 5

Section

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. Public inspection

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 Laws of Malaysia 6 ACT 291

PART X

COMPULSORY LICENCES

Section

48. Definition

49. Application for compulsory licences 49A. Application for compulsory licence based on interdependence of patents

50. Request for grant of compulsory licence

51. Decision by the Corporation

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 58A. Acts deemed to be non-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 PART XIII

OFFENCES

62A. Applications in contravention of section 23A 62B. Publication of information in contravention of Registrar's directions

63. Falsification of Register, etc. Patents 7

Section

64. Unauthorized claim or patent

65. Unauthorized 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 corporations 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. Institution of prosecution

78. Jurisdiction of subordinate Court PART XIVA

INTERNATIONAL APPLICATIONS UNDER THE PATENT

COOPERATION TREATY

78A. Interpretation

78B. Application

78C. Patent Registration Office as receiving office 78D. Patent Registration Office as designated office 78E. Patent Registration Office as elected office 78F. Persons eligible for international application 78G. Filing of an international application

78H. Filing date and the effect of filing an international application 78I. Defects in international application

78J. International application considered withdrawn 78K. Processing of international applications

78L. International Searching Authority

Laws of Malaysia8 ACT 291

Section

78M. International Preliminary Examination Authority 78N. International publication of international application and its effect 78O. Entering the national phase

78P. Search similar to international search for national applications 78Q. Conversion of an international application into a national application PART XV

MISCELLANEOUS

79. Powers 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 (Deleted)

SECOND SCHEDULE

Patents 9

LAWS OF MALAYSIA

Act 291

PATENTS ACT 1983

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

[1 October 1986--P.U. (B) 500/1986]

BE IT ENACTED by the 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

Short title and application

1. (1) This Act may be cited as the Patents Act 1983. (2) This Act shall apply throughout Malaysia.

Extent of application

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

Interpretation

3. In this Act, unless the context otherwise requires-- "appointed date" has the same meaning as is assigned to that expression in the Intellectual Property Corporation of Malaysia Act 2002;

Laws of Malaysia¹⁰ ACT 291

"Assistant Registrar" means the person appointed or deemed to have been appointed to be an Assistant Registrar under subsection 8(2) or (3);

"authorized officer" means an officer authorized under section 68;

"Corporation" means the Intellectual Property Corporation of Malaysia established under the Intellectual Property Corporation of Malaysia Act 2002;

"Court" means the High Court, or Judge thereof;

"Deputy Registrar" means the person appointed or deemed to have been appointed to be a Deputy Registrar under subsection 8(2) or (3);

"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;

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

"Examiner" means any person, government department, unit or organization, or any foreign or international patent office or organization, appointed by the Corporation under section 9A; "filing date" means the date recorded by the Registrar as the filing date under section 28;

"Minister" means the Minister for the time being charged with the responsibility for intellectual property;

"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; Patents 11

"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 as designated in subsection 8(1);

"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)–(7A) (Deleted by Act A1137).

PART III

ADMINISTRATION

Registrar, Deputy Registrars and Assistant Registrars

8. (1) The Director General of the Corporation shall be the Registrar of Patents.

(2) The Corporation may appoint, on such terms and conditions as it may determine, from amongst persons in the employment of the Corporation, such number of Deputy Registrars of Patents, Assistant Registrars of Patents and other officers as may be necessary for the proper administration of this Act, and may revoke the appointment of any person so appointed or deemed to have been so appointed under subsection (3).

(3) The persons holding office as Deputy Registrars, Assistant Registrars and other officers under this Act before the appointed date who were given an option by the Government of Malaysia to serve as employees of the Corporation and have so opted shall on the appointed date be deemed to have been appointed as Deputy Registrars, Assistant Registrars and such other officers under subsection (2).

(4) Subject to the general direction and control of the Registrar and to such conditions or restrictions as may be imposed by the Registrar, a Deputy Registrar or an Assistant Registrar may exercise any function of the Registrar under this Act, and anything by this Act appointed or authorized or required to be done or signed by the Registrar may be done or signed by any Deputy Registrar or Assistant Registrar and the act or signature of a Deputy Registrar or an Assistant Registrar shall be as valid and effectual as if done or signed by the Registrar.

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

Patent Registration Office

9. (1) A Patent Registration Office and such number of branch offices of the Patent Registration Office as may be necessary for the purposes of this Act shall be established.

(2)–(4) (Deleted by Act A1137).

(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.

Examiners

9A. The Corporation may appoint any person, government department, unit or organization, or any foreign or international patent office or organization to be an Examiner for the purposes of this Act.

Patents 13

Patent information service

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

PATENTABILITY

Patentable inventions

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

Meaning of "invention"

12. (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. Non-patentable inventions

13. (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 manmade 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.

Laws of Malaysia¹⁴ ACT 291

(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.

Novelty

14. (1) An invention is new if it is not anticipated by prior art. (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 (2) (a) 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.

(4) 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 13(1) (d), if its use in any such method is not comprised in the prior art.

Patents 15

Inventive step

15. 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 14(2) (a), such inventive step would not have been obvious to a person having ordinary skill in the art. Industrial application

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

PART IVA

UTILITY INNOVATIONS

Definition

17. 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 is capable of industrial application, and includes an invention. Application

17A. (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, 26, Part X, and sections 89 and 90 shall not apply to utility innovations.

Conversion from an application for a patent into an application for a certificate for a utility innovation, and vice versa 17B. (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.

Laws of Malaysia¹⁶ ACT 291

(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 30(1) or (2).

(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. Patent and certificate for a utility innovation cannot both be granted for the same invention

17C. (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. Patents 17

PART V

RIGHTS TO A PATENT

Right to a patent

18. (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. (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. Judicial assignment of patent application or patent

19. 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.

Inventions made by an employee or pursuant to a commission

20. (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. Laws of Malaysia 18 ACT 291

(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 or 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.

Inventions by Government employee

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

22. 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

Requirements of application

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

Patents 19

Applications by residents to be filed in Malaysia first 23A. (1) 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.

Application fee

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

25. 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. Unity of invention

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

Amendment of application

26A. The applicant may amend the application:

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

Division of application

26B. (1) The applicant may, within the prescribed time, divide the application into two or more applications ("divisional applications"):

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

Laws of Malaysia 20 ACT 291

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

Right of priority

27. (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.

(1A) The period of twelve months mentioned in subsection (1) may not be extended under section 82.

(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. Priority date

27A. (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.

Patents 21

Filing date

28. (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, 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.

Preliminary examination

29. (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.

Laws of Malaysia 22 ACT 291

(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. Request for substantive examination or modified substantive

examination

29A. (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.

Patents 23

(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 section 82.

Substantive examination and modified substantive examination

30. (1) Where a request for substantive examination has been filed under subsection 29A(1), 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.

Laws of Malaysia 24 ACT 291

(2) Where a request for a modified substantive examination has been filed under subsection 29A(2), 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 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. Patents 25

Prohibition of publication of information which might be prejudicial to the nation

30A. (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.

Grant of patent

31. (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 or morality.

(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.

Laws of Malaysia 26 ACT 291

(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). Register of Patents

32. (1) The Registrar shall keep and maintain a register called the Register of Patents.

(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.

Notice of a trust not to be registered

32A. Notice of a trust, express, implied or constructive, shall not be entered in the Register or be accepted by the Registrar. Examination of Register and certified copies

33. Any person may examine the Register and may obtain certified extracts therefrom on payment of the prescribed fee. Certified copies of or extracts from Register, etc., admissible as evidence in court

33A. (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.

Patents 27

Amendments to the Register

33B. (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.

Court may order rectification of the Register

33C. (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; Laws of Malaysia 28 ACT 291

(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. Public inspection

34. (1) The Registrar shall make available for public inspection after eighteen months from the priority date or filing date of a patent application and upon payment of the prescribed fee-- (a) the name, address and description of the applicant and the name and address of his agent, if any;

(b) the application number;

(c) the filing date of 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 is a regional or an international application, the

name of the country or countries for which and the office at which it was filed;

(d) the particulars of the application including the description, claim or claims, drawings, if any, and the abstract and any amendments to the application, if any; and

(e) any change in ownership of the application and any reference to a licence contract appearing in the file relating to the application.

(2) Notwithstanding subsection (1) a patent application shall not be made available for public inspection if--

(a) the patent application is withdrawn or refused or deemed to be withdrawn or refused before the expiry of the period of eighteen months from the priority date or filing date of the patent application; or

Patents 29

(b) it appears to the Registrar that the application contains information which contravenes public order or morality. (3) Information relating to a patent application may be inspected only with the written permission of the patent applicant if the information is requested within eighteen months from the priority date or filing date of the patent application.

(4) A certified extract of the information may be obtained upon payment of the prescribed fee.

(5) After an application is made available for public inspection, an applicant may in writing warn a person who has commercially or industrially worked the invention which is the subject matter of the application that a patent application for the invention has been filed.

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

(a) from the time the person is given the warning under subsection (5); or

(b) in the absence of a warning, after the patent application in respect of the invention has been made available for public inspection,

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

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

(9) Where a patent application is withdrawn or refused after the application is made available for public inspection, the right under subsection (6) shall be deemed never to have existed. Laws of Malaysia 30 ACT 291

Duration of patent

35. (1) Subject to subsections (1B) and (1C), the duration of a patent shall be twenty years from the filing date of the application. (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.

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

(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.

(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.

Reinstatement of a lapsed patent

35A. (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.

Patents 31

(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

Rights of owner of patent

36. (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.

Laws of Malaysia 32 ACT 291

(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 purposes 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. Limitation of rights

37. (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.

(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.

(2) Without prejudice to section 58A, 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; Patents 33

(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 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 authorized by the Government as provided in section 84.

Rights derived from prior manufacture or use

38. (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 paragraph 14(3) (a), (b) or (c) 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. Laws of Malaysia 34 ACT 291

PART VIII

ASSIGNMENT AND TRANSMISSION OF PATENT

APPLICATIONS AND PATENTS

Assignment and transmission of patent applications and patents

39. (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. Joint ownership of patent applications or patents

40. 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

Meaning of licence contract

41. (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 (1) (a), and subsection 36(3).

Patents 35

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

Entry in the Register

42. (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).

Rights of the licensee

43. (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 (1) (a), and subsection 36(3) within the whole geographical area of Malaysia without limitation as to time and through any application of the invention. Laws of Malaysia 36 ACT 291

(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 (1) (a), and subsection 36(3). Rights of the licensor

44. (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 (1) (a), and subsection 36(3). (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 (1) (a), and subsection 36(3).

Invalid clauses in licence contracts

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

46. 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;

Patents 37

- (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.

Expiry, termination or invalidation of licence contract

47. 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

Definition

48. 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 authorization 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 (1) (a), and subsection 36(3).

Laws of Malaysia 38 ACT 291

Application for compulsory 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 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 authorization 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. Application for compulsory licence based on interdependence of patents

49A. (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 Corporation, an important technical advance of considerable economic significance in relation to the invention claimed in the earlier patent, the Corporation, 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 Corporation, 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. Patents 39

Request for grant of compulsory licence

50. (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 Corporation. (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).

Decision by the Corporation

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

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

52. Upon the granting of the compulsory licence to the applicant the Corporation shall fix--

(a) the scope of the licence specifying in particular the period for which

licence is granted;

(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.

Laws of Malaysia40 ACT 291

Limitation of compulsory licence

53. (1) A compulsory licence granted by the Corporation-- (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.

Amendment, cancellation and surrender of compulsory licence

54. (1) Upon the request of the owner of the patent or of the beneficiary of the compulsory licence, the Corporation 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 Corporation 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.

Patents 41

(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

Surrender of patent

55. (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.

(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.

Invalidation of patent

56. (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 31(1) 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 29A(4) by the person to whom the patent was granted or by his agent.

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

(3) Where 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.

Date and effect of invalidation

57. (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

Acts deemed to be infringement

58. Subject to subsections 37(1), (2) and (3) and section 38, an infringement of a patent shall consist of the performance of any act referred to in subsection 36(3) 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.

Patents 43

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.

Infringement proceedings

59. (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. Injunction and award of damages

60. (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.

Laws of Malaysia 44 ACT 291

(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 subsections 56(2) and (3) shall apply. Infringement proceedings by licensee and beneficiary of compulsory licence

61. (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 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.

Declaration of non-infringement

62. (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. Patents 45

(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 60(3).

PART XIII

OFFENCES

Applications in contravention of section 23A

62A. 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.

Publication of information in contravention of Registrar's directions

62B. 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.

Laws of Malaysia 46 ACT 291

Falsification of Register, etc.

63. 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.

Unauthorized claim or patent

64. (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.

Unauthorized claim that patent has been applied for

65. (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

Patents 47

(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 (1) (b) 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.

Misuse of title "Patent Registration Office"

66. 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.

Unregistered persons practising, etc., as a patent agent 66A. Any person who carries on business, practices, 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.

Offences by corporation

67. (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

Authorization of officer to exercise powers under this Part

68. (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 [Act 574].

(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. Powers of arrest

69. (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 in that he has furnished a false name or residence or that he is likely to abscond.

Patents 49

(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. Search with warrant

70. (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 thereinto;

(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.

List of things seized

71. 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. Laws of Malaysia 50 ACT 291

Return of things seized

72. 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.

Power of investigation

73. (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.

Examination of witnesses

74. (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 subsections (2) and (3).

Patents 51

(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.

Admission of statements in evidence

75. 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

Laws of Malaysia 52 ACT 291

(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.

Obstruction to search, etc.

76. 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.

Institution of prosecution

77. No prosecution for any offence under this Act shall be instituted except by or with the consent in writing of the Public Prosecutor.

Jurisdiction of subordinate Court

78. (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.

Patents 53

PART XIVA

INTERNATIONAL APPLICATIONS UNDER THE PATENT

COOPERATION TREATY

Interpretation

78A. For the purposes of this Part--

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

"international search" means a search conducted by the International Searching Authority appointed under Article 16 of the Treaty to discover relevant prior art with respect to the invention; "international phase" means the period beginning from the filing of an international application to the time the international application enters the national phase;

"national phase" means the period beginning from the performance, by the applicant, of the acts specified in subsection 780(1); "receiving office" means the national office or the intergovernmental organization with which the international application has been filed;

"elected office" means the national office of or acting for the State elected by the applicant under Chapter II of the Treaty; "designated office" means the national office of or acting for the State designated by the applicant under Chapter I of the Treaty; "international preliminary examination" means a preliminary and non-binding examination carried out by the International Preliminary Examination Authority appointed under Article 32 of the Treaty on the questions of whether the invention appears to be novel, involves an inventive step and is industrially applicable; "international application" means an application for a patent filed under the Treaty.

Laws of Malaysia⁵⁴ ACT 291

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

Application

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

Patent Registration Office as receiving office

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

Patent Registration Office as designated office

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

Patent Registration Office as elected office

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

Persons eligible for international application

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

Filing of an international application

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

(2) The request shall contain--

(a) a petition to the effect that the international application be processed according to the Treaty;

Patents 55

(b) the designation of the State or States in which protection for the invention is desired;

(c) the name, nationality and residence of the applicant; (d) the name and the place of business of the applicant's agent, if any;

(e) the title of the invention; and

(f) the name and address of the inventor.

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

Filing date and the effect of filing an international application 78H. (1) The Registrar shall accord as the international filing date the date of receipt of

the international application, if at the time of receipt--

(a) the applicant, or if the application is made by more than one applicant, at least one of them, is a citizen or resident of Malaysia;

(b) the international application is in the national language or English language;

(c) the international application contains at least the following elements:

(i) an indication that it is intended as an international application;

(ii) the designation of the State in which the protection for the invention is desired;

(iii) the name of the applicant;

(iv) a description; and

(v) a claim or claims.

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

Laws of Malaysia 56 ACT 291

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

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

(5) The international application which fulfills the requirements as listed in paragraphs (1) (a) to (c) and has been accorded an international filing date shall have the effect of a patent application under Part VI if Malaysia is a designated State in the application and the international filing date shall be considered to be the filing date.

Defects in international application

78I. (1) If an international application--

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

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

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

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

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

Patents 57

International application considered withdrawn

78J. (1) An international application shall be considered withdrawn if--

- (a) the applicant has failed to make the amendments within the prescribed time;
- (b) the prescribed fee has not been paid; or
- (c) the Registrar finds that any of the requirements as listed in paragraphs 78H(1) (a) to (c) are not complied with, after an international filing date has been accorded to the international application.

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

Processing of international applications

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

International Searching Authority

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

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

International Preliminary Examination Authority

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

Laws of Malaysia 58 ACT 291

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

International publication of international application and its effect

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

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

Entering the national phase

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

(a) submit to the Patent Registration Office in the national language or English language--

(i) a request in the prescribed form;

(ii) a description;

(iii) a claim or claims;

(iv) a drawing or drawings, where required; and

(v) an abstract; and

(b) pay the prescribed fee to the Patent Registration Office. (2) If the applicant does not comply with the requirements of subsection (1) the application shall be considered to be withdrawn. (3) Applications which have entered the national phase shall comply with the requirements of this Act.

Patents 59

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

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

Search similar to international search for national applications 78P. (1) Any applicant who files a national application with the Patent Registration Office may request that a search similar to an international search be carried out on such application. (2) The Patent Registration Office may subject a national application filed with it to an international search. (3) In such cases, the description and the claims contained in the application shall be presented in the languages specified by the International Searching Authority, and the search fees shall be paid for by the applicant.

Conversion of an international application into a national application

78Q. (1) Where a foreign receiving office has refused to accord a filing date to an international application, or the foreign receiving office has declared that the international application is considered withdrawn or the designation of Malaysia is considered withdrawn and copies of any document in the

application have been sent to the Patent Registration Office at the request of the applicant, the Patent Registration Office shall decide whether such refusal or declaration is justified under the Treaty or its rules. (2) If the Patent Registration Office finds that the refusal or declaration referred to in subsection (1) was the result of an error or omission, it shall treat the international application as if such error or omission had not occurred and shall treat the application as a patent application in accordance with the provisions of this Act.

Laws of Malaysia60 ACT 291

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

PART XV

MISCELLANEOUS

Power of Registrar to amend patent application

79. (1) The Registrar may, upon a request made by an applicant for a patent in accordance with patent 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.

Power of Registrar to amend patent

79A. (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.

Patents 61

(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.

Other powers of Registrar

80. (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) amend 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 (1) (a), (b) and (c) 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.

Exercise of discretionary power

81. 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.

Extension of time

82. Subject to subsection 27(1A), subsection 29A(8) and subsection 30(4), 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.

Laws of Malaysia 62 ACT 291

Extension of time by reason of error in Patent Registration Office

83. (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.

Certificate by the Registrar

83A. 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.

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. Patents 63

(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 authorized 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 authorization as determined in the decision; and

(b) where a decision has been taken under paragraph (1) (b), 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 wished to be heard.

(5) The exploitation of a patented invention in the field of semi-conductor technology shall only be authorized 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 authorization would remedy such anti-competitive practice.

(6) The authorization shall not exclude--

(a) the continued exercise by the owner of the patent of his rights under subsection 36(1); or

(b) the issuance of compulsory licences under Part X. (7) Where a third person has been designated by the Minister, the authorization 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

Laws of Malaysia 64 ACT 291

(b) the Government agency or the third person authorized 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 authorizing 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 authorization 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 authorization 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 authorized 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.

Refusal to grant patent by the Registrar

85. 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. Patent agents

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

Patents 65

(2) No person shall carry on business, practice, 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.

Regulations

87. (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;

Laws of Malaysia 66 ACT 291

(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. Appeal

88. (1) Any person aggrieved by any decision or order of the Registrar or the Corporation 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. Repeal and saving provisions

89. The Registration of United Kingdom Patents Act 1951 [Act 215], the Patents Ordinance of Sarawak [Sarawak Cap. 61], the Registration of United Kingdom Patents Ordinance of Sabah [Sabah Cap. 124] and the Patents (Rights of Government) Act 1967 [Act 53 of 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--

(i) so long as the original patent remains in force in the United Kingdom; or

*NOTE--Paragraph 89(c) shall be deemed to be and to have always been an integral part of section 89 from the date of coming into force of the principal Act--see subsection 45(2) of the Patents (Amendment) Act 1993 [Act A863].

Patents 67

(ii) until the expiration of twenty years from the date of application, whichever is the earlier.

Transitional

*90. (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--

(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-- (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.

(3) (Deleted by Act A863).

(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. *NOTE--Every grant made in Sarawak before the coming into force of this section and purported to have been made under subsection 90(1) or 90(2) of the principal Act is hereby declared to have been lawfully and validly made notwithstanding the omission of an express reference to the making of such grant--see the Patents (Amendment) Act 1993 [Act A863]. Laws of Malaysia 68 ACT 291

FIRST SCHEDULE

(Deleted by Act A1137)

SECOND SCHEDULE

[Section 17A]

MODIFICATIONS TO THE PROVISIONS OF THE ACT

APPLICABLE TO UTILITY INNOVATIONS

(1) (2)

Provisions of Modifications

the Act

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;

(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.

Patents 69

(3) A disclosure made under paragraph (2) (a)

shall be disregarded--

(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;

(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.".

Section 16 Substitute "utility innovation" for "invention". PART V 1. Substitute "certificate for a utility innovation" for "patent". (except as otherwise 2. Substitute "innovator" for "inventor". provided below) 3. Substitute "utility innovation" for "invention".

4. Substitute "a utility innovation" for "an invention". Section 19 Substitute therefor the following:

"Judicial 19. Where the essential elements of the utility assignment innovation claimed in--

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

for a utility (b) a certificate for a utility innovation, innovation

or a have been unlawfully derived from an

certificate invention or a utility innovation for which for a utility the right to the patent or the certificate innovation 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:

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.".

(1) (2)

Provisions of Modifications

the Act

Laws of Malaysia70 ACT 291

PART VI 1. Substitute "certificate for a utility innovation" for "patent".
(except as

otherwise 2. Substitute "innovator" for "inventor". provided

below) 3. Substitute "utility innovation" for "invention".

4. Substitute "an application for a certificate for a utility innovation" for "a patent application".

Section 28 Substitute "the claim" for "a claim or claims" in paragraph (1) (d).

Section 29 (Deleted by Act A863)

Section 31 1. In subsection (2)---

(a) (Deleted by Act A1137)

(b) (Deleted by Act A1137)

(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);

(d) substitute the following paragraph for paragraph (b): "direct the Registrar to record the certificate for a utility innovation in the Register for Certificates for Utility Innovations."

2. (Deleted by Act A1137) 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 35. (1) The duration of a certificate for a of certificate utility innovation shall be ten years from the for a utility filing date of the application.

innovation.

(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.

Patents 71

(2) Notwithstanding subsection (1), the

owner of a certificate for a utility innovation

may, before the expiration of the period of

ten 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.

(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 Gazette. PART VII 1. Substitute "certificate for a utility innovation" for "patent". (except as

otherwise 2. Substitute "utility innovation for which a certificate has provided been granted" for "patented invention".

below)

3. Substitute "application for a certificate for a utility innovation" for "patent application".

4. Substitute "utility innovation" for "invention". Section 37 1. In subsection (2)--

(a) substitute a full stop for the semi-colon at the end of paragraph (iii);

Laws of Malaysia72 ACT 291

(b) delete paragraph (iv).

2. Delete ", by the provisions on compulsory licences as provided in sections 51 and 52" in subsection (5). Section 38 In subsection (1)--

(a) substitute a full stop for the colon at the end of the first proviso;

(b) delete the second proviso.

PART VIII 1. Substitute "An application for a certificate for a utility innovation or a certificate for a utility innovation" for "A patent application or patent".

2. Substitute "an application for a certificate for utility innovation or a certificate for a utility innovation" for "a patent application or patent".

3. Substitute "the application for a certificate for a utility innovation" for "the patent application".

4. Substitute "certificate for a utility innovation " for "patent".

5. Substitute "utility innovation for which a certificate has been granted" for "patented invention".

PART IX 1. Substitute "certificate for a utility innovation" for "patent".

2. Substitute "utility innovation" for "invention".

3. Substitute "utility innovation for which a certificate has been granted" for "patented invention".

4. Substitute "application for a certificate for a utility innovation" for "patent application".

PART XI 1. Substitute "certificate for a utility innovation" for "patent".
(except as

otherwise 2. Substitute "utility innovation" for "invention". provided
below)

Section 55 Delete subsections (2) and (3A).

Section 56 1. Substitute the following paragraph for paragraph (2) (a): "(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 31(1);"

Patents 73

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).

PART XII Substitute "certificate for a utility innovation" for "patent".
(except as

otherwise

provided

below)

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, "beneficiary" means any licensee unless the licence contract
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 (3) (b). PART XIII 1. Substitute "certificate for a utility innovation" for "patent". (except as

otherwise 2. Substitute "product in respect of which a certificate for a provided utility innovation has been granted" for "patented product". below)

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 1. Substitute "certificate for a utility innovation" for "patent". (except in

section 86)

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).".

Laws of Malaysia74 ACT 291

LAWS OF MALAYSIA

Act 291

PATENTS ACT 1983

LIST OF AMENDMENTS

Amending law Short title In force from

Act A648 Patents (Amendment) Act 1986 01-10-1986

Act A863 Patents (Amendment) Act 1993 01-08-1995

Act A1088 Patents (Amendment) Act 2000 01-08-2001 Act A1137 Patents

(Amendment) Act 2002 03-03-2003 Act A1196 Patents (Amendment) Act 2003 14-08-2003 Patents 75

LAWS OF MALAYSIA

Act 291

PATENTS ACT 1983

LIST OF SECTIONS AMENDED

Section Amending authority In force from

3 Act A648 01-10-1986

Act A863 01-08-1995

Act A1137 03-03-2003

4 Act A648 01-10-1986

Act A863 01-08-1995

Act A1137 03-03-2003

5 Act A863 01-08-1995

Act A1137 03-03-2003

6 Act A1137 03-03-2003

7 Act A648 01-10-1986

Act A1137 03-03-2003

7A Act A648 01-10-1986

Act A1137 03-03-2003

8 Act A1137 03-03-2003

9 Act A648 01-10-1986

Act A1137 03-03-2003

9A Act A1137 03-03-2003

10 Act A863 01-08-1995

13 Act A648 01-10-1986

14 Act A648 01-10-1986

Act A863 01-08-1995

15 Act A648 01-10-1986

17 Act A648 01-10-1986

Act A863 01-08-1995

Act A1088 01-08-2001

Laws of Malaysia76 ACT 291

17A Act A648 01-10-1986

Act A863 01-08-1995

Act A1088 01-08-2001

17B-17c Act A863 01-08-1995

18 Act A863 01-08-1995

19 Act A863 01-08-1995

23A Act A648 01-10-1986

25 Act A863 01-08-1995

26A Act A648 01-10-1986

26B Act A648 01-10-1986

Act A863 01-08-1995

27 Act A863 01-08-1995

27A Act A863 01-08-1995

29 Act A863 01-08-1995

29A Act A863 01-08-1995

30 Act A648 01-10-1986

Act A863 01-08-1995

30A Act A648 01-10-1986

31 Act A863 01-08-1995

Act A1088 01-08-2001

32 Act A648 01-10-1986

Act A863 01-08-1995

32A Act A863 01-08-1995

33A-33c Act A863 01-08-1995

34 Act A648 01-10-1986

Act A1196 20-04-2006

35 Act A648 01-10-1986

Act A863 01-08-1995

Act A1088 01-08-2001

Act A1196 14-08-2003

35A Act A863 01-08-1995

Section Amending authority In force from

Patents 77

36 Act A648 01-10-1986

37 Act A648 01-10-1986

Act A863 01-08-1995

Act A1088 01-08-2001

38 Act A648 01-10-1986

Act A863 01-08-1995

42 Act A648 01-10-1986

45 Act A648 01-10-1986

46 Act A648 01-10-1986

49 Act A1088 01-08-2001

49A Act A648 01-10-1986

Act A863 01-08-1995

Act A1088 01-08-2001

Act A1137 03-03-2003

50 Act A648 01-10-1986

Act A1137 03-03-2003

51 Act A648 01-10-1986

Act A1137 03-03-2003

52 Act A1137 03-03-2003

Act A1196 20-04-2006

53 Act A1088 01-08-2001

Act A1137 03-03-2003

54 Act A1137 03-03-2003

55 Act A648 01-10-1986

56 Act A863 01-08-1995

58A Act A1088 01-08-2001

62A Act A648 01-10-1986

62B Act A648 01-10-1986

64 Act A863 01-08-1995

66A Act A648 01-10-1986

77 Act A1137 03-03-2003

Section Amending authority In force from

Laws of Malaysia78 ACT 291

78A-78Q Act A1196 20-04-2006

79-79A Act A863 01-08-1995

82 Act A648 01-10-1986

Act A863 01-08-1995

83-83A Act A863 01-08-1995

84 Act A648 01-10-1986

Act A1088 01-08-2001

85 Act A648 01-10-1986

86 Act A648 01-10-1986

Act A863 01-08-1995

87 Act A863 01-08-1995

88 Act A1137 03-03-2003

89 Act A648 01-10-1986

Act A863 01-08-1995

90 Act A648 01-10-1986

Act A863 01-08-1995

First Schedule Act A648 01-10-1986

Act A1137 03-03-2003

Second Schedule Act A648 01-10-1986

Act A863 01-08-1995

Act A1088 01-08-2001

Act A1137 03-03-2003

Section Amending authority In force from

DICETAK OLEH

PERCETAKAN NASIONAL MALAYSIA BERHAD,

KUALA LUMPUR

BAGI PIHAK DAN DENGAN PERINTAH KERAJAAN MALAYSIA