

# asean insiders

series

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## Patents

# Patent protection in ASEAN

*A patent is an exclusive right granted for an invention, which is a product or a process that provides a new way of doing something, or offers a new technical solution to a problem.*

Source : WIPO

Over the last 5 years, ASEAN has seen much progress in patent protection. Of its 10 members, only Myanmar and Cambodia are yet to accede to the Patent Cooperation Treaty, but these countries too are making progress in their own right. Myanmar, the last of the ASEAN countries without any patent law regime in force, is in the process of drafting new patent laws (replacing an archaic draft patent law that was never implemented).

The rest of ASEAN too has been making concerted progress towards a harmonious patent protection framework of international standards.

For example, all but Myanmar are now participants to the ASEAN Patent Examination Co-operation (ASPEC). Established in 2009, ASPEC is a work sharing programme aimed at reducing costs and time taken to obtain grant of a patent within ASEAN.

The recently revised ASPEC allows participating members to share search and examination results amongst participating IP Offices to allow applicants to obtain corresponding patents faster and more efficiently. In reducing duplication on the search and examination work done, ASPEC serves as a useful reference in producing quality reports on all but one member of ASEAN. In addition to the ASPEC programme, 5 ASEAN members have also established the Patent Prosecution Highway (PPH) to accelerate the examination of patent applications. The PPH is a procedure allowing participating patent offices to make use of relevant work already conducted by another office when conducting patent examinations.

The Thai Department of Intellectual Property commenced its PPH pilot programme with Japan's Patent Office (JPO) in January 2014 whilst Malaysia followed suit in October 2014, joining Singapore, the Philippines and Indonesia which have already implemented PPH Programmes of their own with the JPO.

Singapore has recently made some changes to its patent protection regime with the introduction of a new patent law which came into force on 14 February 2014, migrating from a "self-assessment system" to a "positive grant system". Now, it is no longer possible to obtain a patent which invention does not satisfy the criteria of patentability.






In addition, the Intellectual Property Office of Singapore now, for the first time, has examiners within its Office as compared to the previous practice of outsourcing examination to Australian, Danish and Hungarian patent offices, amongst others.





There is now only a single prosecution track (abandoning the dual fast and slow track systems), newly-introduced examination procedures, and a written appeal procedure for instances of refusal.

As the push towards an industrialized and knowledge-based economy of ASEAN intensifies, greater improvements to the patent regime will be expected in the near future. It is apparent that substantial efforts have been made by many member countries towards raising the bar of patent standards to international levels, and the region has seen concerted efforts in simplifying grant procedures, expediting grants and producing quality patents. Incentives have been provided by local governments to encourage domestic patent applications, so that in the long run, there will be some form of equilibrium between foreign and domestic patent ownership.



Linda Wang  
Partner, Intellectual Property  
[linda.wang@zicolaw.com](mailto:linda.wang@zicolaw.com)

	 <b>Malaysia</b>	 <b>Singapore</b>	 <b>Brunei</b>	 <b>Thailand</b>
<b>What is the governing patent law in your country?</b>	Patents Act 1983.	Patents Act (Chapter 221).	Patents Order 2011.	Patent Act B.E. 2522 (A.D. 1979).
	Myanmar, the last of the ASEAN countries without any patent law regime in force, is in the process of drafting new patent laws (replacing an archaic draft patent law that was never implemented). In the interim, intellectual property rights are vaguely protected under a myriad of other laws. It is common practice for a patent owner to register a declaration of ownership of patent with the Office of the Registration of Deeds pursuant to section 18(f) of the Registration Act 1908 and publish a cautionary notice based on such registration in local newspapers.			
<b>Is your country a member/party of:</b> (i) WTO <sup>1</sup> (ii) the Paris Convention <sup>2</sup> (iii) the Patent - Cooperation Treaty <sup>3</sup> ? (iv) Is there a novelty grace period <sup>4</sup> ?	Yes to all			
<b>What are the legal requirements for a patentable invention?</b>	The invention must: <ul style="list-style-type: none"> <li>• Have novelty;</li> <li>• Involve an inventive step; and</li> <li>• Be industrially applicable</li> </ul>			
<b>Is there a novelty grace period? If so, how long?</b>	1 year preceding the date of patent application			
<b>Is there substantive examination?</b>	<p>Yes. There are normal substantive examination and modified substantive examination (based on patents granted in the US, UK, EPO, Japan, Korea and Australia).</p> <p>For a conventional application, request for examination must be filed within 18 months from filing date.</p> <p>For a national phase application, request for examination must be filed within 4 years from the international filing date.</p>	<p>Yes. There are local search and examination, and supplementary examination.</p> <p>For the local search and examination, the request must be filed within 36 months from the base date (priority date – if any/ filing date).</p> <p>For supplementary examination, the request must be filed within 54 months from the base date (priority date – if any/filing date). This route is preferred if the Applicant wishes to rely on a corresponding granted/allowed patent or final examination results from the prescribed patent offices or to rely on a favorable IPRP.</p>	<p>Yes. There are all-local approach, all-foreign approach and combination approach by requesting:</p> <p>i) Local search and examination – request to be filed within 21 months from the priority/ application date, extendable up to 39 months</p> <p>ii) Examination based on a search report from an approved jurisdiction – request to be filed within 21 months from the priority/ application date, extendable up to 39 months</p> <p>iii) On the basis of final examination results (including IPRP) received in an approved jurisdiction- request to be filed within 42 months from the priority/application date, extendable up to 60 months</p>	<p>Yes. The request for substantive examination must be submitted by the applicant either within 5 years after the publication of such application or, in cases where there is an opposition and an appeal is filed, within 1 year after the final decision has been made, depending on which period expires last.</p>
<b>Is there a pre-grant opposition procedure?</b>	No			Yes. The opposition must be filed within 90 days of the date that the application has been published in the Official Patent Gazette.
<b>What is the estimated time for grant of a patent?</b>	3-5 years from the filing date.			
<b>What are the grounds for invalidation of a patent?</b>	<ul style="list-style-type: none"> <li>• The invention is not a patentable invention</li> <li>• The description or claim does not comply with the requirements of application</li> <li>• Drawings which are necessary for the understanding of the claimed invention have not been furnished</li> <li>• The right to the patent does not belong to the person to whom the patent was granted</li> <li>• Information provided to the Registrar was deliberately incomplete or incorrect.</li> </ul>	<ul style="list-style-type: none"> <li>• The invention is not a patentable invention</li> <li>• The patent was granted to a person who is not entitled to the grant</li> <li>• The specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art</li> <li>• The matter disclosed in the specification extends beyond that disclosed in the application as filed.</li> <li>• Prohibited amendments and correction made to the specification</li> <li>• The patent was obtained fraudulently, on any misrepresentation or on any non-disclosure or inaccurate disclosure of any material information concerning corresponding applications</li> <li>• The patent is one or more patents for the same invention having the same priority date and filed by the same party or his successor in title.</li> </ul>	<ul style="list-style-type: none"> <li>• The invention is not a patentable invention</li> <li>• The patent was granted to a person who is not entitled to the patent</li> <li>• Unclear and incomplete specification to a person skilled in the art.</li> <li>• The matter disclosed in the specification extends beyond that disclosed</li> <li>• Prohibited amendments and correction made to the specification</li> <li>• The patent was obtained fraudulently, on any misrepresentation or on any nondisclosure or inaccurate disclosure of any prescribed material information.</li> <li>• The patent granted is one of 2 or more patents for the same invention having the same priority date and filed by the same party or his successor in title</li> </ul>	<ul style="list-style-type: none"> <li>• The invention is not a patentable invention</li> <li>• The Patent encompasses non patentable subject matter</li> <li>• The patentee is not the true inventor or has no right to file an application</li> <li>• Unqualified applicant issues</li> </ul>
<b>Are there criminal liabilities for infringement of a patent?</b>	No			
<b>What civil remedies are available against a patent infringer?</b>	<ul style="list-style-type: none"> <li>• Damages</li> <li>• Injunction</li> <li>• Delivery up or destruction of infringing patented product</li> <li>• Account of profits</li> <li>• Declaration that the patent is valid and has been infringed</li> </ul>			









 Cambodia	 Laos	 Vietnam	 Indonesia
The Law on Patents, Utility Model Certificates and Industrial Designs 2003.	Law on Intellectual Property 2011, Regulation on the Implementation of Decree bon Patents, Petty Patents and Industrial Designs 2002.	Law on Intellectual Property 2005 as amended in 2009.	Law No 14 of 2001 regarding Patents.
Myanmar, the last of the ASEAN countries without any patent law regime in force, is in the process of drafting new patent laws (replacing an archaic draft patent law that was never implemented). In the interim, intellectual property rights are vaguely protected under a myriad of other laws. It is common practice for a patent owner to register a declaration of ownership of patent with the Office of the Registration of Deeds pursuant to section 18(f) of the Registration Act 1908 and publish a cautionary notice based on such registration in local newspapers.			
Only WTO and Paris Convention	Yes to all		
The invention must: <ul style="list-style-type: none"><li>• Have novelty;</li><li>• Involve an inventive step; and</li><li>• Be industrially applicable</li></ul>			
1 year preceding the date of patent application	6 months preceding the date of patent application	6 months or 12 months preceding the date of patent application, depending on the circumstances of disclosure.	
Yes. Currently, there is no facility to conduct substantive examination, and such examination will be based on that made by any foreign Patent Office.	Yes. Substantive examination is based on search of existing technical knowledge. In case the application has previously been subject to a search or examination by another authority (in another country), the applicant may submit a copy of that report and request that it be accepted in lieu of conducting a search.	Yes. The demand for substantive examination must be submitted by the applicant within 42 months from the priority date.	Yes. The request for examination must be filed within 36 months from the receipt date of patent application.
In case the applicant is unable to submit foreign search and examination results, the Cambodia Patent Office will request a foreign search and examining authority to undertake this upon the request of the applicant.	The deadline to submit the search/examination report or file a request for substantive examination is 32 months for invention and 12 months for device (petty patent) from the priority/application date	Late submission of the Demand is permitted within six (6) months after expiration of the 42-month deadline, provided that there are legitimate grounds and the applicant pays extra fee for late filing.	For a simple patent, the request for examination can be made together with the application or at the latest 6 months from the receipt date of the application.
No	Yes. The opposition must be filed prior to the issuance of patent	Yes, opposition can be made during the publication (6 months for patent or 3 months for simple patent) made by the DGIP before substantive examination.	
3-5 years from the filing date.	More than 3 years and could take very long if there is no corresponding patent that has been examined or granted overseas	Approximately 19 months	3-5 years from the filing date.
<ul style="list-style-type: none"><li>• The invention is not a patentable invention</li><li>• The Patent encompasses non patentable subject matter</li><li>• The specification of the patent does not disclose the invention clearly or sufficiently</li></ul>	<ul style="list-style-type: none"><li>• Incomplete application form</li><li>• No condition for the protection of such invention</li><li>• Applicant has no right to file application for registration</li><li>• Applicant did not pay the official fee</li><li>• Applicant did not file a request for the substantive examination within the period specified under the law</li></ul>	<ul style="list-style-type: none"><li>• The applicant has no right to file an application for the patent</li><li>• The invention does not meet patentability criteria applicable at the time the patent was issued.</li></ul>	<ul style="list-style-type: none"><li>• The invention is not a patentable invention</li><li>• The patent contains the same invention as a prior patent granted to another party</li></ul>
Yes. Penalties may include: <ul style="list-style-type: none"><li>• Fines;</li><li>• Imprisonment;</li><li>• Being banned from holding certain posts, or practicing certain occupations; or</li><li>• Confiscation and/or destruction of infringing products.</li></ul>			
<ul style="list-style-type: none"><li>• Damages</li><li>• Injunction</li><li>• Other remedies provided for in the general law</li></ul>	<ul style="list-style-type: none"><li>• Damages</li><li>• Injunction</li><li>• Public Apology</li><li>• Compelling performance of civil obligations</li><li>• Destruction, distribution or use for non-commercial purposes of infringing goods, or contrivances used.</li></ul>	<ul style="list-style-type: none"><li>• Damages</li><li>• Delivery up or destruction of infringing patented product</li></ul>	

1. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is an international agreement administered by the World Trade Organization that sets down minimum standards for various forms of intellectual property regulation as applied to nationals of other WTO members, including enforcement procedures, remedies, and dispute resolution procedures. Myanmar is a party to the WTO.

2. Signed in 1883, it provides two fundamental rights: i) citizens of any signatory country will enjoy in all signatory countries the rights each signatory country grants its own citizens; and ii) citizens of any signatory country, within 12 months after filing a patent in the home country, can file an application in any signatory country to receive benefits of the original filing date.

3. An international patent law treaty concluded in 1970 that provides a unified procedure for filing patent applications to protect inventors in each of its contracting states.

4. Novelty is a patentability requirement to ensure that only new subject matter is patented. A grace period exists for protecting an inventor from authorized or unauthorized disclosure of the invention before the filing date. If the inventor publishes/discloses the invention, it will not destroy the novelty of the invention, provided that the patent application is filed during the statutory grace period flowing publication/disclosure.

									
	Brunei	Cambodia	Indonesia	Laos	Malaysia	Singapore	Thailand	Vietnam	
Patent Offices	The Brunei Darussalam Intellectual Property Office (BrulPO)	Industrial Property Office of the Intellectual Property Department of the Ministry of Commerce.	Directorate General of Intellectual Property Rights (DGIP) under the Ministry of Law and Human Rights	The Intellectual Property Division under the Department of Intellectual Property, Standardization and Metrology	The Intellectual Property Corporation of Malaysia (MyIPO)	The Intellectual Property Office of Singapore (IPOS)	Department of Intellectual Property under the Ministry of Commerce (DIP)	The National Office of Intellectual Property of Vietnam (NOIP) under the Ministry of Science and Technology	
Are there annuity payments to be made for the duration of a patent, and if so, how often?	The annuity fee is to be paid yearly until the duration of the patent expires.						The annuity fee is to be paid yearly beginning in the 5th year of the term of the patent until the duration of the patent expires	The annuity fee is to be paid yearly until the duration of the patent expires.	
Is post-grant amendment of patents allowed? If so, under what circumstances?	Yes. The amendment must not cause disclosure of additional matter or extend the protection conferred by the patent. No amendment shall be allowed where there are pending before the Court or Registrar proceedings in which validity of the patent may be put in issue.	No			Yes. Post grant amendment is granted on limited basis, i.e. for the purpose of correcting clerical error or obvious mistake or for any other reason acceptable to the Registrar. Amendment is not allowed if it discloses new matter or has the effect of extending the protection conferred by the patent. No amendment shall be allowed where there are pending before the Court proceedings in which validity of the patent may be put in issue.	Yes. The amendment must not cause disclosure of additional matter or extend the protection conferred by the patent. No amendment shall be allowed where there are pending before the Court or Registrar proceedings in which validity of the patent may be put in issue.	No	Yes, the patent holder may request for amendment of the patent to narrow the scope of the patent by cancelling one or more claims	
Is there a system of petty patent/utility innovation/utility model <sup>1</sup> ?	Yes. Utility Models are protected under the Law on Patents, Utility Models and Industrial Designs.		Yes. Simple Patents are protected under Law. No.14 of 2001.	Yes. Petty Patents are protected under Laos' Intellectual Property Laws.	Yes, utility innovations are protected pursuant to Part IV A of the Patents Act read together with the Second Schedule.	Yes. Petty Patents are protected under the Thai Patent Act B.E. 2522 (1979).		Yes. Utility Solutions are protected under Vietnam's Law on Intellectual Property 2005 as amended in 2009.	
What are the requirements for grant?	N/A		The invention must: • Be new; and • Be industrially applicable. The invention may be or may relate to a product or process.	The invention must: • Be new; • Be industrially applicable; • Relate to the product or tool; • Have functions that are more practical than prior inventions.	The eligibility criteria of an invention to qualify as a petty patent are similar to a patent except that there is a lower technical level required as compared to a patent.	The invention must: • Be new; and • Be industrially applicable.	N/A		The invention must: • Be new; and • Be industrially applicable.
What is the duration of grant?	7 years from the filing date.		10 years from the filing date.	Up to 12 years in total – 10 years from the filing date, and an extension of 2 years.	Up to 20 years in total – 10 years from the initial date of grant and 2 further extension periods of 5 years each.	Up to 10 years in total – 6 years from filing date, and 2 further extensions of 2 years each.		10 years from the filing date. Renewal fee must be paid every 2 years during the duration of the grant.	

A utility model is an exclusive right granted for an invention, which allows the right holder to prevent others from commercially exploiting the protected invention without his authorization for a limited period of time. In its basic definition, which may vary from one country to another, utility models are similar to patents and are sometimes referred to as petty patents, simple patents, or utility innovations. There are however differences between utility models and patents, most notably that utility models need not satisfy the inventive step requirement or may have a lower level of inventiveness and in some countries, are protected for a shorter period of time.



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