

A Guide to Selecting an IP Professional

Intellectual Property (IP) is a complex area of law. Some IP rights are governed by statutes while others are not. And not all IP rights are registrable. Often, a particular product will embody a number of IP rights. Accordingly, steps should be taken to timely and properly identify, protect and manage the relevant rights. In the context of commercialisation and enforcement, the subject of IP often overlaps with other fields of law, such as licensing, assignment, confidential obligations, passing off, misappropriation, misrepresentation and/or trade description.

In view of the complexity involved, it is advisable that the application for registration of the relevant IP rights must be filed through registered trade mark, patent and/or industrial designs agents being those who are well-versed with the laws and practice of the relevant IP. In Malaysia, only agents who are registered with the Intellectual Property Corporation of Malaysia, ("MyIPO") are allowed to act as trade mark, patent and/or industrial designs agents. The lists of registered trade mark, patent or industrial design agents ("IP Agents") are available on the official website of MyIPO, www.myipo.gov.my

It is advisable that an application, be it for trade mark, patent or industrial design, is well-drafted and is done correctly to save you valuable time and money. This is to ensure that your rights are adequately carved out and properly protected. An ill-drafted application / specification will not only affect the extent of IP protection that you get, it may also result in unnecessary delay in obtaining a registration. In extreme cases, the application may be rejected and/or may need to be re-filed.

As IP is a specialised area, the selection of an IP Agent should primarily be based on the said agent's expertise. It is thus prudent to seek alternative opinion(s) and quotation(s) before selecting and appointing a particular IP Agent.

Specifically in choosing an IP Agent to apply for your patent and/or utility innovations, the IP Agent you choose should possess the relevant technical expertise to enable him or her to not only to understand your invention but to also be in a position to advise you and draft the necessary claims and specifications. You may wish to request for samples of his / her work and to meet with his / her team to enable you to better determine whether the said IP Agent is able to meet your needs.

For foreign applications, it is advisable to engage a registered agent located in the relevant country to act for you in your IP matters. This is to ensure that the application in question meets the laws, regulations and practice of that particular country. Your Malaysian IP Agent should either be able to recommend someone for you.

Generally, before engaging an IP Agent, you may wish to request for an itemised quotation of fees and charges, as well as the proposed billing schedule to ensure that the same is acceptable to you.

If the IP Agent is also a qualified lawyer in Malaysia, you may approach the Bar Council of Malaysia (<http://www.malaysianbar.org.my>) to ascertain if the particular lawyer holds a valid legal practising certificate. In the event of any misconduct, a complaint may be lodged with the Bar Council Advocate and Solicitors Disciplinary Board for actions to be taken pursuant to the Legal Profession Act 1976. For more information on the Discliplinary Board, please visit <http://www.asdb.org.my>.

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