

**INTELLECTUAL PROPERTY CORPORATION
OF MALAYSIA
(MyIPO)**



**CONSULTATION PAPER - PROPOSED TRADE MARKS AND
PATENTS (INCLUDING UTILITY INNOVATIONS) FEES
REVISION**

3rd of December 2014

Bil: 1/2014/PC/TM&PA

INTRODUCTION

This consultation paper seeks feedback on the proposed changes from our stakeholders. The Intellectual Property Corporation of Malaysia (MyIPO) welcomes any interested parties to make written submissions in response to the proposed changes as stated herein.

Those interested in submitting written submissions are invited to submit it via email to lawreview@myipo.gov.my latest by 31st of December 2014.

Please note that, unless requested otherwise, written submissions submitted to MyIPO may be made publicly available.

BACKGROUND

Over the years, MyIPO constantly strived to improve the delivery system in processing the patents and trade marks applications for registrations. In this regard, MyIPO is taking step to upgrade and enhance our ICT system for the benefits of the users.

The escalating costs of upgrading the ICT system, makes it inevitable for MyIPO to revise its fees with respect to trade marks and patents. In order to incentivize applicants to utilize the online filing system, we are introducing much lower online filing fees as compared to the manual filing fees.

The revision introduces certain changes, which includes the waiver of certain patents searching fees (online) and the reduction of certain fees for trade marks and patents. Meanwhile for certain patents and trademarks fees, an increase at an average of 5% to 50% is also proposed.

The following summary outlines the fee revision proposed to be implemented. All changes to fees are proposals only at this stage.

① THE PROPOSED FEES REVISION

(A) TRADE MARKS

Under the current Regulation 33 of the Trade Marks Regulations 1997 (TMR 1997), before an application for the registration of a trade mark required or permitted to be advertised by section 27 of the Trade Marks Act 1976 is advertised in the Gazette by the Registrar (for opposition), an applicant is required to file with the Registrar Form TM31 (together with the prescribed fee) within 2 months from the receipt of the Registrar's request (Regulation 33 (2) TMR 1997). In order to shorten the process of the registration period, as well to avoid abandonment due to non-response to office action for request for advertisement of a trade mark, it is proposed that Regulation 33 (2) of TMR 1997 to be deleted (including the need to file Form TM31 and to pay the prescribed fee). Therefore, it is proposed that an 'upfront fee' for application for registration for a trade mark will be introduced by incorporating both the application fee and request for advertisement of a trade mark.

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
TM2	Application for registration of trade marks agent	1300.00	1350.00	1400.00	1400.00	
TM5	Application for registration for a mark	330.00	370.00	990.00	1140.00	Note: Form TM31 to be deleted and the fee is incorporated with TM 5
TM31	Request for advertisement of a trade mark	600.00	650.00			
TM6	Request for statement of grounds of decision	650.00	700.00	1000.00	1000.00	
TM7	Notice of opposition	600.00	650.00	900.00	950.00	
TM9A	Notice to the registrar of attendance at ex-parte hearing	150.00	170.00	230.00	280.00	
TM12	Application for renewal of registration of a trade mark	550.00	600.00	830.00	880.00	
TM13	Application for late renewal of registration of a trade mark	820.00	870.00	1230.00	1280.00	
TM14	Application for restoration and renewal of registration	880.00	930.00	1320.00	1370.00	
TM15	Application and declaration of an assignment / a transmission for registration as proprietor of a trade mark	240.00	260.00	310.00	460.00	
TM17	Request by registered proprietor of a registered trade mark for making, or	130.00	140.00			For cancellation of an entry,

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
	varying of an entry in the Register					new form TM17A will be introduced
*TM17A	Request by registered proprietor of a registered trade mark for cancelling an entry in the Register	130.00	140.00	10.00	10.00	
TM21	Application by registered proprietor for an addition to or alteration of a registered trade mark	160.00	180.00	240.00	290.00	
TM23	Application for registration of a registered user	240.00	260.00	310.00	460.00	
TM26	Request for correction of a clerical error in an application or for permission to amend an application for registration (other than amend representation)	130.00	140.00	20.00	20.00	
*TM26A	Request to amend an application for registration			300.00	300.00	New form TM26A is introduced for amendment of an application for registration other than TM26

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
TM 27	Application for extension of time	70.00	80.00	80.00	80.00	
	Extension of time for every month or part of month	130.00	140.00	170.00	220.00	
TM27A	Application for extension of time (for Opposition proceedings)	70.00	80.00	100.00	100.00	
	Extension of time for every month or part of month	130.00	140.00	250.00	300.00	

Part II

NO.	MATTER	EXISTING FEE (RM)	PROPOSED REVISED FEE (RM)	
			ONLINE	MANUAL
2	Request to conduct public search	10.00 per hour	To be deleted	

(B) (I) PATENTS

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
1	Request for grant of patent	260.00	290.00	260.00	410.00	Online fees remain unchanged but increase in manual fees to encourage the usage of online filing
	Claims – more than 10 claims	20.00	20.00	30.00	50.00	
2A	Entering national Phase	260.00	290.00	340.00	490.00	
2A	Request for reinstatement under Section 78OA (per month of delay fee)	650.00	690.00	850.00	1000.00	
5	Request for substantive examination	950.00	1100.00	1240.00	1390.00	
5A	Request for modified substantive examination	600.00	640.00	780.00	930.00	
5I	Request for expedited examination	2000.00	2200.00	3000.00	3150.00	
21	Request for extension of time	260.00	290.00	390.00	540.00	
	Extension of time for every month or part of month	70.00	80.00	110.00	260.00	

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
Annual fee for patent:						
	For second year after grant of patent	260.00	290.00	340.00	490.00	
	For third year after grant of patent	330.00	360.00	430.00	580.00	
	For fourth year after grant of patent	390.00	420.00	590.00	740.00	
	For fifth year after grant of patent	460.00	490.00	700.00	850.00	
	For sixth year after grant of patent	520.00	560.00	780.00	950.00	
	For seventh year after grant of patent	600.00	640.00	900.00	1050.00	
	For eighth year after grant of patent	650.00	690.00	980.00	1130.00	
	For ninth year after grant of patent	720.00	760.00	1080.00	1230.00	
	For tenth year after grant of patent	780.00	820.00	1170.00	1320.00	
	For eleventh year after grant of patent	850.00	890.00	1280.00	1430.00	
	For twelfth year after grant of patent	900.00	940.00	1350.00	1500.00	
	For thirteenth year after grant of patent	1050.00	1100.00	1580.00	1730.00	
	For fourteenth year after grant of patent	1200.00	1250.00	1800.00	1950.00	
	For fifteenth year after	1300.00	1350.00	1950.00	2100.00	

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
	grant of patent					
	For sixteenth year after grant of patent	1600.00	1660.00	2400.00	2550.00	
	For seventeenth year after grant of patent	1850.00	1900.00	2780.00	2930.00	
	For eighteenth year after grant of patent	2100.00	2200.00	3150.00	3300.00	
	For nineteenth year after grant of patent	2400.00	2500.00	3600.00	3750.00	
	For twentieth year after grant of patent	2600.00	2700.00	3900.00	4050.00	

(B) (II) UTILITY INNOVATIONS

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
14	Application for grant of certificate of utility innovations	130.00	140.00	130.00	280.00	Online fee remain unchanged but increase in manual fee to encourage the usage of online filing
21	Request for extension of time	260.00	290.00	390.00	540.00	

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
	Extension of time for every month or part of month	70.00	80.00	110.00	260.00	
Annual fee for certificate for utility innovations:						
	For third year after grant of certificate	160.00	170.00	210.00	360.00	
	For fourth year after grant of certificate	210.00	240.00	270.00	420.00	
	For fifth year after grant of certificate	210.00	240.00	320.00	470.00	
	For sixth year after grant of certificate	260.00	290.00	390.00	540.00	
	For seventh year after grant of certificate	260.00	290.00	390.00	540.00	
	For eighth year after grant of certificate	320.00	350.00	480.00	630.00	
	For ninth year after grant of certificate	320.00	350.00	480.00	630.00	
	For tenth year after grant of certificate	370.00	400.00	560.00	710.00	
	For eleventh year after grant of certificate	520.00	560.00	780.00	930.00	
	For twelfth year after grant of certificate	780.00	820.00	1170.00	1320.00	
	For thirteenth year after grant of certificate	910.00	950.00	1370.00	1520.00	
	For fourteenth year after grant of certificate	1050.00	1100.00	1580.00	1730.00	

FORM	MATTER	EXISTING FEE (RM)		PROPOSED REVISED FEE (RM)		REMARKS
		ONLINE	MANUAL	ONLINE	MANUAL	
	For fifteenth year after grant of certificate	1300.00	1350.00	1950.00	2100.00	
	For sixteenth year after grant of certificate	1450.00	1500.00	2180.00	2330.00	
	For seventeenth year after grant of certificate	1600.00	1650.00	2400.00	2550.00	
	For eighteenth year after grant of certificate	1700.00	1750.00	2560.00	2710.00	
	For nineteenth year after grant of certificate	1850.00	1900.00	2700.00	2930.00	
	For twentieth year after grant of certificate	1950.00	2000.00	2930.00	3080.00	

Part II

NO.	MATTER	EXISTING FEE (RM)	PROPOSED REVISED FEE (RM)		REMARKS
			ONLINE	MANUAL	
1	Copy of patent	40.00	NIL	60.00	
2	Copy of search report (by applicant/owner)	30.00	NIL	40.00	
3	Examination of Register	15.00 per hour	NIL	20.00 per hour	
4	Certified copies or extract from Register	15.00 per page	N/A	30.00 per page	
5	Copy or extract from Register	3.00 per page	NIL	5.00 per page	

NO.	MATTER	EXISTING FEE (RM)	PROPOSED REVISED FEE (RM)		REMARKS
			ONLINE	MANUAL	
6	Certified copies or extract of any information	100.00 per page	N/A	300.00	Flat rate of RM300 per request
7	Copy of document (S.34)	3.00 per page	NIL	5.00 per page	
8	Permitted information (upon request) - for 1 st 10 pages	140.00	200.00		
	- for subsequent pages	7.00 per page	10.00 per page		

Note: NIL = fees is proposed to be waived

② LEGAL CHANGES REQUIRED

The proposed fees revision will require amendments to the Trade Marks Regulations 1997 and the Patents Regulations 1986.

③ THE PROPOSED PERIOD OF COMMENCEMENT

It should be noted that the fees revision is proposed to come into force in second quarter of 2015. However, this is subject to the actual date of coming into force of the said amendments to the Trade Marks Regulations and the Patents Regulations.

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