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# WHEN SHOULD AN INVENTOR CHOOSE UTILITY INNOVATION OVER PATENT

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It is a well-known fact that in order to qualify for a patent, an invention must meet three basic criteria:

1. the characteristics of the claims must be totally new or novel
2. the characteristics of the claim must involve inventive step, and
3. the invention is industrially applicable.

However, some inventions may not meet all these criteria. For example, if the characteristics of the claim are novel but it is clear that there is no inventive step, does the inventor not qualify for any form of ownership?

In Malaysia's Patents Act 1983, there is an explanation regarding the granting of a Certificate Utility Innovation (CUI) whereby if the characteristic of the claim of an invention is novel but does not involve inventive step, it can be registered.

Utility Innovation (UI) means any innovation which creates a new product or process, or any new improvement of a known product or process, which is capable of industrial application.

The key disparity between a patent and a CUI is that only one claim is allowed for CUI while a patent can have several claims.

The period for a patent is 20 years from the filing date while a CUI is 10 years from the filing date.

However, a CUI owner can, before the expiry of five years from the date of application, apply for an extension period of five years, and before the expiration of the second term of five years, apply for an extension of another five years. It gives a maximum protection of probably 15 years from the filing date.

And, this is subjected to payment of annuity fees.

Also, due to less stringent requirements for CUI, it is easier to get a CUI as compared to a patent. However, it is easier to defend and attack the validity of CUI as compared to defending patents.

The only obstacle is the limit on the number of claims. In a patent, there will be different dependent claims directed to a different embodiment of the invention or its different important features. Whereas in CUI, because only one claim is allowed, an inventor has often declared important characteristics that may be included in products that can be commercialised.

Although it is possible to file a patent and CUI at the same time, a patent or CUI can only be given for the same invention. It is also possible to convert a patent application into an application for CUI during the examination process and vice versa. In practice, the choice to change is done after Substantive Examination Report is received.

Procedures to apply for a CUI are the same as the process to apply for a patent. An UI application can be the original application for an international patent by using PCT or Paris Convention. A national-level application using PCT can be filed as UI application under the PCT Regulations.

Inventors in Malaysia should still be observant when considering getting a CUI if they think that innovative characteristics, although novel, may not be inventive, and do not meet the characteristics of a patent. It is also good to know that a CUI will act as a strong deterrent document against any violations of the law or infringement.

