



Intellectual Property Corporation of Malaysia

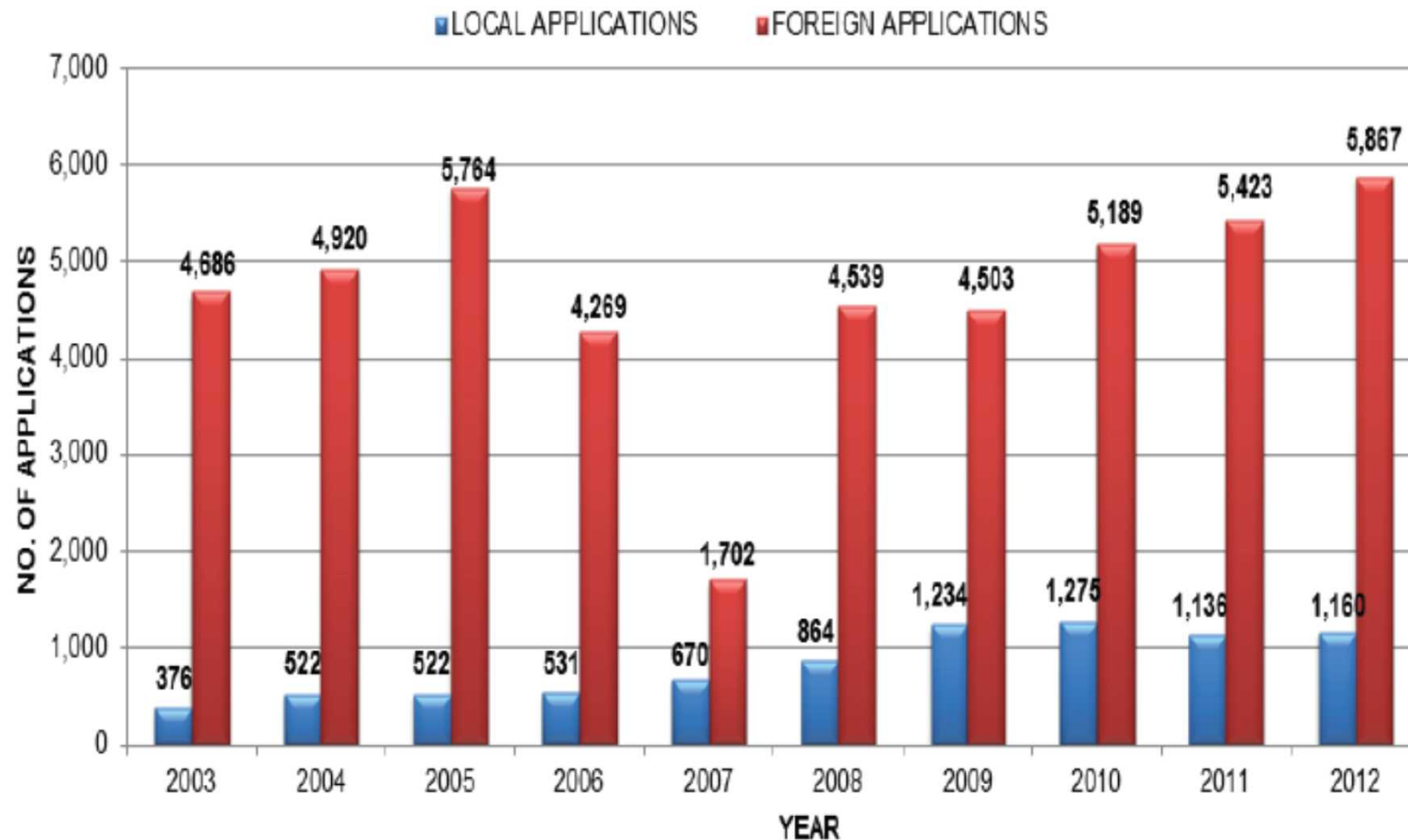
CHALLENGES OF EXAMINATION



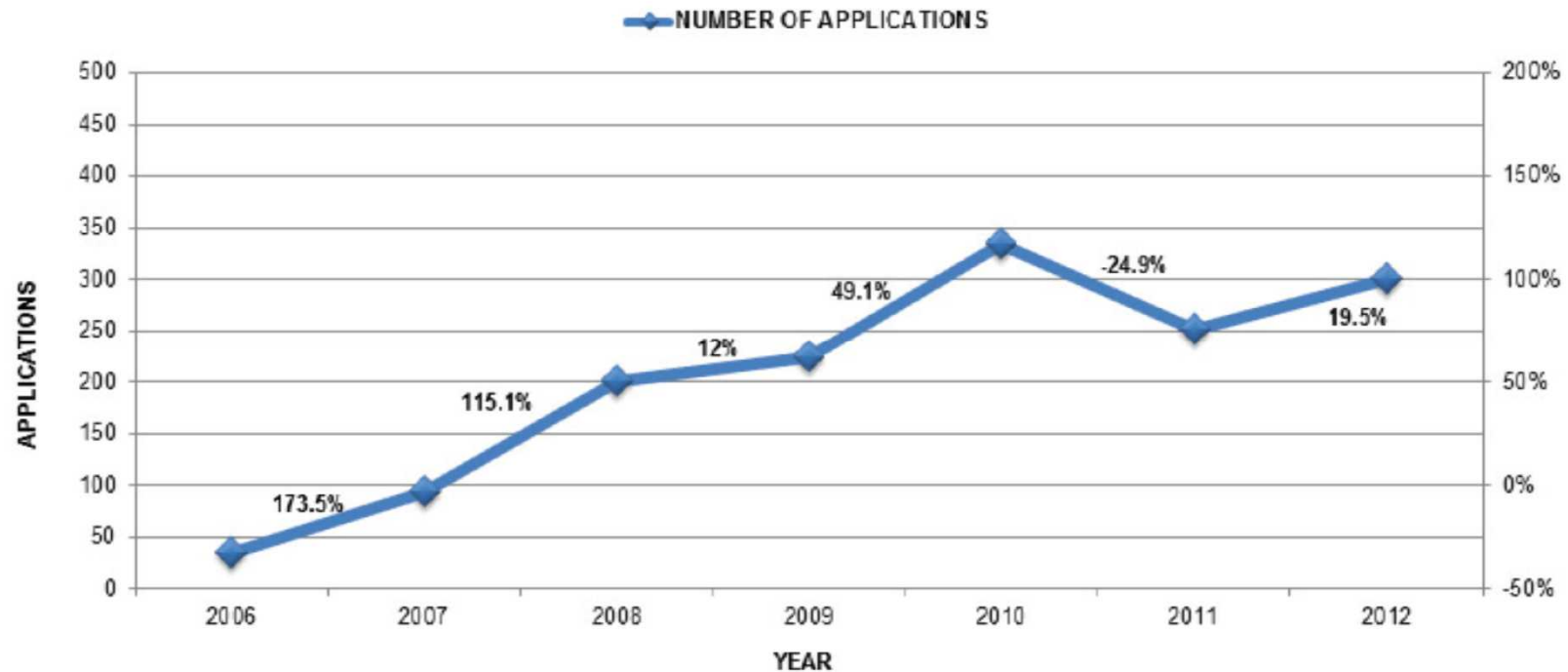
NOVEMBER 26-28, 2013

TOKYO

PATENT APPLICATIONS: Local vs Foreign



PCT APPLICATIONS

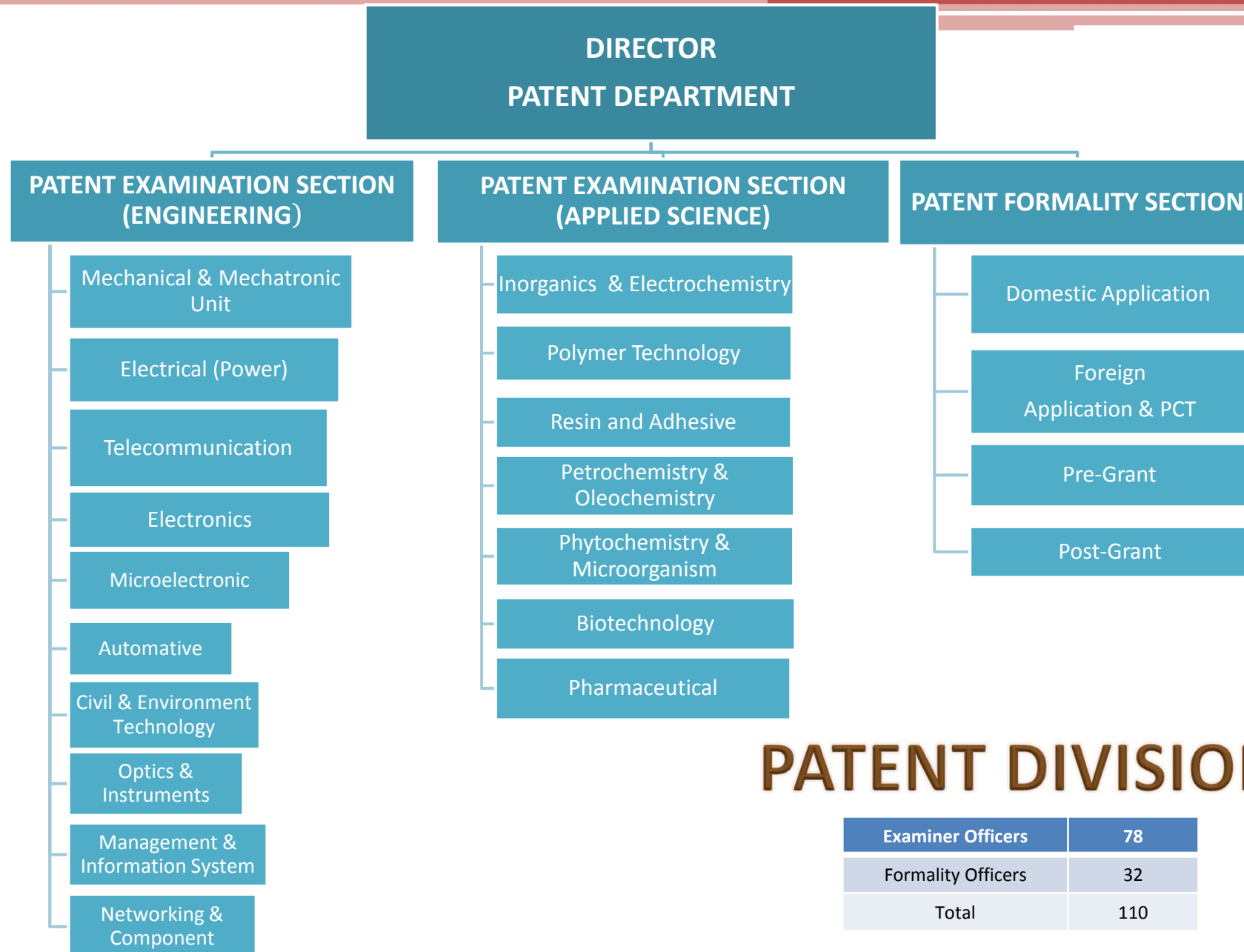


YEAR	2006	2007	2008	2009	2010	2011	2012
NUMBER OF APPLICATIONS	34	93	200	224	334	251	300
GROWTH RATE (%)		173.5%	115.1%	12%	49.1%	-24.9%	19.5%

PENDENCY OF EXAMINATIONS

Normal Track
(26 months for Clear Cut Case)

Expedited Examination
(20 months for Clear Cut Case)



2. a) How and to what extent do you use external examination results ?

We use external examination results from corresponding applications preferably from prescribed country or treaty/convention (EP/US/GB/JP/KR/AU/PCT).
[Reg. 27(6) and Reg. 27B(5)]

- b) Do you use results done by other offices, e.g., during their national phase of a PCT application; or do you use only the results from the international phase ?

We use both results as guidance.

3. Does your legislation explicitly authorize the examiner to request the applicant to submit information on whether the application has been filed elsewhere, and also copies of the external examination results ?

Yes, according to Malaysia Patent Act [Section 80(1)(c)] where the examiner may request any supporting documents or articles to assist him to make required assessment.

4. Does your legislation explicitly authorize granting of patents based on claims granted by certain other patent offices ?

Yes, according to Patent Act [Section 29A] where the applicant may request to conformity with granted patent available in prescribed country or treaty/convention (EP/US/GB/JP/KR/AU).

5. a) Are there any timelines that an examiner has to observe for processing an application?

No. But we do only have the timeline for the first action of examination (clear cut case) which is 26 months (Normal Track) and 20 months (Expedited Examination) from the Filing date.

- b) To what extent could an examiner wait for examination results from other IPOs ?

No. We do not wait for examination results from other IPOs .

6. Which resources do you use that permit access to examination results of other IP offices, e.g. AIPN, Espacenet, CCD, Patentscope, US PAIR,...What is your experience with using them?

- ✓ Espacenet
- ✓ EP-Register
- ✓ US Public Pair
- ✓ Patentscope
- ✓ AusPat
- ✓ AIPN (authorized user)
- ✓ K-PION (authorized user)

7. a) What databases do you use for prior art searches ?

We use subscribe databases such as Epoquenet and STN.

b) Do you use WIPO's ARDI or ASPI program ?

No.

8. Major challenges in substantive examination ? Ideas for better support through WIPO or other IPOs ?

Challenges	Issues	Solution
New Technology	<ul style="list-style-type: none"> ▪ Nanotechnology ▪ Green technology ▪ Cross Technology (IPC in class Y) 	<ul style="list-style-type: none"> ✓ Continuous attending Seminar/Conference organized by University and Industry ✓ Further study in particular field ✓ Sharing knowledge among IP Offices ✓ Attachment to University and Industry
Search Tools	<ul style="list-style-type: none"> ▪ Non-patent Literature 	<ul style="list-style-type: none"> ✓ Access to the non-patent Literature (WIPO' ARDI program)
	<ul style="list-style-type: none"> ▪ Lack of experience of using Epoquenet 	<ul style="list-style-type: none"> ✓ Organized more training with the expert
Quality of Specification and Examination Report	<ul style="list-style-type: none"> ▪ Lack of experience on patent drafting (local application) 	<ul style="list-style-type: none"> ✓ Organized seminar of patent drafting for local applicant
	<ul style="list-style-type: none"> ▪ To produce quality examination report 	<ul style="list-style-type: none"> ✓ Sharing knowledge regarding examination report among IP Offices

For more information, visit our website at:

<http://www.myipo.gov.my>

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THANK YOU