



South-East Asia IP Mediation Conference 11th - 12th November 2024

THE NATIONAL IP **MEDIATION PROGRAMS** AND INITIATIVES OF **MALAYSIA**



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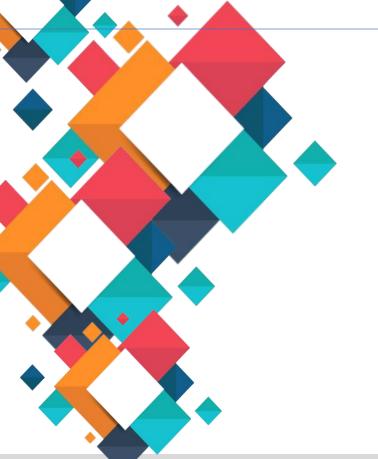
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MyIPO



Intellectual Property Corporation of Malaysia (MyIPO)

- A Government agency under Ministry of Domestic Trade and Cost of Living (corporatized in 2003)
- Self funded organization
- Responsible for the development and management of intellectual property system in Malaysia
- Legislation namely the <u>Trademarks Act</u> 2019, the <u>Patents Act</u> 1983, the <u>Copyright Act</u> 1987, the <u>Industrial Designs Act</u> 1996, the <u>Layout Designs of Integrated Circuits Act</u> 2000, <u>Geographical Indications Act</u> 2022 and the subsidiary regulations





IP LAWS IN MALAYSIA

PATENTS ACT 1983



LAW OF MALAYSIA

Act 291

PATENTS ACT 1983

Judicial assignment of patent application or patent

19. Where the essential elements of the invention claimed in a patent application or patent have been unlawfully derived from an invention for which the right to the patent belongs to another person, such other person may apply to the Court for an order that the said patent application or patent be assigned to him:

Provided that the Court shall not entertain an application for the assignment of a patent after six years from the date of the grant of the patent.

Court may order rectification of the Register

- **33**C. (1) The Court may, on the application of any aggrieved person, order the rectification of the Register by directing—
 - (a) the making of any entry wrongly omitted from the Register;
 - (b) the expunging or amendment of any entry wrongly made in or remaining in the Register; or
 - (c) the correcting of any error or defect in the Register.



LAW OF MALAYSIA

Act 291

PATENTS ACT 1983

Invalidation of patent

56. (1) Any aggrieved person may institute Court proceedings against the owner of the patent for the invalidation of the patent.

Infringement proceedings

59. (1) The owner of the patent shall have the right to institute Court proceedings against any person who has infringed or is infringing the patent.

PATENTS ACT 1983



LAW OF MALAYSIA

Act 291

PATENTS ACT 1983

Service of application, order or judgement on Registrar

88C. (1) A copy of every application to the Court relating to a patent application or patent in the proceedings including an appeal from such application shall be served on the Registrar by the parties to the application in the prescribed manner together with the payment of the prescribed fee.

(2) Upon receipt of a copy of the application including an appeal under subsection (1), the Registrar may change the status of the patent application or patent as the Registrar deems fit, subject to further conditions, directions, order or judgement of the court.

(3) Any order or judgement made by the court upon the completion of the application including appeal under subsection (1) shall be served on the Registrar in the prescribed manner together with the payment of

94 Laws of Malaysia ACT 291

the prescribed fee by the party in whose favour the order or judgement is made or given.

(4) Upon receipt of the order or judgement under subsection (3), the Registrar shall—

- (a) record the court order or judgement in the Register; and
- (b) cause the order or judgement to be published in the Official Journal if the Registrar thinks necessary.

TRADEMARKS ACT 2019



TRADEMARKS ACT 2019

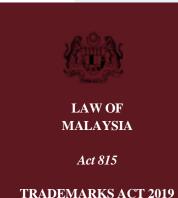
Opposition proceedings

35. (1) Any person may file a notice of opposition in the form as determined by the Registrar together with the payment of the prescribed fee and send the notice of opposition to the applicant within the prescribed period from the date of the publication of the acceptance of an application for the registration of the opposed trademark.

Revocation of registration by Court as to non-use of trademark

46. (1) The registration of a trademark may be revoked by the Court on an application by an aggrieved person on any of the grounds as follows:

TRADEMARKS ACT 2019



Invalidation of registration by Court

47. (1) The registration of trademark may be declared invalid by the Court upon the application by an aggrieved person on the ground that the trademark was registered in breach of section 23.

Action for infringement

56. (1) The registered proprietor shall have the right to institute Court proceedings against any person who has infringed or is infringing the registered trademark.

TRADEMARKS ACT 2019



LAW OF MALAYSIA

Act 815

TRADEMARKS ACT 2019

Service of applications to Court on the Registrar

140. (1) A copy of every application to the Court, including appeals to the Court of Appeal or Federal Court, relating to the application for registration or registered trademark shall be filed

Trademarks

with the Registrar by the parties to the application to the Court in the manner as determined by the Registrar within the prescribed

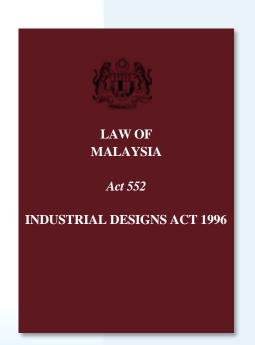
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(2) Upon receipt of the application under subsection (1), the Registrar may change the status of the application or registration of trademark as the Registrar deems fit, subject to further condition, direction, instruction, order or judgment of the Court.

period, without having to name the Registrar as a party.

- (3) Any order or judgment made by the Court upon the completion of the application filed under subsection (1) shall be filed with the Registrar in the manner as determined by the Registrar.
- (4) The Registrar, under subsection (3), shall comply and give effect to the Court's order or judgment.
- (5) If the Registrar considers that publicity should be given upon giving effect to the Court's order, he may publish it in the Intellectual Property Official Journal.

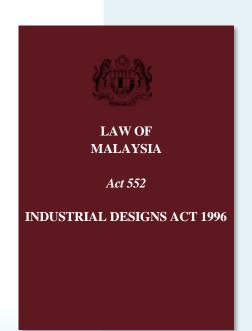
INDUSTRIAL DESIGNS ACT 1996



Rectification of Register

- **24.** (1) Subject to the provisions of this Act—
 - (a) the Court may, on the application in the prescribed manner, of any person aggrieved by or interested in the non-inclusion in or omission from the Register of any entry, or by or in any entry made in the Register without sufficient cause, or any entry wrongfully remaining in the Register, or any error or defect in any entry in the Register, make such order for including, making, expunging or varying any such entry or for the correcting of any such error or defect as it deems fit;

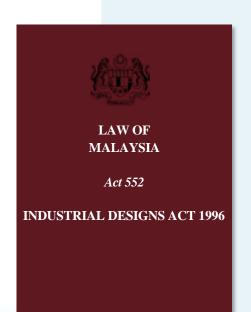
INDUSTRIAL DESIGNS ACT 1996



Revocation of registration and grant of compulsory licence

- **27.** (1) At any time after the registration of an industrial design, any person may apply to the Court—
 - (a) for the revocation of the registration of the industrial design on the ground, subject to section 12, that the industrial design has been disclosed to the public prior to the priority date of the application for registration of the industrial design;
 - (b) for the cancellation of the registration of the industrial design on the ground that the registration of the industrial design has been procured by unlawful means; or

INDUSTRIAL DESIGNS ACT 1996



Infringement proceedings

33. (1) The owner of a registered industrial design shall have the right to institute legal proceedings against any person who has infringed or is infringing any of the rights conferred by the registration of the industrial design.



LEGAL DEVELOPMENT IN MALAYSIA



MEDIATION ACT 1983



- In force since 1st August 2012 throughout Malaysia
- To promote and encourage mediation as a method of alternative dispute resolution
- Facilitating the parties in disputes to settle disputes in a fair, speedy and cost-effective manner



MEDIATION ACT 1983

NON-APPLICATION

- 1. Proceedings involving a question which arises as to the effect of any provision of the Federal Constitution.
- Suits involving prerogative writs, as set out in the Schedule to the Courts of Judicature Act 1964 [Act 91].
- Proceedings involving the remedy of temporary or permanent injunctions.
- Election petitions under the Election Offences Act 1954 [Act 5].
- Proceedings under the Land Acquisition Act 1960 [Act 486].
- 6. Proceedings involving the exercise of the original jurisdiction of the Federal Court under Article 128 of the Federal Constitution.
- Judicial review.
- Appeals.
- Revision.
- Any proceedings before a native court.
- 11. Any criminal matter.



LAW OF **MALAYSIA**

Act 749

MEDIATION ACT 2012

SALIENT FEATURES

Steps to commence mediation

- > A person may initiate by sending invitation
- Invitation will be deemed accepted or rejected based on response by the other person
- If accepted, parties must enter into mediation agreement which contain among others; appointment of mediator and costs.

The mediator

- Must possess relevant qualification, knowledge and experience
- Must act independently and impartially
- Mediator will not be liable unless in fraudulent and wilful misconduct

Confidentiality

- Conducted privately
- > Prohibits the disclosure of oral or written statement

Settlement Agreement

- > Binding settlementt agreement if reach consensus
- Can be recorded in court as consent judgement



Act 749

MALAYSIA

MEDIATION ACT 2012



COURT ANNEXED MEDIATION

RULES OF COURT 2012

Order 34 rule 2(1A) and (1B)

RULES OF COURT 2012

2. Pre-trial case management when directed by the Court (O. 34 r. 2)

- (1) Without prejudice to rule 1, at any time before any action or proceedings are tried, the Court may direct parties to attend a pre-trial case management relating to the matters arising in the action or proceedings.
- (1A) If a judge of the High Court identifies that an issue arising in the action or proceedings between the parties can be resolved by way of mediation, the judge may refer the parties to mediation as prescribed by practice directions issued from time to time.

[1A. Ins. PU(A) 351/2020:r.5]

(1B) All running down cases shall be subject to mediation.

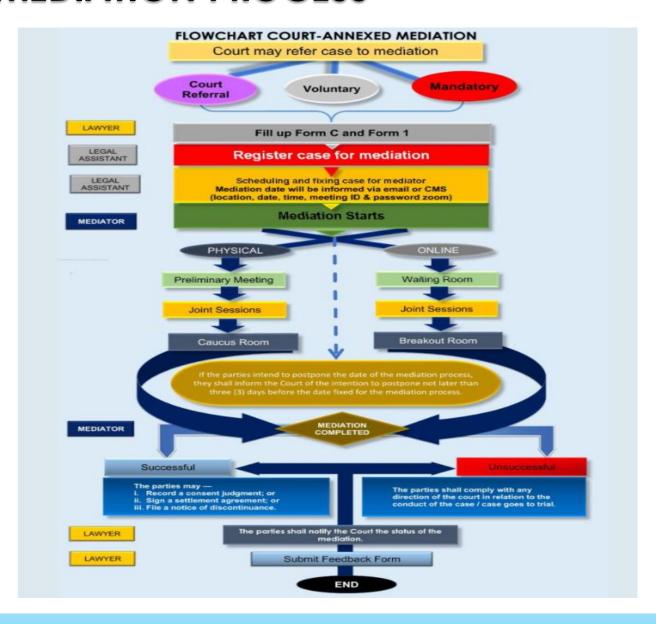
[1B. <u>Ins. PU(A) 351/2020:r.5</u>

COURT ANNEXED MEDIATION

RULES OF COURT 2012



COURT ANNEXED MEDIATION PROCESS





COURT ANNEXED MEDIATION PROCESS

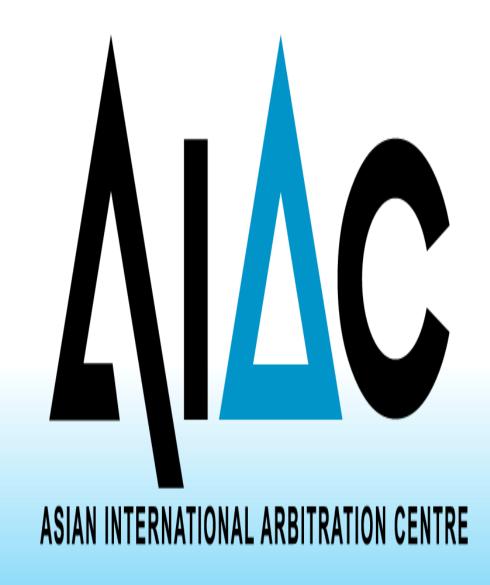
Mediation Div	
FORM 1	
<u> </u>	
Agreement to	Mediate Pursuant to Court Annexed Mediation
Case No	:
Judge / Mediator	: <u>.</u>
Parties	:Plaintiff :
	Defendant :
	Third Party :
Mention Date	:
Hearing Date	:
	diation process conducted is a closed process attended only by the avolved or an authorized representative together with counsel, if any;
, .	losures, admissions and communications made during the mediation are confidential and without prejudice;
,	nunications during the mediation process shall not be part of the records edings; and
, .	earty shall call the mediator to give evidence in relation to the mediation conducted by the mediator for the proceedings.
Plaintiff / Pla	
So l icitor's Sig	gnature Solicitor's Signature
	······································

Third Party / Third Party's Solicitor's Signature



ASIAN INTERNATIONAL ARBITRATION CENTRE

- Was established on 17th April 1978 and formerly known as 'Kuala Lumpur Regional Arbitration Centre (KLRCA)'
- Renamed as AIAC on 28th February 2018
- Legislations:
 - ➤ Mediation Act 2012
 - ➤ AIAC Mediation Rules 2023 (take effect from 24th August 2023)
 - All previous edition of AIAC
 Mediation Rules 2013 and 2018
 shall no longer be applicable



ASIAN INTERNATIONAL ARBITRATION CENTRE

6. Must sign settlement agreement – can be used as evidence for seeking relief

5. Mediator can communicate with parties together or separately

1. Domestic and International Mediation

SALIENT FEATURES

4. May replace mediator at any time

2. Cost involves: mediator fees and administrative charges

3.
Commenceme
nt – submit
request to
Director of
AIAC



MALAYSIAN INTERNATIONAL MEDIATION CENTRE



- Previously known as Malaysian Mediation Centre
- Established on 5th November 1999 under the auspices of Bar Council of Malaysia
- Renamed on 15th January 2024
- Has its own Mediation Rules and Code of Ethics
- Provides workshop to be accredited to the MIMC'S Panel of Mediators
- Mediation process subject to MIMC's fees





OTHER MEDIATION INSTITUTION IN MALAYSIA

 Securities Industry Dispute Resolution Center

Mediation Centre Sabah, Sabah Law Society

• AAS Mediation Services, Advocates Association of Sarawak (AMS)



CONCLUSION



- > There is no express legal framework on mediation in the IP Laws
- Mediation may be considered as part of the legal framework in the proceedings before the Registrar in the IP Office
- Cooperation with practitioners may be considered





THANK YOU

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