

10 Things You Need to Know about the Malaysian Patent Grant Process

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The processes for allowance and grant of patents in Malaysia differ significantly from those in many other jurisdictions. They are a common source of confusion and uncertainty. So, here are ten pointers that should help clarify the local practice.

1. Is a Notice of Allowance issued by MyIPO prior to grant?

Yes, upon the successful conclusion of the examination of an application, MyIPO will issue what is known as a substantive examination – clear report. This final report signals the intention to grant a patent and sets out the pages of the specification that will form the basis of the granted patent. It is normally accompanied by a draft bibliographic page of the patent that contains details such as the applicant, inventor, priority claim and invention title. If a search report has not been issued during prosecution, this may also accompany the clear report.

2. Do we need to pay an Issue Fee?

No. Malaysian patent practice does not provide for the payment of any issue fee, nor are any excess claims fees payable at this stage of the procedure.

3. Previously, we had to pay a Certificate Fee – why is this fee no longer required?

It is true that an official fee, the certificate fee, used to be payable to MyIPO in order to obtain the patent certificate and documents. However, this fee was abolished in 2011, when it was effectively absorbed into a higher substantive examination fee. For any application whose request for examination is filed on or after 15 February 2011, no certificate fee is payable. The certificate fee is still payable on legacy applications with earlier-filed examination request.

4. As no official fee is payable, what actions do we need to take to secure the grant?

Once a clear report has issued on an application, MyIPO will continue to process the application to grant automatically thereafter. Having said that, the clear report contains a request that the applicant review the information and documents that are the basis for grant, and inform MyIPO of any errors or oversights within seven days. Our firm carries out such a review routinely on our side and informs MyIPO promptly if we detect that anything is amiss or needs correcting.

5. Can we make amendments once an application has been allowed?

Once a clear report has issued, generally MyIPO's practice is to treat the examination of the application as closed. Therefore, normally MyIPO will not entertain further amendments at this stage of the procedure. In these circumstances, the applicant's options may be limited to waiting for grant to occur and then requesting a post-grant amendment, or filing a divisional application. As an exception, if an application proceeds to allowance directly, without any prior adverse report being issued, the applicant is allowed a term of two months from the mailing date of the clear report for the submission of any voluntary amendments. This policy was introduced effective 01 June 2016 under a practice note issued by MyIPO. If

the applicant does not intend to file amendments in this scenario, it is possible to inform MyIPO so as to avoid the grant process being paused for the two-month interval.

6. Is it still possible to file a Divisional Application after allowance but before grant?

When an objection of non-unity is raised in the examination procedure, the regular term for filing a divisional application is three months from the mailing date of the adverse report containing the objection. Otherwise, a voluntary divisional application may be filed within a regular term of three months from the mailing date of the first adverse report. Each regular term may be extended at the Registrar's discretion and upon payment of official fees that depend on the number of months of extension. The extension request may be filed together with the late divisional application. A divisional application must always be filed before the grant of its parent.

In order to reduce costs, as well as to avoid being unintentionally squeezed out of the option of filing a divisional application, clients are recommended to review their needs at the latest when the first adverse report is received. At this stage, a voluntary divisional application may be filed without incurring any extension fees.

In the exceptional case where an application proceeds to allowance directly, without any prior adverse report being issued, the applicant is allowed a term of three months from the mailing date of the clear report to file a voluntary divisional application. Again, this policy was introduced effective 01 June 2016 under a practice note issued by MyIPO. If the applicant does not intend to file a divisional application in this scenario, it is possible to inform MyIPO so as to avoid the grant process being paused for the three-month interval.

7. What is the typical interval between allowance and grant?

The number of patents granted by MyIPO has been increasing year-by-year since 2010, as shown by the following table:

| Year | 2010 | 2011 | 2012 | 2013 | 2014 | 2015 | 2016 | 2017* |
|---------|------|------|------|------|------|------|------|-------|
| Patents | 2177 | 2392 | 2501 | 2691 | 2762 | 2908 | 3353 | 4193 |

[* Jan~Sep]

Inevitably, this growing productivity has impacted processing time. The interval between issuance of the clear report and grant of the patent is not readily predictable. It may vary between a minimum of one or two weeks to several months depending on MyIPO's workload. Furthermore, there is often a considerable delay between formal grant of the patent and issuance of the patent certificate and documents. Rest assured that we keep tabs on the progress and send regular reminders to MyIPO when necessary.

8. What do the Patent documents consist of?

Apart from the patent certificate, the entire patent document includes a bibliographic page (which corresponds to what is published in the Government Gazette), a schedule of annuity payments, the clear report and the final, consolidated patent specification. Unless instructed otherwise, we shall send you the original documents by registered mail, with an electronic copy provided in advance.

9. Will there be any back annuities payable at the time of grant?

No. There are no maintenance fees payable on a pending application and similarly, upon grant, there will be no back annuities payable.

10. What is the Patent Term and when is the first renewal fee due?

All Malaysian patents with filing date on or after 01 August 2001 have a maximum term of 20 years, calculated from the filing date. That means the international filing date in the case of a PCT national phase application. The first renewal fee is due one year from the date of grant, and payable at the latest one day before the first anniversary of the date of grant. Each renewal fee may be paid up to six months late, subject to a surcharge.

In the case of a utility innovation certificate, the initial term is 10 years from the filing date, extendible by a further two periods each of five years. The first renewal fee is due two years from the date of grant, and may also be paid up to six months late with surcharge.

Conclusion

The year-on-year growth in the number of Malaysian patents being granted by MyIPO is a product of several factors: advance in the numbers of applications being filed, the increased availability of options such as PPH programs for expediting examination, the streamlined grant procedure following abolition of the certificate fee, as well as commendable efforts in the clearing of earlier backlogs. These changes bode well for the future of the patent system as earlier grant is one of the most commonly expressed needs of our clients, both locally and internationally.