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Succeed in Southeast Asia's 2.0 Markets - Green Technology Industry in Malaysia

South-East Asia IPR SME Helpdesk

**EU-Malaysia Chamber of Commerce and
Industry SEBSEAM-M**

Mrs. Norma Datuk, EUMCCI Business Advisor

Mr. Philippe Girard-Foley, South-East Asia Helpdesk IP Expert

*A project co-funded by the European
Union.*

Welcome to the Webinar!



Marianne Karu
Project Officer

South-East Asia IPR SME Helpdesk



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7 October 2016

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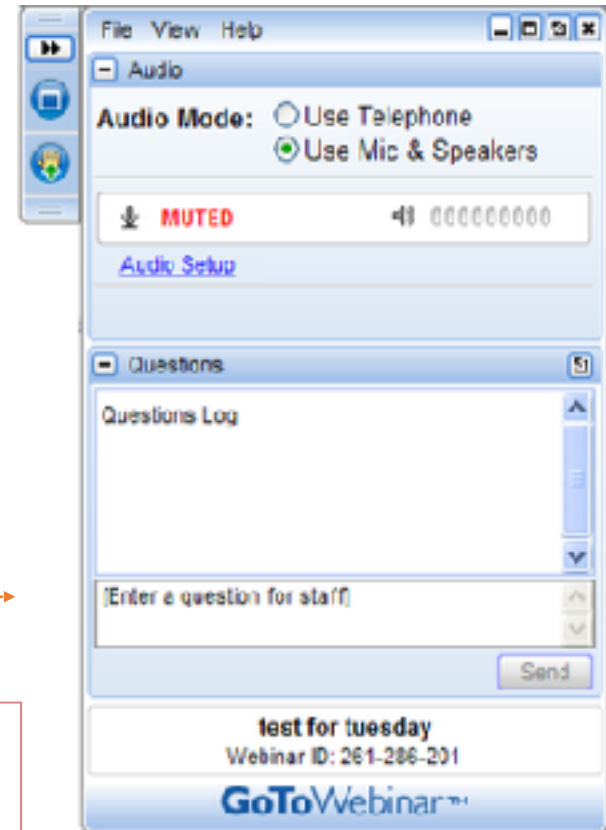
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I Speaker

Name:

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Location:

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Bio:

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II Speaker

Name: Philippe Girard-Foley

Firm: GIRARD-FOLEY & Associates

Location: Kuala Lumpur, Malaysia

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Over a continuous presence of more than 25 years, Philippe Girard-Foley has helped many European companies protect and defend their IP rights and establish a successful business in Asia, through direct investment, partnership, distributorship, agency, franchising or otherwise. He is a regular speaker at events focusing on ASEAN matters, and has authored several publications on ASEAN IP laws including the chapters on Malaysia, Indonesia and Vietnam of 'Intellectual Property Rights - Acquisition, Scope and Enforcement' for the EU program Asia Invest.

Philippe Girard-Foley has received both a civil law and common law education (Paris Sorbonne, Paris Institute of Political Sciences 'Sciences Po', University of Pennsylvania Law School, CIArb London) and is a member of the Paris Bar from France as well as an associate member of the Victoria Law Institute from Australia. Philippe joined South East Asia IPR SME Helpdesk network in 2013.

IP AND GREEN TECHNOLOGY - AN ASIAN AND MALAYSIAN PERSPECTIVE



Green Technology = Innovation

Hence:

- expensive R&D (R&D necessary)
- uncertainty as to financial return (commercial success of the innovation)
 - **greater need for IP protection**
 - has to rely on **trade secrets and patents**

In green technology especially compared to other sections of the industry, IP protection is a matter of arbitrage between:

- trade secret and patent
- normal/accelerated examination



TRADE SECRET

- Increasingly a pillar “the fourth pillar” of IP - see DTSA
- Name slightly misleading (“trade”) includes manufacturing, industrial and commercial secrets

CONDITIONS

- commercial value; and
- steps to protect
- most up-to-date and comprehensive definition: DTSA



TRADE SECRET II

DRAWBACKS

- no right of exclusion - particularly an issue in fast-developing technologies such as green technology
- vulnerability to independent researching
- vulnerability to reverse-engineering
- increased difficulty to find outside investors, issue for green “untested” technology

ADVANTAGES

- lower cost
- easier process
- depending on the process or product, lower risk of reverse engineering - to be assessed case by case for green technology



PATENTS

ADVANTAGES

- right of exclusion: exclusive rights for the inventor (usually 20 years)
- protection against independent development

DRAWBACKS

- cost
- depending on the process or product, possibly higher risk of retro-engineering v/ better legal protection, but requires legal action
- time between application (disclosure once published) and grant of patent



NORMAL/ACCELERATED EXAMINATION

THE ACCELERATED EXAMINATION PROGRAMMES

Object: reduce the time necessary to obtain patent protection in green technology (and other priority areas)

- Started in the UK in 2009
- Followed same year in Australia, Israel, Japan, South Korea, USA.
- In 2001 Canada and Malaysia
- In 2012, Brazil and China



NORMAL/ACCELERATED EXAMINATION

Not a uniformed system!

- In Australia, Canada and UK: all environmental friendly inventions are eligible
- In Japan, only energy-saving and carbon-saving
- In Brazil, “clean tech” i.e. “green energy”
- EPO European Patent Office: accelerated examination procedure open to all patent applications subject to conditions
- USA - Green Technology Pilot Program closed in 2012 with 3,500 pending applications. Replaced by three programmes including Prioritized Examination (Track 1) program (exemption of pre-examination search) open to utility and plant applications.



MALAYSIA

The Expedited Examination Programme (EEP)

Came into force on 15 February 2011

- normally, patents in Malaysia take around three to four years from filing to grant (if no objection during prosecution)
- possibility to jump the queue with the EEP:
 - file a request with MyIPO (Intellectual Property Corporation of Malaysia), if approved, notification of approval by Registrar
 - file a request for Expedited Examination within five working days
 - one month for issuance of first examination report (v/ one year)
 - three weeks for applicant to reply (if fails, return to normal track)
- **CONDITIONS:** one of five prescribed grounds: the invention relates to green technology that will enhance the quality of the environment or conservation of energy sources

MALAYSIA II

DRAWBACK: higher fees !

ALTERNATIVES:

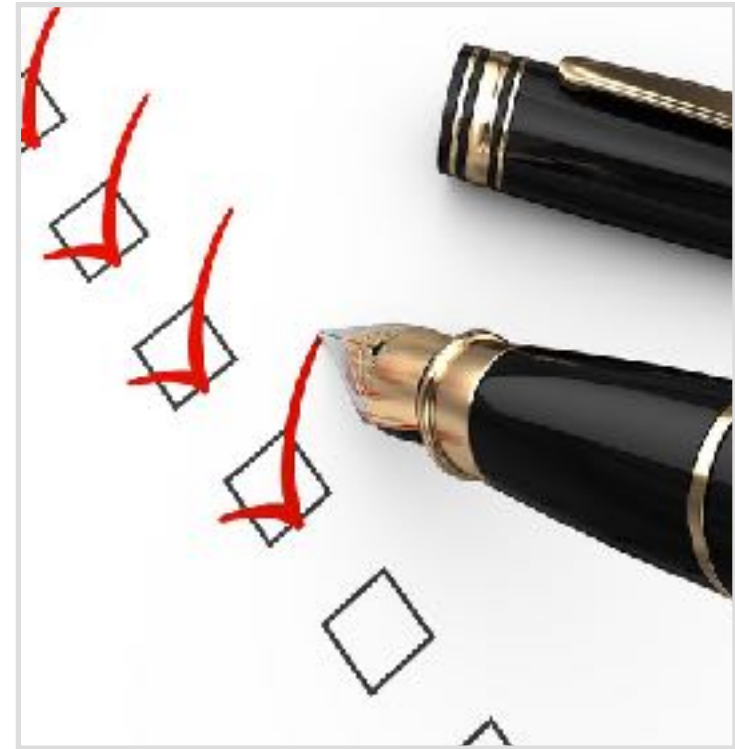
- **The PPS (Patent Prosecution Highway)**
Accelerated examination by MyIPO for applications based on matching Japanese of PCT applications approved by JPO (Japan Patent Office)
 - four to five months
 - no additional fee
- **The Modified Substantive Examination** - Expedited grant for modified examination based on patent granted by Australia, UK, USA, Japan, Korea or EPO
 - six to twelve months
 - no fee



ARBITRAGE PATENT / TRADE SECRET

The points to consider:

- can the product be retro-engineered?
 - if not, preference for trade secret
 - if yes, preference for patent
 - ... but this is a simplification: see above
- **longevity** of the product: if short term in a fast developing industry such a green tech, perhaps not worth the efforts and costs of a patent application
- **cost**: affordability, return on investment
- and of course **patentability**



In practice: a mix the best option ?



CASE STUDY

Example of a **biotech company** (US) developer of a technique combining new designs for bioreactors and micro-organisms

Their choice:

➤ **patent** for bioreactor process and product

Reasons:

- hard to keep secret
 - retro-engineering easy
- **trade secret** for organisms used in the process

Reasons:

- not patentable
- retro-engineering difficult

CASE STUDY



ARBITRAGE ACCELERATED / NORMAL TRACK

ADVANTAGES:

- speed (obvious!)
- protection against:
 - possible “competing” applications (green research active, parallel R&D)
 - risk of novelty-destroying prior art
- image “green company” (generally, patents obtained through a fast track procedure have a higher value)
- helps to find investors / JV partners / licensees
- courts’ friendly attitude re-enforcement



ARBITRAGE ACCELERATED / NORMAL TRACK II

But on the other hand...

- higher fees (sometimes, e.g. Malaysia)
- date of application/publication more relevant than date of grant for anti-infringement purposes
- costs incurred earlier
- less time to assess the commercial prospects of the invention before completion of the application process
- less time to adjust the claims to R&D progress until final version



Q&A Session

Please type in your questions using the question box on your screen. Indicate whether your question is addressed to:

Mrs. Norma Datuk, EUMCCI Business Advisor on Green Technologies

Mr. Philippe Girard-Foley, South-East Asia IPR SME Helpdesk IP Expert

Q & A

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KNOW BEFORE YOU GO. WE ARE HERE TO HELP YOU GROW.

The South-East Asia IPR SME Helpdesk provides free, confidential, business-focused advice to European Small and Medium Enterprises (SMEs) relating to IPR in South-East-Asia.

To learn about any aspect of intellectual property rights in Vietnam or elsewhere in South East Asia, including

- ✓ Local partners
- ✓ Due diligence
- ✓ IP audits
- ✓ Or to simply learn about the local landscape and adapt your IP plan accordingly - something which can save you EUR in the long term

Contact us on question@southeastasia-iprhelpdesk.eu