TAY & PARTNERS

The Patents (Amendment) Act 2022 together with the Patents (Amendment) Regulations 2022 have come into force on 18 March 2022, with the exception of some provisions. The amendments incorporated Malaysia's commitments in various international agreements and treaties, including the Agreement of Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement") and the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure ("Budapest Treaty"). Below are the following key amendments introduced by the said Act and Regulations:

**1. Definition of resident**

Section 3 of the Patents Act 1983 ("Act") has been amended to include the definition of "resident", which covers Malaysian citizens residing in Malaysia as well as non-Malaysian citizens who are residing in Malaysia whether by virtue of a permanent resident status or a valid pass lawfully issued under the Immigration Act 1959. The definition of resident also extends to any body corporate incorporated or any unincorporated body established or registered under any written law in Malaysia.

The above amendment would mean that all of the persons falling within the definition of "resident" will be subject to section 23A of the Act which requires residents to first apply for a patent application in Malaysia.

## 2. New and revised timeframes

New and/or revised timeframes for certain applications and/or procedures have been introduced by virtue of the amended Act and/or Patents Regulations 1983 ("Regulations"):

**(a) Conversion of applications**

Section 17B(4) of the Act has been amended to require a request for conversion of applications to be filed within the prescribed period of three months as provided under the new Regulation 33C(1A) of the Regulations. This is a significantly shorter period compared to the previously prescribed period of six months. Further, the Act provides that the newly prescribed period of three months shall not be extended by the Registrar.

**(b) Judicial assignment**

The time limitation for commencing an application for judicial assignment of a patent application or patent under section 19 of the Act has been extended from five years to six years.

**(c) Reinstatement of lapsed patent**

An application for the reinstatement of a lapsed patent must now be made within twelve months from the date of the notice pursuant to section 35A(1) of the Act instead of two years previously.

**(d) Infringement proceedings**

The time limit for commencing infringement proceedings has been extended from five years to six years from the act of infringement.

**(e) Observations on the report of substantive examination and modified substantive examination**

The time limit for an applicant to make observations pursuant to section 30(3) of the Act has been extended from two months to three months.

**(f) Request for conversion of application**

A new time limit for making a request for conversion of applications has been introduced by Regulation 33C(1A) of the Regulations, where such requests must now be made within three months from the date of the report made by the Examiner pursuant to substantive examination or modified substantive examination.

**(g) Extension of time**

Any request for an extension of time after the expiration of a prescribed period must now be made not later than six months from the expiration of the prescribed period.

**3. Conditions for divisional application**

The new subsection 26B(1A) of the Act prohibits any application for division if the initial application had been granted a patent, refused, withdrawn or deemed to be withdrawn. Further, no extension of time is allowed for an applicant to make a divisional application.

**4. Restoration of right of priority**

Section 27(1B) of the Act provides for an applicant's right to make a request for restoration of right of priority after the expiry of the period of twelve months from the priority date.

The mechanism for such request is provided under the new Regulation 23A of the Regulations. For patent applications filed at the Patent Registration Office, the request for restoration must be made within the period of two months from the expiry date of the right of priority. The request may be made on the ground that the failure to file the application within the right of priority period is unintentional, which shall be accompanied by a statement of the reasons and evidence in support by way of a statutory declaration. If the Registrar is of the view that the conditions have not been satisfied, the applicant will be given an opportunity to make observations.

Requests for restoration of right of priority may also be made in relation to international applications entering the national phase under section 78O or 78OA of the Act, where the request must be made within the period of one month from the expiration of thirty months from the priority date.

**5. Sequence listing as filing requirement**

Section 28(1)(c) of the Act and Regulations 5(1)(b) and 18(1A) of the Regulations have been amended to require an applicant to include a sequence listing (if any) in their patent applications. Regulations 12A, 18(7A)

and 18(12) of the Regulations further provide for the form for the submission of sequence listing to the Patent Registration Office.

**6. Additional fees for applications containing more than ten claims**

Patent applications containing more than ten claims would be subjected to an additional fee for each subsequent claim. Where the applicant fails to make payment of such fees or fails to comply with the Registrar's request to make such payments, the date of receipt of the application shall be recorded as the filing date for the first ten claims only.

**7. No deferment of substantive examination**

Request for deferment of substantive examination is no longer available and only requests for deferment of modified substantive examination may be made on the ground that the corresponding patent to be used for the modified substantive examination has not been granted or is not available by the expiration of eighteen months from the date of the patent application.

**8. Notice of express trust may be accepted**

A notice of an express trust or a beneficiary of an express trust may now be accepted and entered in the Register. Notice of any implied or constructive trust still could not be accepted or entered in the Register.

**9. Right of third party to make observations**

Section 34A of the Act introduces a right for third parties to make observations on any matter relating to the patentability of a patent application. Such observations may be made within three months from the date of the publication of the patent application or three months from the date of the international application entering the national phase. The observations shall be limited to the ground of novelty or inventive step and must be accompanied by an explanation on the grounds as well as documentary evidence by way of statutory declaration.

**10. Recognition of patent applications and patents as objects of property**

Heading of Part VIII of the Act as well as section 39 have been amended to recognise patent applications and patents as objects of property which may be transmitted in the same way as other personal or moveable property. A patent may also be the subject of a security interest transaction which may be recorded in the Register.

**11. Compulsory licensing for pharmaceutical products**

Several amendments have been introduced in Part X of the Act to provide for compulsory licensing for the production, importation and exportation of patented pharmaceutical products in compliance with Article 31bis of the TRIPS Agreement.

**12. Re-examination for post-grant amendments**

When an owner of a patent makes a request to amend the patent, the Registrar may require the patent owner to file a request for re-examination or the applicant may file such a request on his own volition.

**13. Procedure for the opportunity to be heard**

Where a person has an opportunity to be heard pursuant to section 81 of the Act, there is an additional step before the Registrar may issue a notice of the hearing date. Regulation 47 of the Regulations now provide that the Registrar must first issue a notification of an opportunity of being heard, to which the person must make a request for a hearing within the period of 3 months. Only upon the request shall the Registrar issue a notice of the date of hearing.

The following amendments have been incorporated but they are not yet in force:

**1. Deposit of micro-organisms**

The new section 26C of the Act ensures compliance with the Budapest Treaty by allowing deposit of micro-organisms with any National or International Depositary Authority for satisfying the disclosure requirement in patent applications.

## 2. Opposition proceedings

Under the new section 55A of the Act, opposition proceedings may be commenced by any interested person after the publication of the grant of a patent on the same grounds as applicable to invalidation proceedings under section 56 of the Act. The opposition proceeding may only be commenced if there is no invalidation proceeding or any other proceeding that has been instituted in Court by the interested person in relation to the relevant patent.

If the Registrar decides to maintain the patent at the end of the opposition proceedings, the interested person may not commence invalidation proceedings in Court, but may choose to appeal to the Court against the Registrar's decision pursuant to section 88 of the Act.

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