

## Malaysian IP office consults users on proposed changes to fees

[MARKS & CLERK MALAYSIA]



**Dr Chris Hemingway,**  
BSc (Hons) PhD CPA EPA ETMA  
Director of the local office of the  
Marks & Clerk group in Kuala  
Lumpur (Malaysia)

The Malaysian Intellectual Property Office (MyIPO) recently launched a consultation seeking feedback from stakeholders on various proposals which have a target implementation date of June 2015.

The first proposal was to consolidate the filing and advertisement fees for the trademarks. However, while this may improve prosecution efficiency, stakeholders were concerned that if the application was rejected or withdrawn prior to advertisement, the corresponding fee would not be refundable. In fact, data from members of the

Malaysian Intellectual Property Association (MIPA) indicate that 90% of users were against this proposal.

The second and perhaps more ominous proposal was to amend the official fees. At present official fees for online prosecution are slightly cheaper (typically 5-10%) than their manual prosecution counterparts. In the proposal not only are the majority of the fees being increased significantly, but the gap is also being widened for manual filings 'to incentivize applicants to utilize the online filing system'. Many of the online fees are being increased by 50%, with manual fees being increased by 100-200%!

Data from MIPA members indicate that 95% of users think the fee increase is inappropriate, especially as there was a significant hike in fees of around 30-50% only a few years ago, and would lead to a reduction in filings (contrary to MyIPO's aim). In

addition, the majority of users would not be persuaded to use the online filing system by the increase in manual prosecution fees (also contrary to MyIPO's aim) because the system is too problematic and unreliable. Indeed, in our own experience in testing the system, we have found that some of the problems are so serious that an applicant's rights may be severely and/or unrecoverable impacted, and therefore we do not currently believe that MyIPO's online system can be relied upon for regular use.

As such we hope that stakeholder's views are given fair consideration and the proposals are rejected, as in our view they are unjustified and inequitable.



**Dr Chris Hemingway, BSc (Hons) PhD CPA EPA ETMA**

Professional Qualifications

*Malaysian Patent, Trade Mark & Design Agent*

*European Patent Attorney*

*European Trade Mark & Design Attorney*

*Chartered UK Patent Attorney*

Academic Qualifications

*Certificate of Intellectual Property Law, University of Manchester, UK*

*PhD Biological Sciences; University of Warwick, UK*

*BSc (Hons) Biological Sciences (Sandwich); University of Leicester, UK*

Profile

*Chris is a director of the local office of the Marks & Clerk group, the largest firm of patent and trade mark attorneys in the world.*

*He specializes in the drafting and prosecution of patent applications, and is one of only a few practitioners in the country who are also qualified as UK/European patent attorneys. He has experience with a broad range of technical subject matter, ranging from mechanical and software-based inventions, to medical devices and chemical innovations.*

*In more detail he has particular expertise with security and communication software, pharmaceutical drugs, broadcast data receivers, electronic toys, play equipment for children, banknote validates, trigger sprayers, and power tools.*

*He holds a PhD in Microbiology from the University of Warwick and gained a number of years of valuable commercial experience in industry in the fields of IT and biotechnology prior to joining the legal profession.*

*Chris is a fellow of the Chartered Institute of Patent Attorneys (CIPA) in the UK and received the Michael Jones Prize while qualifying as a UK Patent Attorney. In addition to dealing with matters before the UK Patent Office, he has represented clients in Oral Proceedings and Oppositions at the European Patent Office, and handled trade mark and design cases before the UK and European Trade Mark Registries. Chris is also a Registered Malaysian Patent, Trade Mark and Design agent.*

*He is a member of the CIPA Education Committee, and before moving to Malaysia he was a lecturer for CIPA's Patent Administrators Course.*

*Locally, Chris has provided advice, workshops and seminars to various entities, including UKM, IIUM, USM, UTAR, UKM, USM, NUS, MIGHT, MABIC, BiotechCorp, Genting, Petronas, MIMOS, etc, and is also a judge for the annual ITEX show.*

*Chris is listed as an expert for Malaysia on the ASEAN IPR SME Helpdesk, is a member of the Executive Committee of the Malaysian Intellectual Property Association (MIPA), represents Malaysia on the Patents Committee for the Asian Patent Attorneys Association (APAA), and has been named as an IP Star in the World IP Survey 2014 conducted by Managing Intellectual Property.*

## Contact

### MARKS & CLERK MALAYSIA

Unit 6, Level 20, Tower A  
Menara UOA Bangsar  
5 Jalan Bangsar Utama 1  
Taman Bangsar  
59000 Kuala Lumpur  
Malaysia

Tel: +603 2283 8986

Fax: +603 2283 7898

Email: [malaysia@marks-clerk.com.my](mailto:malaysia@marks-clerk.com.my)

Email: [chemingway@marks-clerk.com.my](mailto:chemingway@marks-clerk.com.my)

<http://www.marks-clerk.com/>