Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

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Country:

Malaysia

IP Office

MALAYSIAN INTELLECTUAL PROPERTY OFFICE

Job title

ASSISTANT DIRECTOR OF POLICY AND INTERNATIONAL AFFAIRS DIVISION

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Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.
It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

A. Prior Art

1. How is prior art defined under the applicable national or regional law?

Malaysian Patents Act 1983, Section 14(2).
Prior art shall consist of everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention.

2. Against which date is prior art assessed under the applicable law?

Malaysian Patents Act 1983, Section 14 (2).

Against the priority date of the patent application claiming the invention.

3. Which types of information may constitute prior art under the applicable law, and how is it determined whether such information is considered to form part of the prior art?

Prior to the priority date claimed.

Written publications, patent documents, digital or online disclosures, or other publicly accessible information.

Limitation: oral disclosures, public use, sales and partially/restricted publish of technical documents.

4. Does the applicable law provide for any category of prior art that is taken into account for patentability purposes notwithstanding that it was not publicly available before the relevant filing or priority date (sometimes referred to as "secret prior art")?

No

If yes, please indicate, where applicable, the types of information or documents concerned (for example, earlier-filed patent applications), the relevant date(s) for determining such prior art, as well as any limitations, exclusions, or special rules applicable to such prior art. :

5. Please provide any additional information that may be relevant to the understanding or application of prior art under the applicable law, including where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

MyIPO Patent Examination Guidelines 2023.

Please upload any document that may be relevant to the understanding or application of prior art under the applicable law.

PATENT_EXAMINATION_GUIDELINES_2023.pdf

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Malaysian Patents Act 1983, Section 17.

B. Novelty

1. How is the requirement of novelty defined under the applicable national or regional law?

Malaysian Patent Act, Section 14.
An invention is new if it is not anticipated by prior art.

2. For the purposes of assessing novelty under the applicable law, are there any novelty-specific considerations regarding the relevant date or the scope of information taken into account, beyond those addressed in the Prior Art section of this survey?

None

3. Does the applicable law apply an absolute novelty requirement, or does it provide for any limitations or qualifications to novelty (for example, relative novelty or other restricted approaches), apart from any grace period mechanisms addressed separately in this survey?

Under Malaysian patent law, several contextual factors influence what is taken into account as prior art when assessing novelty. First, the geographic scope is global, meaning that disclosures made anywhere in the world are relevant, with no distinction between domestic and foreign disclosures. Second, the form of disclosure is not limited; prior art may arise from patent documents and non-patent literature. Accordingly, public accessibility is key, and confidential or secret disclosures are generally excluded from consideration.

In addition, earlier-filed Malaysian patent applications that are published later may be considered prior art for novelty purposes only. The timing of disclosures is assessed against the priority date (or filing date) of the application. Malaysian law also provides a limited 12-month grace period for certain disclosures made by the inventor or derived from them, such as unauthorized disclosures or disclosures at recognized exhibitions, which may be excluded from prior art if specific conditions are satisfied. These factors collectively shape the scope of prior art in Malaysia for the purpose of assessing novelty.

4. Apart from the approach described in question 3, are there any specific rules or contextual factors that affect what is taken into account as prior art for the purposes of assessing novelty under the applicable law?

As described in question 3.

5. Please provide any additional information relevant to the requirement of novelty under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or other interested parties, captured by patent office practice.

None

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Malaysian Patents Act 1983, Section 14 & Section 17.

C. Inventive Step

1. How is the criterion of inventive step or non-obviousness defined under the applicable national or regional law?

Malaysian Patents Act 1983, Section 15.
An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under paragraph 14(2)(a), such inventive step would not have been obvious to a person having ordinary skill in the art.

Techniques such as "mosaicking" or "wind surfing" (often referred to as the Windsurfing/Pozzoli approach) may be employed, which involve combining multiple prior art references where appropriate and systematically analyzing the inventive concept, the differences from the prior art, and whether those differences would have been obvious to the skilled person.

2. For the purposes of assessing inventive step or non-obviousness under the applicable law, what is the relevant date and what prior art or information is taken into account?

Under the Malaysian Patents Act 1983, the relevant date is the priority date (or filing date if none claimed). Assessment is from the perspective of a person having ordinary skill in the art at priority/filing date.

Prior art includes all publicly available information worldwide before the priority date, regardless of form. Examiners identify the closest prior art and compare it with the claimed invention. Other prior art may be considered if a person having ordinary skill in the art would combine it.

3. What is the standard applied under the applicable law to determine whether an invention involves an inventive step or is non-obvious, in particular as reflected in the concept of the “person skilled in the art”, focusing on how the standard is understood or applied, rather than its formal legal definition?

The "person skilled in the art" is presumed to be a skilled practitioner in the relevant field of technology who is possessed of average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date. The skilled person is also presumed to have had access to everything in the "state of the art", in particular the documents cited in the search report, and to have been in possession of the means and capacity for routine work and experimentation which are normal for the field of technology in question. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist
in that field is the person qualified to solve the problem. The skilled person is involved in constant development in the relevant technical field. The skilled person may be expected to look for suggestions in neighbouring and general technical fields or even in remote technical fields, if prompted to do so.

4. Are there any specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness under the applicable law?

Yes

Please indicate, where relevant, whether such rules or factors include geographic or territorial considerations affecting the relevance of prior art (for example, distinctions between domestic and foreign disclosures, uses, or publications, or territorial conditions applicable to particular categories of prior art) or any other particular considerations relevant to the assessment.

***Responses should be limited to such contextual factors asthey relate to the assessment of inventive step or non-obviousness, without restating general rules on what constitutes prior art.*:** The Starting Point for the Inventive Step Consideration The applicant may set out the starting point for the inventive step consideration, often by stating the problem to be solved, or by setting out the prior art. However, Examiners are not bound by such statements by the applicant, and can approach the consideration from a different direction. In some cases, the same invention may be arrived at from an attempt to solve different problems, in some cases with a different level of inventive step. Any document from the prior art as set out in Section 14(2) may be used as the starting-point for an inventive step objection. As a consequence, an inventive step objection will not be overcome by merely arguing that the person skilled in the art would have been unaware of the document, if that document has been made public anywhere in the world, in any language, at any time before the priority date. Inventive Step Test In order to assess inventive step in an objective and predictable manner, the following approach is applied: (i) Identify the claimed inventive concept. (ii) Assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, at that date, common general knowledge of the art in question. (iii) Identify what, if any, differences exist between the matter cited as being "state of the art" and the alleged invention. (iv) Decide, without any knowledge of the alleged invention, whether these differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.

5. Please provide any additional information relevant to the requirement of inventive step or non-obviousness under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Determining Obviousness
The last two (2) questions in the "Inventive Step Test" require the Examiner to identify the differences that exist between the prior art and the invention in question, and then to determine whether those differences constitute steps which would have been obvious to the person skilled in the art or whether they require any degree of invention.

Please upload any document relevant to the requirement of inventive step or non-obviousness under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Assessment on inventive step is not taken into consideration when examining utility innovations.

D. Grace Period Mechanisms and Pre-Filing Disclosures

1. Does the applicable law provide for any mechanism under which certain disclosures made before the filing or priority date do not prejudice the patentability of an invention, in particular with respect to novelty and/or the legal effect on prior art?

Yes

If yes, please identify the relevant legal provisions (in primary and/or secondary legislation) and describe their operation.: Malaysian Patents Act 1983, Section 14(3). "A disclosure shall be disregarded— (a) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title; (b) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title; (c) if such disclosure is by way of a pending application to register the patent in the United Kingdom Patent Office as at the date of coming into force of this Act. "

2. What is the duration of the mechanism referred to in question 1, during which the covered disclosures do not prejudice the patentability of the invention?

One year preceding the date of the patent application.

3. Where such a mechanism exists, which categories of disclosures are covered by it?

Any disclosure of the invention whether deliberate or accidental, and whether resulting from an act committed in ignorance or full knowledge of patent law, is to be disregarded provided that the disclosure took place not more than one (1) year before the application was filed.

Examples of such disclosures may include exhibition displays, oral presentations at conferences, and publication of earlier patent applications.

4. Are there any formalities or procedural requirements that must be fulfilled in order to rely on the mechanism identified in question 1?

Yes

Please describe any such requirements, where applicable, including, for example, the need to file statements, declarations or notices, to submit certificates or other supporting evidence, or to comply with any timing or notification requirements or any information relating to the burden of proof. **:** Patents Form No. 1, Part VI.

5. Does the applicable law provide for prior user rights or other protections for third parties who may be affected by an invention that has benefited from a graced pre-filing disclosure?

No

If yes, identify the relevant legal provisions (including any provisions in primary and/or secondary legislation), and describe the conditions under which such rights or protections arise (for example, good-faith use of the invention prior to the filing or priority date), as well as how such rights or protections operate. **:**

6. Please provide any additional information that may be relevant, including, where applicable, any guidance (e.g. patent office manual/guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

None.

Please upload any document that may be relevant to grace period mechanisms and/or pre-filing disclosures.

7. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

None.

Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.