



Intellectual Property Corporation of Malaysia

**SURAYA MOHAMAD @ AHMAD  
PATENT EXAMINER  
APPLIED SCIENCE  
(SEARCH AND EXAMINATION)**

**The Experience of the Intellectual Property Corporation  
of Malaysia (MyIPO) with “Modified Substantive  
Examination”  
30 November 2011**



## OUTLINE OF PRESENTATION

- \* Corporate Profile
- \* Patent System
- \* Modified Substantive Examination
- \* MyIPO Way Forward

i.

- The Intellectual Property Corporation of Malaysia (MyIPO) is established on 3rd March 2003 under the Intellectual Property Corporation of Malaysia Act 2002 (Act 617).

ii.

- fully autonomous in its administration and finance

## Objectives

Establish strong & effective administration

Strengthen IP laws

Provide comprehensive & user-friendly info on IP

Promote public awareness programmes on the importance of IP

Provide advisory services on IP

### Vision

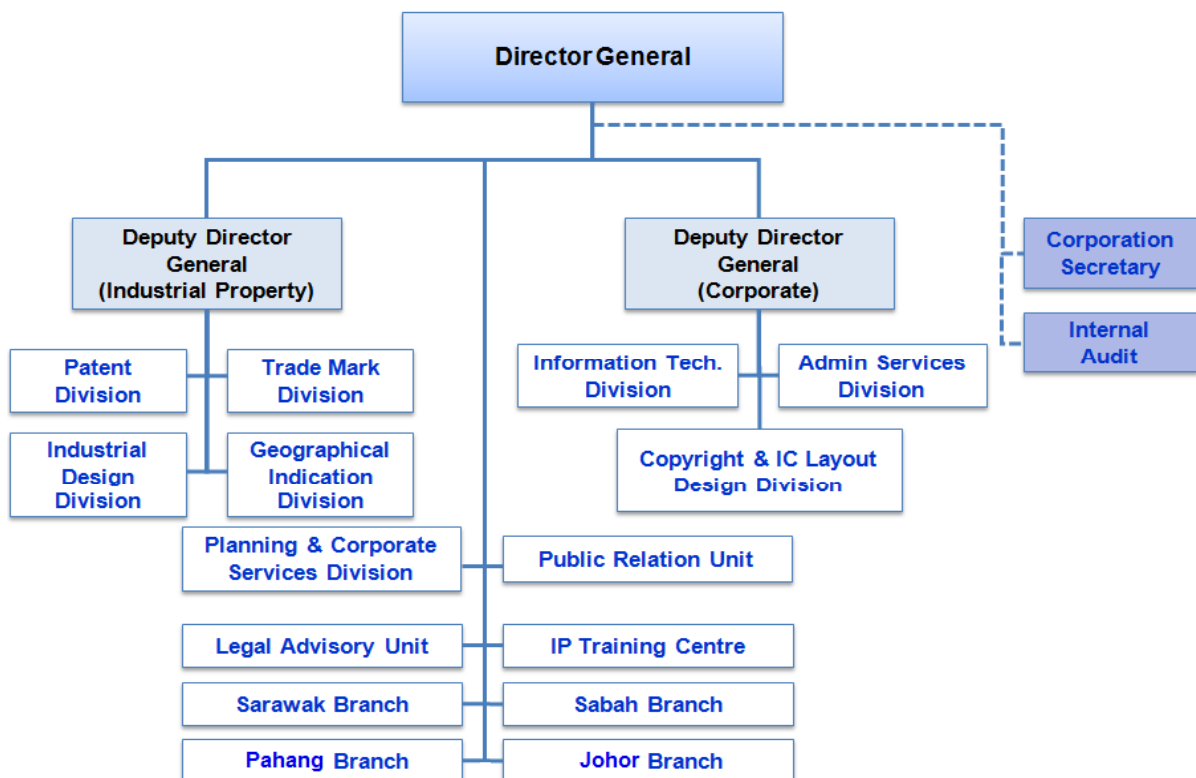
- To be one of the leading IP organizations

### Mission

- To provide strong legal infrastructure & effective administration regime in order to enhance greater creativity & exploitation of IP

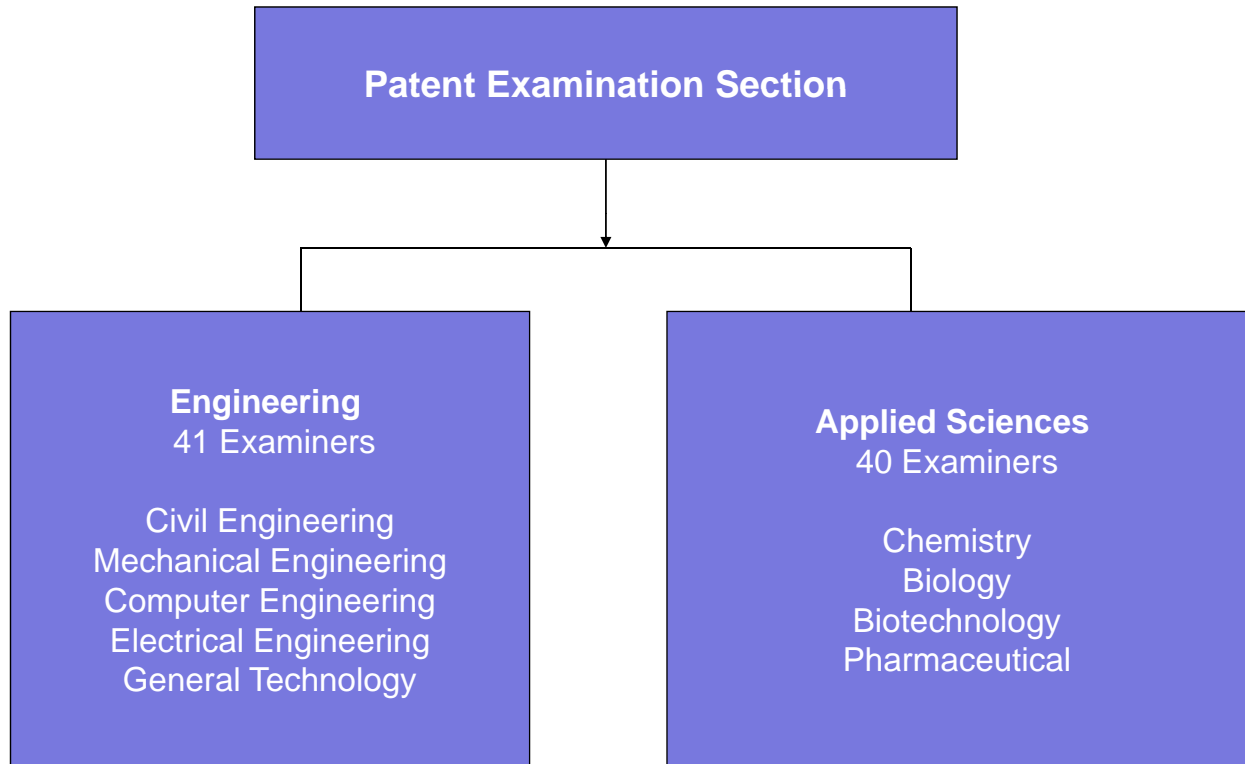
- Intellectual Property Corporation of Malaysia Act 2002
- Trade Marks Act 1976
- Patents Act 1983
- Copyright Act 1987
- Industrial Designs Act 1996
- Layout-Designs of Integrated Circuits Act 2000
- Geographical Indications Act 2000

- \* Malaysia is a signatory to the following treaties :
- World Intellectual Property Organization (1 January 1989)
  - Paris Convention (1 January 1989)
  - Berne Convention (1 October 1990)
  - Agreement on Trade Related aspect of Intellectual Property Rights (WTO – 1994)
  - Patent Cooperation Treaty (2006)
  - Nice Agreement (Sept 2007)
  - Vienna Agreement (Sept 2007)





# Patent Examination Section



Patent • Trade Mark • Industrial Design • Copyright • Geographical Indication • IC & Layout Design



# Patents Act & Regulation

## PATENTS ACT 1983

- Amendment 1986, 1993, 2000, 2002, 2003, 2006

## PATENTS REGULATIONS 1986

- Amendment 1990, 1995, 2001, 2006, 2011

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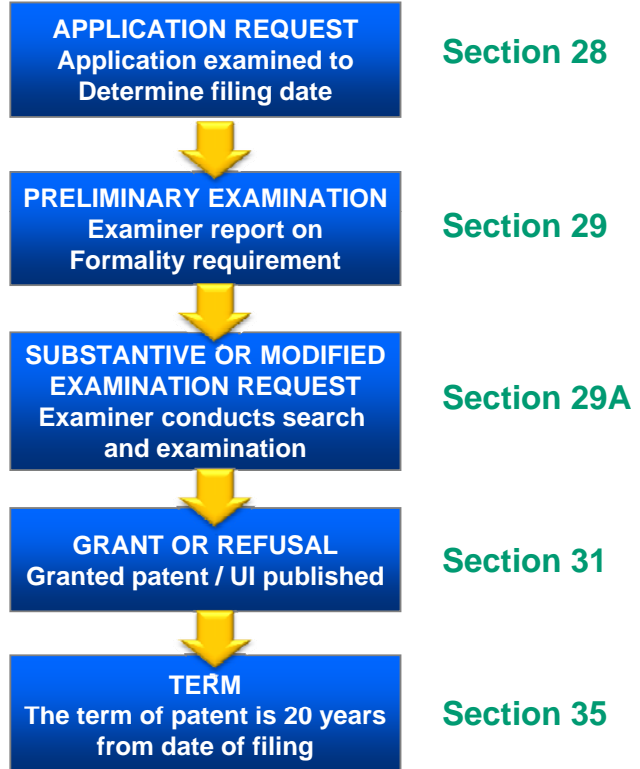
# Patent & Certificate For Utility Innovation Granting Procedure

Applicant must lodge Form 1 Request patent) or Form 14 Request (utility innovation), Prescribe fee, description, single claim for utility; claim(s) for patent and an abstract

Applicant must lodge Form 5 or 5A Request and prescribed fee, within 2 years from filing date (possibility for deferment)

Upon grant, the patentee or certificate owner has the right to institute Court-proceeding against any person using the invention or utility innovation without his permission

Subject to payment of annual renewal fees by patentee or certificate owner



## SUBSTANTIVE OR MODIFIED SUBSTANTIVE EXAMINATION

**SUBSTANTIVE OR MODIFIED EXAMINATION REQUEST**  
Examiner conducts search and examination

A request for Substantive (Form 5) or Modified Substantive (Form 5A) Examination has to be submitted together with the required fee within 2 years from the filing date  
(Form 5 : RM 950 / RM 1,100 @ Form 5A : RM 600 / RM 640 )



## MODIFIED SUBSTANTIVE EXAMINATION

- **Introduced in 1995**
- **It reflects the influence of Australian law in the Malaysian patent legislation**
- **As a result of patent backlogs with granted patent**



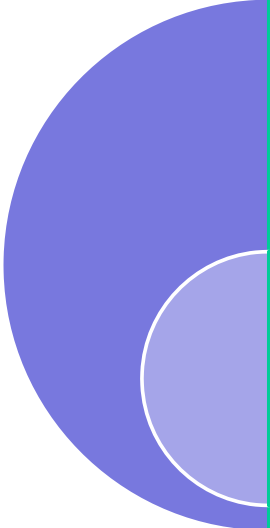
## MODIFIED SUBSTANTIVE EXAMINATION

**An application may be granted without substantive examination on the basis of a corresponding patent issued for an application filed in the prescribed country or under the prescribed treaty or Convention**

**When it is requested, the patent specification must be amended / in conformity with the granted patent on which the modified examination is based.**

## Regulation 27A of Malaysia Patents Act

A request for Modified Substantive (Form 5A) Examination shall be accompanied by:



i). a certified true copy of the patent granted to the applicant in the prescribed country or under the prescribed treaty or Convention

ii). the amendments required for the purpose of bringing the application into conformity with the granted patent

the prescribed country or under the prescribed treaty or Convention

Prescribed country means Australia, Japan, The Republic of Korea, The UK, The United States of America

Prescribed treaty or Convention means the European Patent Convention



The Examiner's primary concern is to check :



To bring the patent specification of the Malaysian application into substantial conformity with the foreign granted patent.

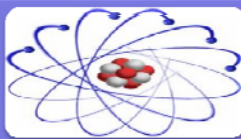


An appropriate prior art search is done



Requirements under Malaysia Patents Act fulfill

Non-patentable invention (Section 13) :



discoveries, scientific theories and mathematical methods



plant and animal varieties or essentially biological processes for the production of plants or animals, other than man-made living micro-organisms



schemes, rules or methods for doing business, performing purely mental acts or playing games

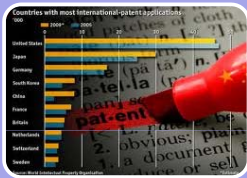


Methods for treatment of human or animal body by surgery or therapy, and diagnostic methods practiced on the human or animal body

## Advantages



Cheaper filing and prosecuting cost



No prior search needed unless a top up search is required



Prosecution of patent application may be shortened

## Disadvantages



Restriction requirement under Malaysia Patents Act 1983 e.g. Method of treatment, business method



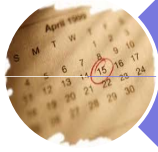
Assessment of novelty and inventive step



Issue of clarity, unity of invention



## MODIFIED SUBSTANTIVE EXAMINATION



No priority claim



Continuation In Part For  
US Patent



Conform to many granted  
patent



SI Unit

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## MyIPO Way Forward

**To rectify problems in the next amendment**

**Accession to key International Treaties e.g WCT,  
WPPT, Budapest Treaty, Madrid Protocol**

**To establish IP Academy**

**Malaysia as International Searching Authority (ISA)**


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# THANK YOU

**INTELLECTUAL PROPERTY CORPORATION OF  
MALAYSIA**

UNIT 1 – 7, GROUND FLOOR  
MENARA UOA BANGSAR  
NO. 5, JALAN BANGSAR UTAMA 1  
59000 KUALA LUMPUR

 : 603-2299 8400

 : 603-2299 8989

[www.myipo.gov.my](http://www.myipo.gov.my)

