

FILING A PATENT

BY JENNIFER JACOBS

Many small and medium enterprises (SMEs) are engaged in developing new technology, but a number of them are not aware of either the need to protect their intellectual property or how to go about it. Dr Viraj Perera, CEO of national technology commercialisation platform PlatCOM Ventures Sdn Bhd, spells out the process for *Unlisted & Unlimited*.

For an invention to be considered patentable, it has to fulfil three criteria, he points out. It has to be novel enough, be able to meet the “inventive step” test and have industrial applicability.

“An invention meets the novelty test if there has been no publication of the subject matter. Thus, if you have not disclosed your novel invention to anyone or in any form of publication, the novelty of your invention remains intact. However, if you have, then you have one year from the date of disclosure to file an application,” says Perera.

The invention passes the “inventive step” test if an expert — defined as a person skilled in a particular area or industry who knows what is already out there or available on the market, or “a person skilled in the art who has considered the prior art” — does not find the invention to be obvious. For instance, if a mechanical engineer who has considered the latest available publications relevant to the subject of your invention cannot figure out your particular configuration, the invention fulfils this requirement.

Finally, if an invention can be produced in or applied to a particular industry, it fulfils the requirement of industrial applicability.

When your invention meets all three requirements, says Perera, you get on with the process of filing the patent. The first step is “invention disclosure”, where the inventor provides a detailed description of the invention.

Once the inventor has provided a detailed description of the invention, the next step is to do a search and patentability assessment. This is where the inventor conducts a search using a worldwide database to assess the invention based on the previously mentioned patentability requirements.

Then, says Perera, the inventor needs to draft the patent specification that complies with the stipulated regulations. Each specification contains a detailed description, scope of protection and drawings.

Only when all these have been done, do we come to the filing of the actual patent application. The filing documents include the patent specification and Form 1, along with the prescribed fee to be paid for the patent application.

About 12 months from the filing date, the applicant may

want to extend the local application overseas, claiming priority from the local application, says Perera. The application may be extended directly to the countries selected by the applicant. Or they may choose to file through the Patent Cooperation Treaty (PCT), which covers 148 countries. You are given 18 months to decide where to file your patent.

Some 18 months after the filing date, an examination request must be filed where an examiner will scrutinise the application based on patentability requirements, says Perera. If the application fulfils all the patentability requirements, a certificate of grant will be issued. The duration for patent protection is 20 years from the filing date.

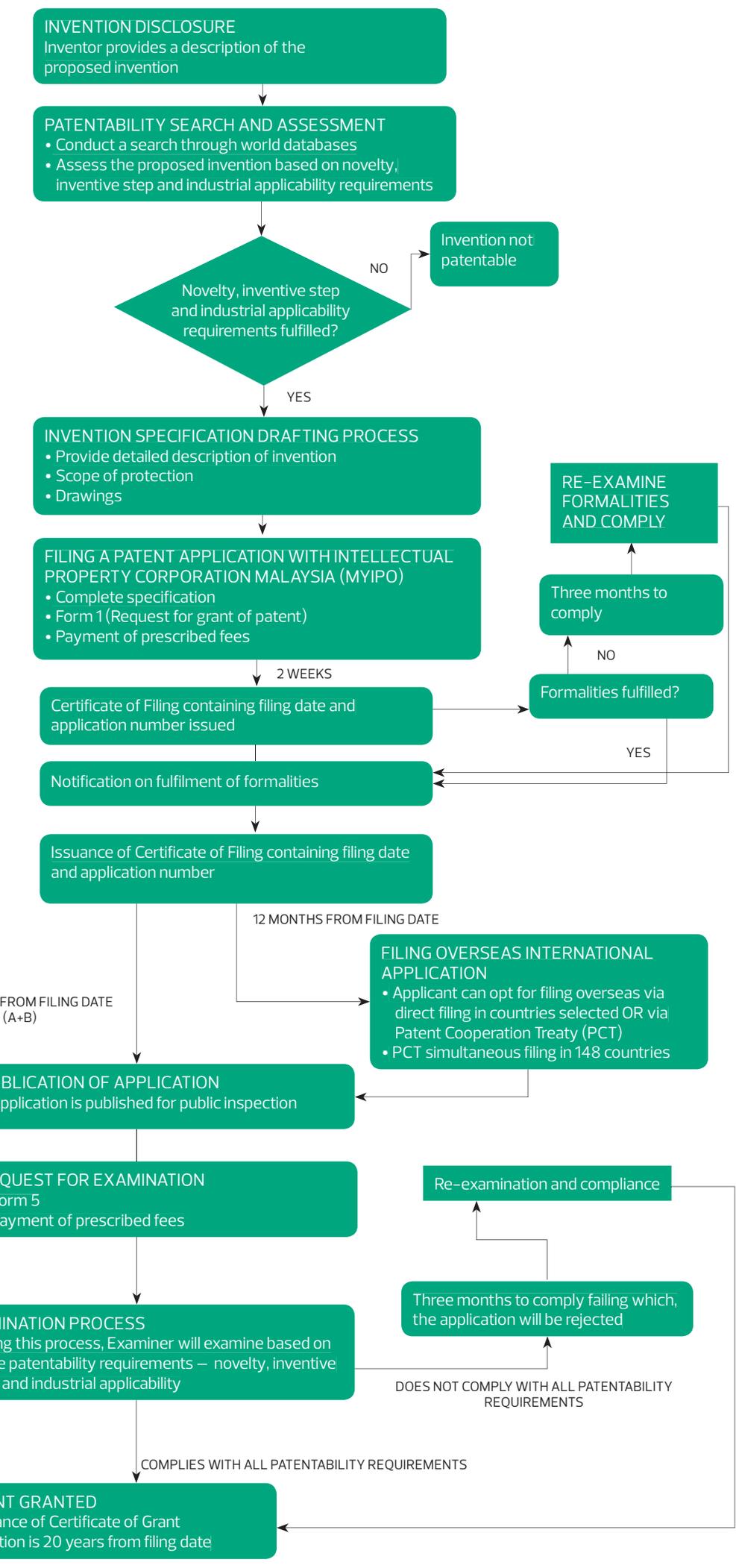
Alternatively, a company can decide to file a patent application just for Malaysia. To do this, it will have to send its application to the Intellectual Property Corp of Malaysia (MYIPO) with the following details: the inventor’s name and address, the applicant’s name and address, and a duly signed “Appointment of Agent” (which can be submitted after filing).

Perera says a request for examination must be filed 18 months from the filing date of the Malaysian patent application. An expedited examination may be filed with the payment of a prescribed fee and the filing of a statutory declaration stating the reasons for requesting the expedited examination, he adds.

If the application complies with all the patentability requirements, the application will be granted and a certificate of grant is issued to the applicant. This patent is also valid for 20 years from the filing date, but the protection only extends to Malaysia.

How long does it take to file a patent? Perera says the search and assessment takes seven working days while it takes three to four weeks to draft a patent, depending on the complexity of the invention. The filing of the patent application itself takes one working day, he adds.

Why do you need a patent agent?



Perera says you need one because of the complexity of a patent specification and scope of protection. “A patent agent/attorney is trained and well versed in preparing the relevant documents in accordance with the Malaysian Patent Act and Regulations.”

You would also require a patent agent to handle the issue of office actions (during the examination stage in particular) from the Patent Office because if this is not handled correctly, it may jeopardise the application and scope of protection. In addition, the patent agent can advise the applicant to determine the scope of protection of the patent.

One SME owner, who spoke to *Unlisted & Unlimited* on condition of anonymity, says he spent RM500,000 to file a global patent for his product (a medical device) while another says he spent RM4 million, so this is not a cheap exercise by any means.

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