



ICLG

The International Comparative Legal Guide to:

Patents 2013

3rd Edition

A practical cross-border insight into patents law

Published by Global Legal Group, in association with CDR, with contributions from:

Abreu Advogados

ALTIUS

Armengaud & Guerlain

Avvocati Associati Franzosi Dal Negro Setti

Bird & Bird LLP

Bloomfield-Advocates & Solicitors

CCPIT Patent & Trademark Law Office

Ehrlich & Fenster Patent Attorneys

Elzaburu

Fiebinger Polak Leon Attorneys-at-Law

Griffith Hack Lawyers

King & Spalding LLP

Law Offices of Patrinos & Kilimiris

Licks Attorneys

Nakamura & Partners

Olivares & Cía.

Pepeljugoski Law Office

Pham & Associates

Plesner

Roschier, Attorneys Ltd.

Rouse & Co. International

Schellenberg Wittmer

Subramaniam, Nataraj & Associates, Patent & Trademark Attorneys

SyCip Salazar Hernandez & Gatmaitan

Tay & Partners

Tilleke & Gibbins

TIPLO Attorneys-at-Law

Vasil Kisil & Partners



GLG

Global Legal Group

Contributing Editor

Gerry Kamstra,
Bird & Bird LLP

Account Managers

Dror Levy, Maria Lopez,
Florjan Osmani, Samuel
Romp, Oliver Smith,
Rory Smith, Toni Wyatt

Sub Editors

Beatriz Arroyo
Fiona Canning

Editor

Suzie Kidd

Senior Editor

Penny Smale

Managing Editor

Alan Falach

Group Publisher

Richard Firth

Published by

Global Legal Group Ltd.
59 Tanner Street
London SE1 3PL, UK
Tel: +44 20 7367 0720
Fax: +44 20 7407 5255
Email: info@glgroup.co.uk
URL: www.glgroup.co.uk

GLG Cover Design

F&F Studio Design

GLG Cover Image Source

Stock.xchng

Printed by

Ashford Colour Press Ltd
August 2012

Copyright © 2012

Global Legal Group Ltd.
All rights reserved
No photocopying

ISBN 978-1-908070-34-0

ISSN 2044-3129

Strategic Partners



General Chapters:

1	The Role of Expert Evidence in Patent Litigation across the World – Gerry Kamstra & Christian Harmsen, Bird & Bird LLP	1
2	Gulf Co-operation Council Countries – Patent Landscape – Sara Holder, Rouse & Co. International	8

Country Question and Answer Chapters:

3	Australia	Griffith Hack Lawyers: Wayne Condon & Eliza Mallon	11
4	Austria	Fiebinger Polak Leon Attorneys-at-Law: Constantin Kletzer & Sabine-Katharina Andreasch	19
5	Belgium	ALTIUS: Christophe Ronse & Olivier Vrins	26
6	Brazil	Licks Attorneys: Otto Licks & Marcela Trigo	32
7	China	CCPIT Patent & Trademark Law Office: Chuanhong Long & Lili Wu	39
8	Denmark	Plesner: Sture Rygaard & Caroline Thufason	46
9	Finland	Roschier, Attorneys Ltd.: Rainer Hilli & Johanna Flythström	53
10	France	Armengaud & Guerlain: Catherine Mateu & Anna van Biesbrock	59
11	Greece	Law Offices of Patrinos & Kilimiris: Constantinos Kilimiris & Tassos Kilimiris	64
12	India	Subramaniam, Nataraj & Associates, Patent & Trademark Attorneys: Hari Subramaniam	69
13	Israel	Ehrlich & Fenster Patent Attorneys: Dr. Gal Ehrlich & Adv. Roy Melzer	76
14	Italy	Avvocati Associati Franzosi Dal Negro Setti: Vincenzo Jandoli	82
15	Japan	Nakamura & Partners: Yoshio Kumakura & Yuriko Sagara	87
16	Macedonia	Pepeljugoski Law Office: Dr. Valentin Pepeljugoski	93
17	Malaysia	Tay & Partners: Linda Wang	100
18	Mexico	Olivares & Cia.: Alejandro Luna F. & Cesar Ramos, Jr.	106
19	Nigeria	Bloomfield-Advocates & Solicitors: Oyebokun Tolushuwa	113
20	Philippines	SyCip Salazar Hernandez & Gatmaitan: Enrique T. Manuel & Vida M. Panganiban-Alindogan	119
21	Portugal	Abreu Advogados: João Veiga Gomes & João Gonçalves Assunção	125
22	Spain	Elzaburu: Colm Ahern	132
23	Sweden	Roschier, Attorneys Ltd.: Erik Ficks & Björn Johansson	136
24	Switzerland	Schellenberg Wittmer: Andrea Mondini & Philipp Groz	142
25	Taiwan	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	150
26	Thailand	Tilleke & Gibbins: Nandana Indananda & Nuttaphol Arammuang	156
27	Ukraine	Vasil Kisil & Partners: Oleksiy Filatov & Tetiana Kudrytska	161
28	UAE	Rouse & Co. International: Sara Holder	167
29	United Kingdom	Bird & Bird LLP: Gerry Kamstra	172
30	USA	King & Spalding LLP: Holmes J. Hawkins III & Dawn-Marie Bey	179
31	Vietnam	Pham & Associates: Pham Vu Khanh Toan	186

Further copies of this book and others in the series can be ordered from the publisher. Please call +44 20 7367 0720

Disclaimer

This publication is for general information purposes only. It does not purport to provide comprehensive full legal or other advice. Global Legal Group Ltd. and the contributors accept no responsibility for losses that may arise from reliance upon information contained in this publication. This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.

Malaysia

Tay & Partners

Linda Wang



1 Patent Enforcement

1.1 How and before what tribunals can a patent be enforced against an infringer?

A patent is enforced by filing a patent infringement action at the High Court. There is a specialised Intellectual Property Court within the commercial division of the High Court in Kuala Lumpur. By and large, patent infringement actions are brought in that specialised Court, although actions arising outside the jurisdiction of the Kuala Lumpur High Court may be filed at the local High Court.

The action is commenced by filing a Writ which must be served on the defendant while it is valid. The Writ is valid for 6 months from the issue date and its validity may be extended twice for not more than 6 months each time. The Writ is usually served endorsed with the Statement of Claim. If it is not so endorsed, the Statement of Claim must be served no later than within 14 days of the defendant entering an appearance.

1.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

After the Writ is served, the defendant has limited time to enter an appearance and, thereafter, to file a defence and, if required, to submit a counterclaim together with particulars of the objection. Within 14 days, the plaintiff may file a reply to the defence and, if there is a counterclaim, file a defence to the counterclaim. The defendant may reply to the defence to counterclaim within 14 days. Pleadings are deemed closed after that.

The sealed Writ is usually endorsed with a first case management hearing date. Otherwise, the plaintiff must, within 14 days of the close of pleadings, file a request for case management.

There will be a number of case management hearings before trial. These hearings are to get the case ready for trial and directions are issued with that objective. The hearings also provide an opportunity for counsel to bring up issues relating to the trial, which they are unable to agree on, for the Judge's direction. The following are required to be completely prepared before trial dates will be fixed:

- (i) Identification of the issues for trial.
- (ii) Statement of agreed facts.
- (iii) Common documents for trial, which are segregated into 3 bundles: admitted bundle; agreed bundle; and non-agreed bundle.

- (iv) List of witnesses.
- (v) Witness statements which are to be filed and exchanged before the trial dates. The witness statement stands in place of the oral evidence in chief of the witness and is usually taken as read. Thus, on the day of the trial, a witness can be cross-examined soon after he takes the stand and after his statement has been formally marked into evidence.

Prior to trial, the judge may recommend or a party may request that the case be referred to mediation. The mediation is Court-assisted and may take place only if all the parties to the proceedings agree. Mediation hearings will be before a separately appointed High Court judge who is not the hearing judge. If there is no settlement resulting from the mediation, the case will go back to the hearing judge for trial. Such mediation hearings have had some degree of success in assisting parties to resolve matters without going through trial. It has also helped to reduce the case load of trial judges.

There is a general direction for trials to be heard and disposed of within 2 years of filing. On average, a case at the specialised Intellectual Property Court reaches trial within 2 to 3 years from commencement of an action.

1.3 Can a defence of patent invalidity be raised and if so how?

A defence of patent invalidity is available to a defendant or to any aggrieved person. Actions relating to patents are commenced at the High Court.

The defence is raised by filing a counterclaim together with particulars of the objection which must be sufficiently pleaded to enable the plaintiff to identify the grounds by which the patent in suit is said to be invalid. Unless sufficiently pleaded, a defendant may be precluded from relying on a piece of prior art or ground of objection.

1.4 How is the case on each side set out pre-trial? Is any technical evidence produced and if so how?

Parties set out their cases in their respective pleadings: the plaintiff in his statement of claim, reply to statement of defence and/or defence to counterclaim (if any); and the defendant in his statement of defence and, if applicable, the counterclaim and reply to the defence to counterclaim.

The evidence of chief witnesses including technical or expert evidence is contained in the witness statements. All documents including prior art documents, visual and/or audio-visual recordings, drawings, diagrams, models and physical products and

other materials relied on should as far as possible be made available to the other party and the court when the witness statements are filed and exchanged. The time by which witness statements must be exchanged varies according to the Judge's direction but it is in general about a week or two before trial. Once filed, the witness statement may not be substantially added to or amended unless with the other party's consent or the Judge's permission.

1.5 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

The plaintiff, who bears the burden of proof, begins the case by making an opening statement. The object is to provide the Judge with a brief description of the case and the essential points of evidence that will be covered by the witnesses. The plaintiff's witnesses are then called. With the witness statement standing in place of oral evidence in chief, each witness will be cross-examined and re-examined after taking the oath. The plaintiff's case is closed after all his witnesses have been called and examined. If he elects to adduce evidence, the defendant will then proceed to open his case and call his own witnesses. When all his witnesses have been called and examined, the defendant's case is closed.

Written closing speeches or trial submissions are common. These are usually directed to be filed within a specified time. Written reply to the opponent's submission will usually also be directed to be filed within a specified time. After the written submissions and reply are filed, a date will usually be fixed for counsel to take the Judge through the written submissions and also to respond to any questions or request for clarification which the Judge may have. The Judge will then fix a date for decision. Some Judges may dispense with the need for oral submission and/or clarification but it is recommended that counsel request it to be sure that the Judge correctly understands the submissions or is at least made aware of all the salient points of the submission.

A party may amend any pleading of his once before the pleadings are deemed to be closed. If the other party disagrees to the amendment, he may apply to the Court within 14 days of the amended pleading being served to have the amendment disallowed.

Leave of Court is required if the pleading is to be amended a second or subsequent time or after pleadings are closed. The Court has discretion to grant leave at any stage of the proceedings, before or at trial, or even after judgment or on an appeal. It must be shown that the amendment is necessary to enable the real issues between the parties to be tried, subject to penalties on costs. Leave will generally not be granted if the opposing party will be prejudiced or injured by the amendment in ways which cannot be compensated by costs.

1.6 How long does the trial generally last and how long is it before a judgment is made available?

The length of the trial largely depends on the number of witnesses who are called to testify. A patent trial may last from 3 days for more straightforward cases to about 15 days or longer for complex cases.

Judgment will usually be delivered within 4 to 8 weeks after closing submissions and reply submissions are filed.

1.7 Are there specialist judges or hearing officers and if so do they have a technical background?

The current Judge of the Intellectual Property Court and the

majority of the commercial Judges are not technically trained and do not have any technical background. The Judges are guided by the evidence and assistance given by expert witnesses during trial. It is therefore important for evidence, especially technical expert evidence, to be given in a manner which is clear and easy to follow.

1.8 What interest must a party have to bring (i) infringement (ii) revocation and (iii) declaratory proceedings?

- (i) The patentee has the right to bring patent infringement proceedings. Any licensee (unless precluded by the licence contract) or the beneficiary of a compulsory licence may sue for infringement if the patentee refuses or fails to file proceedings within 3 months of being requested to do so.
- (ii) Any aggrieved party may institute Court proceedings against the patentee to invalidate the patent.
- (iii) Any interested party has the right to request, by bringing proceedings against the patentee, that the Court declares that the performance of a specific act does not constitute an infringement. However, if the act in question is already the subject of infringement proceedings, the defendant may not institute proceedings for a declaration of non-infringement.

1.9 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The rules relating to discovery apply. The process of discovery can be initiated by serving the requisite notice, requesting production and the inspection of the documents from the opposing party. The Court may compel adherence with the request if there is refusal or failure to comply with the initial request. Documents claiming legal privilege are precluded from discovery. Confidential documents which are not legally privileged are not excused from disclosure if it is established that they are relevant evidence to the issues in dispute. The use and disclosure of confidential documents and information can, however, be made subject to restrictions and limitations by a Court order or by mutual agreement of the parties.

1.10 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of but not all of the infringing product or process?

The Patents Act 1983 makes no provision for secondary infringement. A finding of infringement is made only if the product or process falls within the scope of protection of the patent in suit. If only part is supplied, and not all of the essential integers of the independent claim/s are met, there will be no infringement.

1.11 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

There is infringement if a product obtained directly by means of the patented process is imported, notwithstanding that the process was carried on outside Malaysia.

1.12 Does the scope of protection of a patent claim extend to non-literal equivalents?

The Malaysian Courts take a "purposive approach" to claim construction. A literal interpretation of the claim is avoided and the Court will seek to give the patentee the full extent of the monopoly

which a reasonable person, ordinarily skilled in the art, reading the claim in context, would think he was intending to claim. The question is always what a person skilled in the art would have understood the patentee to be using the language of the claim to mean.

1.13 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

Any of the following may invalidate a patent:

- (i) what is claimed as an invention is not an invention within the meaning of the Patents Act 1983 or is excluded from protection or is not patentable;
- (ii) the description or the claim does not comply with requirements of the Act;
- (iii) any drawings which are necessary for the understanding of the claimed invention have not been furnished;
- (iv) the right to the patent does not belong to the plaintiff; or
- (v) incomplete or incorrect information was deliberately provided or caused to be provided to the Registrar by the patentee or his agent during prosecution.

1.14 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

Issues of validity and infringement of a patent are determined by the High Court. The Patent Office has no jurisdiction to hear such matters.

The Court has discretion to stay infringement proceedings pending resolution of validity in another Court. It is not uncommon for a transfer to be ordered so that both actions are before the same Court. The Court may then hear the invalidation action first, or hear both matters together in one trial sitting.

1.15 What other grounds of defence can be raised in addition to non-infringement or invalidity?

Other grounds of defence that can be raised include that the alleged infringing acts:

- (i) are not for industrial or commercial purposes or for scientific research only;
- (ii) are for uses reasonably related to the development and submission of information to the relevant authority which regulates the manufacture, use or sale of drugs;
- (iii) relate to parallel imports;
- (iv) are for the use of the patented invention on any foreign vessel, aircraft, spacecraft or land vehicle temporarily in Malaysia;
- (v) are time-barred; or
- (vi) that the defendant was, in good faith at the priority date, already making or using the patented invention in Malaysia or had made serious preparations towards the same.

1.16 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

A preliminary injunction is a discretionary remedy and is granted if:

- (i) there is a serious issue to be tried (i.e. that an arguable case exists);
- (ii) damages is not an adequate remedy for the plaintiff; and
- (iii) there is doubt as to the adequacy of the respective remedies in damages available to either party or to both, and the “balance of convenience” weighs in favour of granting the injunction. The

“balance of convenience” process involves weighing and balancing the risk of doing an injustice by considering various relevant factors, including whether the alleged infringing product has long been in the market or is a new entrant, the ability of the respective parties to compensate the other should it fail at trial, etc. Almost without exception, a plaintiff is required to provide an undertaking as to damages before a preliminary injunction will be granted. The plaintiff gives the undertaking to the Court that it will make good any damage which the defendant may suffer by reason of the preliminary injunction. Some evidence of the plaintiff’s financial ability to meet the undertaking is required.

The plaintiff is granted a final injunction upon a successful trial although a defendant may ask for it to be stayed if it is appealing against the trial judgment. Stay is not readily granted. Special or exceptional circumstances warranting stay will need to be established.

1.17 On what basis are damages or an account of profits estimated?

Damages, or an account of profits, are assessed after the trial in separate proceedings before the Court Registrar. The assessment proceedings are based on affidavit evidence although the Registrar has discretion to require witnesses to be produced for examination.

The claimant must elect whether to pursue damages or an account of profits. The latter is not often elected because disclosure is usually not satisfactory to know if the account given is a true reflection of the defendant’s profits. If damages are pursued, the claimant must set out the basis of assessment and prove his claim. Damages are generally claimed under three broad headings: loss of profits or revenue; loss of opportunity; and injury to reputation and goodwill. Other expenses actually incurred by reason of the infringement, such as costs of advertisements or publications to warn the public of infringing products, can also be claimed as part of damages.

The purpose of awarding damages is to compensate the plaintiff for the loss and injury (including injury to reputation and goodwill) suffered due to the infringement, and not to punish the defendant or enrich the plaintiff.

1.18 What other form of relief can be obtained for patent infringement?

The Court may additionally order (i) delivery and/or destruction of the infringing items and/or tools or equipment used to manufacture the infringing items, (ii) publication of the judgment in newspapers or trade publications at the defendant’s costs, and (iii) publication of a public apology by the defendant.

1.19 Are declarations available and if so can they address (i) non-infringement and/or (ii) claim coverage over a technical standard or hypothetical activity?

Declarations addressing non-infringements are available. There is as yet no Malaysian Court judgment giving declarations addressing (ii) above. A declaration will only be granted if it is proved by the evidence and would resolve the dispute between the parties. The Court will not likely entertain declaratory proceedings on a hypothetical situation or one which is a purely academic exercise.

1.20 After what period is a claim for patent infringement time-barred?

The action is time-barred after 5 years from the act of infringement.

1.21 Is there a right of appeal from a first instance judgment and if so is it a right to contest all aspects of the judgment?

There is a right of appeal from a first instance judgment (High Court) to the Court of Appeal in respect of the whole or any part of the judgment. An appeal from the Court of Appeal to the Federal Court (apex court) requires leave of the latter.

1.22 What are the typical costs of proceedings to first instance judgment on (i) infringement and (ii) validity; how much of such costs are recoverable from the losing party?

More often than not, infringement and validity are heard together. Typical costs to first instance judgment on infringement alone would be in the region of RM150,000 to RM600,000 depending on the complexity of the case, number of witnesses and length of trial. If invalidity is also an issue, costs can go up to more than RM1,000,000. A successful party can expect to recover about 50% to 80% of his incurred costs on taxation.

1.23 Can a defendant that is found to infringe and is ordered to pay damages by a final non-appealable decision of the Court apply to set aside the order if the patent is subsequently revoked by another party?

It is unlikely that an application to set aside in such a circumstance will be allowed. The opposing party will no doubt raise *res judicata*. If the plaintiff still decides to proceed to assess damages or to sue for contempt based on disobedience of any injunctive order granted, the fact that the patent is revoked may then be raised at these proceedings, to say that no damages are payable and no injunction can be effective as the patent is revoked (this is on assumption that the revocation order is also final and non-appealable). Thus, even if the decision is not set aside, it will be challenging for the plaintiff to enforce the order in the face of a revocation order by a Court of the same or higher jurisdiction.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant and if so how?

Provided there is no pending Court action in which the validity of the patent may be contested, the patent may be amended to correct a clerical error or an obvious mistake, or for any other reason acceptable to the Registrar, by filing a request and paying the prescribed fees. Amendments having the effect of adding subject matter or extending the protection conferred at the time of grant are not permissible.

2.2 Can a patent be amended in *inter partes* revocation proceedings?

The Court has discretion to allow amendments to the patent in revocation proceedings, taking into account the effect on validity by the proposed amendments. Amendments which add subject matter or which extend the protection conferred at the time of grant are not permitted.

2.3 Are there any constraints upon the amendments that may be made?

Please refer to questions 2.1 and 2.2 above.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

A term of a licence contract is invalid if it imposes upon the licensee restrictions not derived from the rights conferred on the patentee by the Patents Act 1983, or which are unnecessary for the safeguarding of such rights. The Competition Act 2010 (which came into force on 1 January 2012) will govern agreements including patent licences to prohibit anti-competitive agreement or conduct, and to penalise commercial practice which is an abuse of dominant position.

3.2 Can a patent be the subject of a compulsory licence, and if so how are the terms settled and how common is this type of licence?

A compulsory licence is possible but it is not common. The applicant proposes the terms of the compulsory licence in his application and the terms are determined after consideration by the Intellectual Property Corporation of Malaysia. Any party aggrieved by the determination of the Corporation may appeal to the High Court.

4 Patent Term Extension

4.1 Can the term of a patent be extended and if so (i) on what grounds and (ii) for how long?

The term of a patent cannot be extended.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable and if not what types are excluded?

The following are not patentable, though they may be inventions coming within the Patents Act 1983:

- discoveries, scientific theories and mathematical methods;
- plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes;
- schemes, rules or methods for doing business, performing purely mental acts or playing games; or
- methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body (but products used in any such methods can be patentable).

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

Such a duty is not expressly imposed by the Patents Act 1983. However, deliberately providing incomplete or incorrect information to the Registrar is a ground for patent invalidation. There is therefore risk of invalidity if the failure to disclose prejudicial prior documents amounts to such a ground.

5.3 May the grant of a patent by the Patent Office be opposed by a third party and if so when can this be done?

There is no procedure for a third party to oppose the grant of a patent.

5.4 Is there a right of appeal from a decision of the Patent Office and if so to whom?

Any person aggrieved by a decision of the Registrar or the Intellectual Property Corporation may appeal to the High Court. There is a further right of appeal to the Court of Appeal. The decision of the Court of Appeal is final, unless leave to appeal to the Federal Court is obtained.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

Such disputes may be resolved by filing an action at the High Court; declaratory judgments may be sought. After filing of the action, parties may opt for Court-assisted mediation prior to trial. The mediation will be led by a mediation judge who is not the hearing judge. Parties may also attempt resolution outside the Court system, via mediation or arbitration.

5.6 What is the term of a patent?

The term of a patent is 20 years from the filing date of the application.

In either of the following circumstance, the term is 20 years from the filing date or 15 years from the date of grant, whichever is longer:

- (i) the application was pending on 1 August 2001; or
- (ii) the patent has been granted and remained in force on 1 August 2001.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products and if so how quickly are such measures resolved?

There is currently no legal provision or mechanism for seizing or preventing the importation of infringing products.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

The Competition Act contains nothing to prevent grant of relief for patent infringement. The Patents Act expressly provides that if infringement has been or is being committed, the Court shall award damages and shall grant an injunction to prevent further infringement and any other legal remedy.

7.2 What limitations are put on patent licensing due to antitrust law?

Contractual terms which have the object or effect of significantly preventing, restricting or distorting competition for goods or services in any market in Malaysia are prohibited. However, if there are significant technological, efficiency or social benefits directly arising from the anti-competitive agreement or conduct, then it may be excused. In questions posed to it, the Competition Commission ("MyCC") has explained that it is not against an IP rights holder being a monopoly or dominant. It is, however, concerned with abuse of dominant position. The imposition of an excessive licence fee, for example, may constitute abuse of dominant position and if so, the IP owner will have to show that the fee is not unfair or unreasonable. Separate guidelines to address intellectual property rights, which hopefully will throw more light on the matter, are expected to be issued by MyCC within 2012 or by the early part of 2013.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

The Registry has continued with efforts implemented in 2011 to improve the procedures and shorten the pendency period for the registration of patent. It continues to work towards shortening the prosecution process to 26 months, and to 20 months for applications approved to be on a fast track basis without examination objection. The use of e-filing is still low and the Registry is looking into measures to encourage greater use of it.

8.2 Are there any significant developments expected in the next year?

A significant development would be the coming into force of the proposed amendments to the Patents Act 1983. They are now scheduled to be finalised and take effect by end 2012 or early 2013. Included within the proposed amendments are provisions for patent term restoration and compulsory licences for public health.

8.3 Are there any general practice or enforcement trends that have become apparent in Malaysia over the last year or so?

There has been a noticeable increase in the number of patent litigation cases brought before the Court in the last few years. The present availability of a specialised Intellectual Property Court and a greatly expedited Court system are likely to have contributed to that increase.



Linda Wang

Tay & Partners
6th Floor, Plaza See Hoy Chan
Jalan Raja Chulan
50200 Kuala Lumpur
Malaysia

Tel: +603 2050 1888
Fax: +603 2072 6354
Email: linda.wang@taypartners.com.my
URL: www.taypartners.com.my

Linda has practised exclusively in the area of Intellectual Property & Technology for more than 20 years and heads this practice group at the law firm of Tay & Partners in Kuala Lumpur, Malaysia. She is experienced in matters relating to patents, trade marks, industrial designs and copyright; and the litigation, protection and enforcement of such rights. Linda frequently conducts trials and appeal hearings relating to patents, trade marks and other intellectual property disputes at all levels of the court including the apex Federal Court. She also represents major clients in telecommunication, entertainment and media industries and has a special interest in the exploitation of rights in the new media. Linda is consistently identified in surveys by major legal directories as a leading lawyer in Malaysia in recognition of her work and expertise in the area of Intellectual Property & Technology.



Tay & Partners' presence and philosophy are built on a bedrock of solid legal expertise combined with a business-oriented approach. We build our reputation by presenting clients with innovative and practical solutions. This enables us to perform in a manner that exceeds expectations and sets us apart as true experts, backed by a track record honed from extensive experience.

Our clients refer to us as their strategic alliance - to us that just means we are reliable, trustworthy and an ally to their business.

We are at the forefront of the Malaysian intellectual property industry and have been consistently recognised for our practice in Intellectual Property in surveys by major legal directories. We have also been consecutively voted as a leading law firm in Malaysia for Intellectual Property & Technology.

Other titles in the ICLG series include:

- Aviation Law
- Business Crime
- Cartels & Leniency
- Class & Group Actions
- Commodities and Trade Law
- Competition Litigation
- Corporate Governance
- Corporate Recovery & Insolvency
- Corporate Tax
- Dominance
- Employment & Labour Law
- Enforcement of Competition Law
- Environment & Climate Change Law
- Gas Regulation
- Insurance & Reinsurance
- International Arbitration
- Lending & Secured Finance
- Litigation & Dispute Resolution
- Merger Control
- Mergers & Acquisitions
- PFI / PPP Projects
- Pharmaceutical Advertising
- Private Client
- Product Liability
- Project Finance
- Public Procurement
- Real Estate
- Securitisation
- Telecoms, Media & Internet
- Trade Marks



59 Tanner Street, London SE1 3PL, United Kingdom
Tel: +44 20 7367 0720 / Fax: +44 20 7407 5255
Email: sales@glgroup.co.uk

www.iclg.co.uk