

Best Practices of IP Mediation in Malaysia

Intellectual Property Corporation of Malaysia (MyIPO)

24 March 2025

Mohd Syaufiq bin Abdul Latif

Legal Officer / Secretary of Copyright Tribunal



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
- ▶ Administers and enforces Intellectual Property Legislation namely the Trademarks Act 2019, the Patents Act 1983, the Copyright Act 1987, the Industrial Designs Act 1996, the Layout Designs of Integrated Circuits Act 2000, Geographical Indications Act 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

33C. (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.

PATENTS ACT 1983



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.



LAW OF
MALAYSIA

Act 815

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:



LAW OF
MALAYSIA

Act 815

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.

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

117

with the Registrar by the parties to the application to the Court in the manner as determined by the Registrar within the prescribed period, without having to name the Registrar as a party.

(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.

(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



LAW OF
MALAYSIA

Act 552

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



LAW OF
MALAYSIA

Act 552

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



LAW OF
MALAYSIA

Act 332

COPYRIGHT ACT 1987

 13 Julai 2012 13 July 2012 P.U. (A) 212	WARTA KERAJAAN PERSEKUTUAN <i>FEDERAL GOVERNMENT GAZETTE</i>
PERATURAN-PERATURAN HAK CIPTA (TRIBUNAL HAK CIPTA) 2012 <i>COPYRIGHT (COPYRIGHT TRIBUNAL) REGULATIONS 2012</i>	
 DISIARKAN OLEH/ PUBLISHED BY JABATAN PEGUAM NEGARA/ ATTORNEY GENERAL'S CHAMBERS	

Copyright of the Attorney General's Chambers of Malaysia

PART IV PROCEDURE

Negotiation for settlement

18. (1) At any stage of the proceedings, the Tribunal shall where appropriate, assist the parties to effect settlement of the application, reference or appeal by consent.

(2) Where the parties reach an agreed settlement, the Tribunal shall approve and record the settlement, and the settlement shall then take effect as if it is a decision of the Tribunal.



LEGAL DEVELOPMENT IN MALAYSIA



1

MEDIATION ACT 1983



LAW OF
MALAYSIA

Act 749

MEDIATION ACT 2012

- 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



LAW OF
MALAYSIA

Act 749

MEDIATION ACT 2012

NON-APPLICATION

1. Proceedings involving a question which arises as to the effect of any provision of the Federal Constitution.
2. Suits involving prerogative writs, as set out in the Schedule to the Courts of Judicature Act 1964 [Act 91].
3. Proceedings involving the remedy of temporary or permanent injunctions.
4. Election petitions under the Election Offences Act 1954 [Act 5].
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.
7. Judicial review.
8. Appeals.
9. Revision.
10. Any proceedings before a native court.
11. Any criminal matter.

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



LAW OF
MALAYSIA

Act 749

MEDIATION ACT 2012

2

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

COURT ANNEXED MEDIATION

RULES OF COURT 2012



MEDIATION DIVISION
OFFICE OF THE CHIEF REGISTRAR OF THE FEDERAL COURT OF MALAYSIA

WHY DO WE NEED MEDIATION?

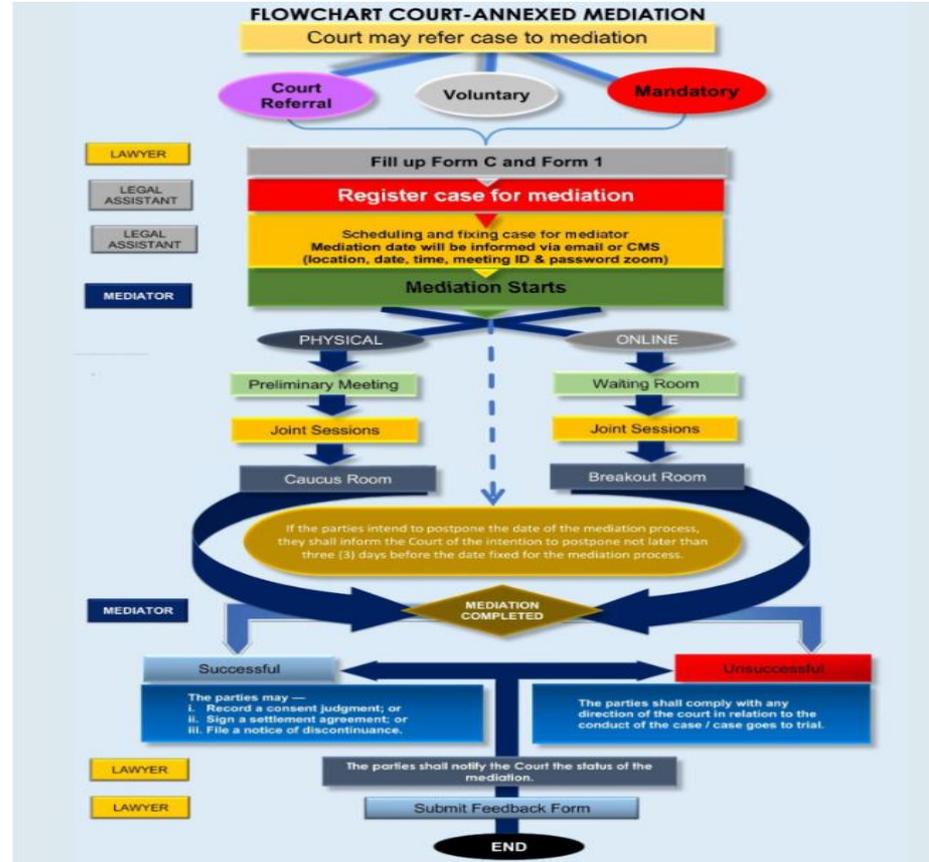
WHAT IS COURT ANNEXED MEDIATION?

Mediation is an alternative case resolution without going through a full trial process that offers the following benefits:

- 01.** Mediation services are free. **FREE!**
- 02.** Mediators consist of experienced and knowledgeable Judges and Judicial Officers.
- 03.** No party loses because the agreement to a settlement is reached voluntarily. Win-win situation.
- 04.** The settlement agreement also binds the parties according to contract law.
- 05.** Mediation can save time.
- 06.** Mediation is private and confidential and very useful for the purpose of protecting the good name of a person, business etc. **TOP SECRET**
- 07.** Mediation can strengthen the relationship between the conflicting parties because it gives the parties the opportunity to explain their respective situations.
- 08.** The mediation process is informal and flexible. The parties are more comfortable discussing.
- 09.** Facilities at the mediation center which provide mediation rooms and caucus rooms, will provide comfort to the parties to negotiate comfortably and reduce the feeling of anxiety to appear in open court.

MEDIATION DIVISION
mtkimediasi@kehakiman.gov.my

COURT ANNEXED MEDIATION PROCESS



COURT ANNEXED MEDIATION PROCESS



Mediation Division
Office of the Chief Registrar
Federal Court Malaysia

FORM 1

PLEASE TICK (✓) ONE ANSWER ONLY

- 1) Mediation referred by the High Court Judge / Sessions Court Judge / Magistrate
- 2) Voluntary Mediation

Agreement to Mediate Pursuant to Court Annexed Mediation

Case No :

Judge / Mediator :

Parties : Plaintiff :

Defendant :

Third Party :

Mention Date :

Hearing Date :

We, the solicitors representing the abovementioned parties hereby consent to refer this matter for mediation for the purpose to reach an amicable settlement and to the satisfaction of all parties.

It is hereby agreed that

- a) The mediation process conducted is a closed process attended only by the parties involved or an authorized representative together with counsel, if any;
- b) Any disclosures, admissions and communications made during the mediation process are confidential and without prejudice;
- c) All communications during the mediation process shall not be part of the records of proceedings; and
- d) Neither party shall call the mediator to give evidence in relation to the mediation process conducted by the mediator for the proceedings.

.....
 Plaintiff / Plaintiff's
 Solicitor's Signature

.....
 Defendant / Defendant's
 Solicitor's Signature

.....
 Third Party / Third Party's Solicitor's Signature

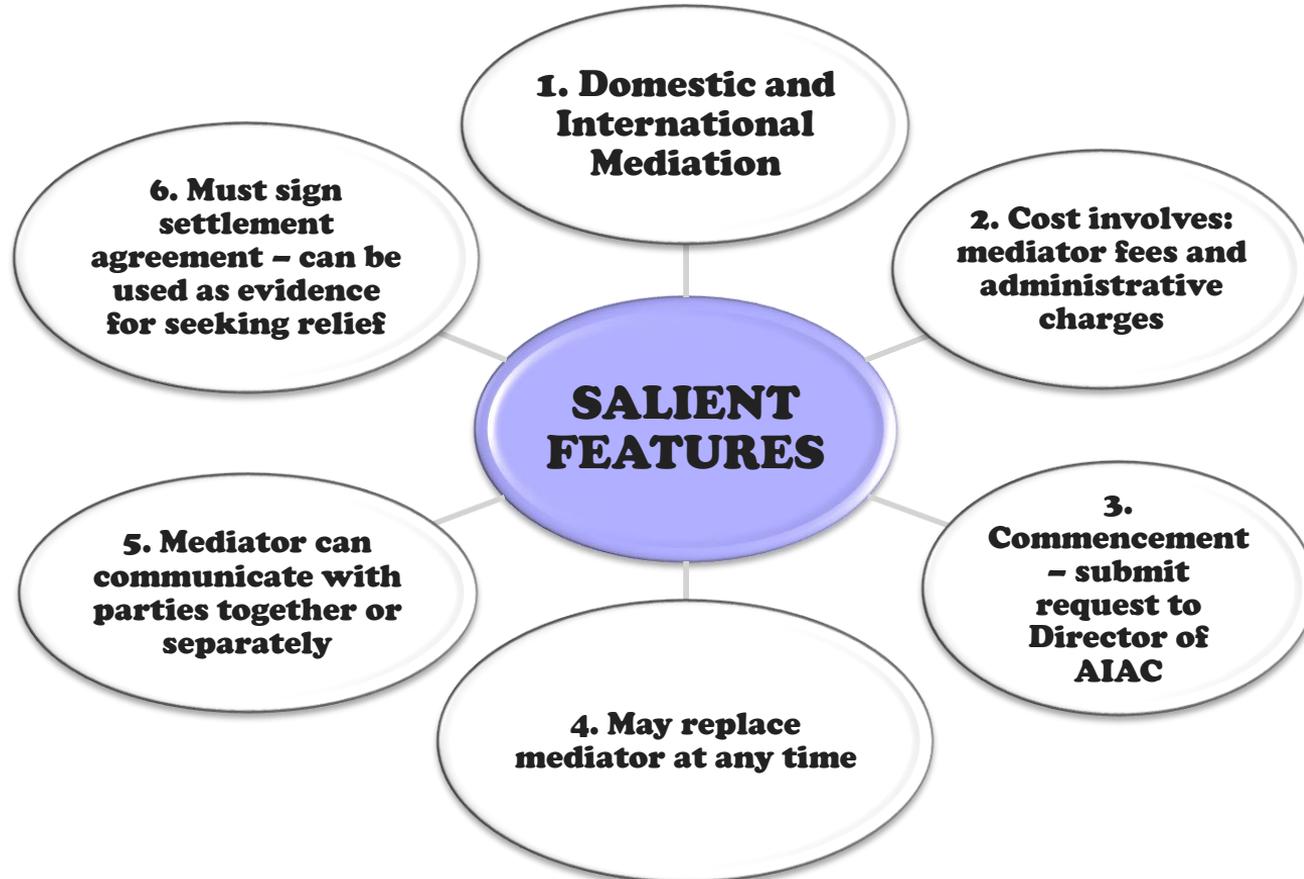
ASIAN INTERNATIONAL ARBITRATION CENTRE



- 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



4

MALAYSIAN INTERNATIONAL MEDIATION CENTRE



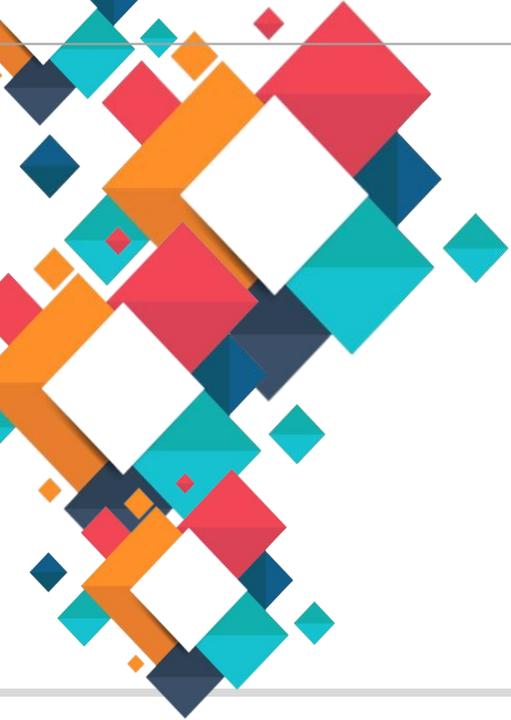
MALAYSIAN INTERNATIONAL
MEDIATION CENTRE (MIMC)

- 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



Challenges (from the context of IP Office)

There is no expressed legal framework on mediation in the IP Laws

Awareness of the benefits is not highly discussed



Future Plans (from the context of IP Office)

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

Promotion and encouragement on the use of ADR may produce positive result

|||

THANK YOU



PERBADANAN HARTA INTELEK MALAYSIA
INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA