



A New Chapter in Malaysia's Patent System – Introduction of Opposition Proceedings

Malaysia's intellectual property landscape will undergo a significant transformation with the introduction of opposition proceedings for granted patents. This landmark shift, brought about by the Patents (Amendment) Act 2022, requires patent owners and interested third parties to prepare for a new administrative challenge mechanism.

I. The New Landscape: Effective Date

The framework for challenging a patent post-grant is established under the new Section 55A of the Patents Act 1983, which will be complemented by the new Regulations 43A to 43U of the Patents Regulations 1986, Directive of Patents Act 1983 and Patents Regulations 1986 (the 3rd amended version, Ref PT01-2025) (dated 10th October 2025) and Practice Notice No. 1 of 2025 (dated 10th October 2025). The aforesaid are scheduled to take effect on 31st December 2025.

The following is a brief outline of some of the steps and requirements which the new opposition framework will entail.

II. Initiation of Opposition

- **Who Can Oppose:** Opposition may be filed by "*any interested person*", provided no court proceedings under PA 1983 relating to the patent are currently instituted.
- **Time Limit:** Notice of opposition must be filed within 6 months from the date of the publication of the patent.
- **Filing Requirements:** The notice must be supported by a statement detailing the grounds and facts relied upon, as well as evidence in the form of a statutory declaration.
- **Security for Costs:** If the interested person is not a resident, security for costs must be given at the time of filing the notice of opposition. The amount is RM2,500.00 for opposition against the grant of a patent and RM1,500.00 for opposition against the grant of a certificate for utility innovation.

III. The Patent Owner's Response

- **Notification:** The Registrar issues a copy of the opposition notice to the patent owner.
- **Filing Counterstatement:** The owner has 3 months from the Registrar's issuance date to file a counterstatement, accompanied by a supporting statement and evidence in the form of a statutory declaration.
- **Request to Amend:** The owner may file a request to amend the patent simultaneously with the counterstatement, specifically for the purpose of responding to the grounds of opposition.
- **Consequence of Default:** If the owner fails to file a counterstatement or the counterstatement has been treated as abandoned or refused, the owner will not be allowed to proceed in the opposition, and the Registrar may decide based on the notice of opposition.

IV. Opposition Proceedings and Decision

- **Evidence Exchange:** The interested person has 3 months to file evidence in reply and a response to the amendment request (if any)
- **Further Evidence:** Thereafter, either party may request leave from the Registrar to submit further evidence.
- **Language of documents:** Documents filed must be in either the local Malay language or English. If evidence is not in either language, it must be accompanied by a certified translation in either of the languages.
- **Written Submission:** The Registrar may notify parties to file written submissions within 3 months. Once this notice is issued, no further evidence requests are allowed.
- **Recommendation:** An *ad hoc* opposition committee will provide a recommendation to the Registrar to either (i) maintain the patent, (ii) maintain the patent with amendment, or (iii) invalidate the patent.
- **Final Opportunity to Amend:** If the committee recommends invalidation, the Registrar may offer the owner (if the owner filed a counterstatement) an opportunity to request an amendment within 2 months.
- **Decision:** The Registrar makes a final decision based on the committee's recommendation, which is appealable under Section 88, PA 1983.

V. Costs and Withdrawal

- **Awarding Costs:** The Registrar may award costs to the winning party if costs were applied for by the opponent in the notice of opposition or by the owner in the counterstatement.
- **Recovery of security for costs:** If costs are awarded to the owner and remain unpaid, the owner may request the Registrar to claim from the non-resident opponent's security for costs.
- **Withdrawal:** An interested person may withdraw the notice of opposition. The Registrar may award costs to the owner if the withdrawal occurs after the counterstatement has been filed, provided the owner applied for costs.

For further information on the matters discussed above or intellectual property law generally, please get in touch with Lee Lin Li, our partner and head of IP practice. The information in this article is intended only to provide general information and does not constitute any legal opinion or professional advice.

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