



malaysian intellectual property association

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11th January 2012

Y. Bhg. Dato' Azizan Mohamad Sidin
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By e-mail & fax

Y. Bhg. Dato' Azizan

RE: URGENT AND SERIOUS ISSUES OF CONCERN WITH RESPECT TO THE INDUSTRIAL DESIGNS REGULATIONS 1999 (2012 AMENDMENT)

We refer to and thank MyIPO for the briefing on "Peraturan-Peraturan Reka Bentuk Perindustrian 1999 (Pindaan 2012)" which was held yesterday, 10th January 2012, for the benefit of IP practitioners and stakeholders.

MIPA has the following urgent and very serious concerns, and we hope to receive a positive response from the authorities:

1) Commencement date of amended Regulations and list of official fees

We have been informed at the abovementioned briefing that the amended Regulations will come into force either on 13th or 16th January 2012. MIPA would strongly urge the authorities to defer the date of coming into force of the amended Regulations at least until 15th February 2012, taking into consideration the intervening public holidays for Chinese New Year,

Thaipusam and Maulidur Rasul, to allow IP practitioners and agents sufficient time to inform their clients and foreign associates of the increase in fees. This is on the assumption that the revised fees will be disclosed/released on 13th January 2012. MIPA is of the view that the short deferment in the commencement date of the amended Regulations is reasonable and would benefit all stakeholders.

2) Appointment of Agent (ID Form 10) as a filing date requirement

MyIPO insists that an ID Form 10 appointing the agent be filed simultaneously with a new application for registration of an industrial design, or else an extension of time be filed. This practice is not in line with international practice under which it is normal to allow an applicant a period of grace for filing such kind of document (in those countries where it is required at all). Also, this practice does **not** appear to have a legal foundation and the requirement for filing ID Form 10 is **not** a requirement for securing a filing date. This is explained in detail in the attached Appendix A.

Furthermore, it is problematic for agents representing overseas applicants, who are less familiar with the requirements of each country they seek to file in and will often send instructions close to the deadline for filing an application without complete documentation. Requiring the applicant to obtain an extension of time if ID Form 10 cannot be filed with the initial application is financially burdensome and adds considerably to the cost of filing an application, at a time when the basic filing fees are about to be increased significantly.

In fact, to be in line with the practice of many developed countries, MyIPO should be looking to abolish the routine filing of Appointment of Agent forms and instead have a provision under which they may be exceptionally requested only when the Registrar entertains serious doubts as to an agent's authority to act.

3) Appointment of Agent (ID Form 10) forms signed by an agent to be accompanied by a Letter of Authorisation from the applicant.

It is learnt that ID Form 10 may be signed by the agent but must be supported by a Letter of Authorisation from the applicant. While MIPA welcomes this ruling that agents may sign the ID Form 10, we see no need for the Letter of Authorisation from the applicant as it is unnecessarily burdensome to the agent and his/her clients/associates. Logically, no agent would spend any funds on an industrial design filing if

he/she has not been instructed to do so by his/her clients/associates. Of course, such Letters of Authorisations may be requested on a case-by-case basis whenever the Registrar has doubts as to the agent's authority to act.

Thank you.

Yours sincerely

A handwritten signature in black ink, consisting of a stylized initial 'K' followed by a horizontal line extending to the right.

Chew Phye Keat
MIPA President

c.c. Puan Shamsiah Kamaruddin
Deputy Director General (Industrial Property], MyIPO.

Mr. Desmond Wee Tian Peng
Corporation Member, MyIPO.

APPENDIX A

Appointment of Agent (ID Form 10) as a filing date requirement

This practice by MyIPO also does not appear to have a legal foundation in the Industrial Designs Act 1996 and Regulations 1999. Notwithstanding Regulation 32(2), from Regulations 5(2), 19(1) and 19(2) it is clear that signature by the applicant or his agent is a requirement to be checked in the course of the formal examination rather than being compulsory at the outset. This is further confirmed by the minimum filing date requirements of Section 16, under which the application form ID Form 1 is not necessary to secure a filing date (note: Section 16(a) requires an identification of the applicant and nothing more). Since an applicant that does not appoint an agent can thus secure a filing date without any signature, there should not be objection (for filing date purposes) to an agent filing an application without an ID Form 10. The matter should be raised only as a deficiency under formal examination, as used to be the practice many years ago. This would also be in line with MyIPO's practice on Patents Form No. 17.
