

Amendments to trade mark and patent regulations



By Su Siew Ling

The Malaysian Intellectual Property Office (MyIPO) has undertaken a series of amendments to the existing *Trade Marks Regulations 1997* and the *Patent Regulations 1986*. The amendments have just come into operation as of 15 February 2011 with relatively short notice to IP owners, practitioners and other stakeholders.

One notable change brought about by both of these amending regulations is an increase in official fees although the official fees for online filing have been reduced. Online filing will now officially be an alternative and preferred mode of filing applications given the discount in official online filing fees.

There has generally been a 30 to 50 percent increase in the official fees, and new fees have also been imposed on the filing of documents for a patent application, such as the filing of the power of attorney form and statement justifying the application. In trade mark applications, fees are imposed on request for ex-parte hearings before the Registrar. Thus, trade mark and patent applicants will have to brace themselves for an increase in the cost of protecting these intellectual assets in the country. The official fees had not been revised by MyIPO for some time, and the last revision of trade mark filing fees was back in 1997.

Other than the fee increase, the amendments are aimed at expediting the registration and granting of trade marks and patents. They introduce for the first time an avenue in which an applicant for a trade mark or patent may apply for an expedited examination of the trade mark or patent, as the case may be, within a prescribed time frame from the date of filing. There is no automatic grant of approval to a request to expedite examination, and an application to expedite examination must be accompanied by cogent reasons in the form of a sworn declaration.

Acceptable grounds for an expedited examination of a trade mark or patent include national or public interest, infringement proceedings (actual or prospective) and disbursement of

governmental or institutional funds where registration or grant of the respective right is a prerequisite.

If the request for expedited examination is approved, a trade mark that faces no adverse examination report or opposition is supposed to be registered just under seven months from the date of filing, whilst in the case of a patent with a clear examination report, it should be granted within two months from the lodging of the request for expedited substantive examination.

MyIPO has further truncated the time frame in which the trade mark owner must pay the advertisement/gazette fee, from the initial two month period to a mere one month. This will prove to be challenging for foreign trade mark owners, especially if instructions on filing are routed through their agents. There remains the possibility of extending the time to submit and pay the gazette fee, subject to payment of the requisite extension fee.

Likewise, for patents, in line with the strategy of MyIPO to reduce the period for granting patents, applicants must file a request for substantive examination (whether it is full or modified substantive examination) within 18 months of the filing date, which is six months earlier than under the previous regulations.

The amendments will affect all applications filed after 15th February 2011. There are bound to be teething problems and uncertainties in the implementation of these amendments and it remains to be seen if Malaysia can achieve a system that purports to register trade marks and grant patents in the shortest time frame, without sacrificing quality - a virtue which most trade mark and patent owners place an equal, if not greater, emphasis on.

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