

Material Changes to the Patents Act 1983

The Patents (Amendment) Act 2022 ("**2022 Amendment**") came into force on 18.3.2022 and brought upon drastic changes to the Patents Act 1983 ("**Patents Act**") (which was last amended 16 years ago). This article aims to highlight the material changes brought upon by the 2022 Amendment.

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Time Limits

Several time limits were amended pursuant to the 2022 Amendment:

- Applications for judicial assignments are extended to 6 years (previously 5 years);¹
- Time limit for commencing a patent infringement action is extended to 6 years (previously 5 years);²
- Reinstatement of a lapsed patent is reduced to 12 months (previously 2 years).³

The Patents (Amendment of Second Schedule) Order 2022 did not amend the 2-year limitation period for utility innovation infringement.⁴

Reduced Scope of Matters Eligible for Extension of Time

Except where ordered by any Court, the Patents Act now prohibits extensions of time for the following matters:⁵

- the period in which a request for conversion from a patent to a certificate for a utility innovation and *vice versa* is to be filed (i.e. 6 months from the date the Registrar makes known to the applicant the report made by the Examiner);⁶
- the period in which a request for division of a patent application is to be filed (i.e. 3 months from the date of mailing of the Examiner's report);⁷
- power may not be exercised in respect of the right of priority;⁸
- the period in which the Registrar prescribes for the applicant to furnish outstanding specifications (eg. description, claims and/or drawings) which were not filed together with the patent application, correct details of the patent application and pay any shortfall of the prescribed fees for claims exceeding ten claims wherein each subsequent claim is subject to additional fees;⁹
- the period in which a request for substantive examination or modified substantive examination;¹⁰ or

¹ Section 19 of the Patents Act 1983; Section 8 of the 2022 Amendment

² Section 59 of the Patents Act 1983; Section 49 of the 2022 Amendment

³ Section 35A of the Patents Act 1983; Section 29 of the 2022 Amendment

⁴ Patents (Amendment of Second Schedule) Order 2022 came into force on 18.3.2022

⁵ Section 82 of the Patents Act 1983; Section 60 of the 2022 Amendment read together with sections 17B(4A), 26B(1B), 27(1A), 28(6) and 30(4) of the Patents Act 1983

⁶ Section 17B(4A) Patents Act 1983; Section 6 of the 2022 Amendment

⁷ Section 26B(1B) Patents Act 1983 read together with regulation 19A of the Patents Regulations 1986; Section 13 of the 2022 Amendment

⁸ Section 27(1A) Patents Act 1983

⁹ Section 28(2), (2A) and (4) Patents Act 1983; Section 16 of the 2022 Amendment

¹⁰ Section 29A(8) Patents Act 1983; Section 17 of the 2022 Amendment

- a subsequent extension of time for the patent applicant to make observations on the Examiner's report or to amend the application so as to comply with the requirements of the Act and Regulations.¹¹

Collateralising Patents

The 2022 Amendment introduced section 39(1A) which provides that a patent may be the subject of a security interest in the same way as other personal or moveable property.¹²

Patent Opposition Proceedings

Formerly, only the High Court had the jurisdiction to invalidate a patent. The 2022 Amendment introduces section 55A which is a new regime essentially allowing any interested person to apply to the Registrar to file a notice of opposition against the owner of a patent.¹³ The precondition to utilise this new section is that the interested person has not previously instituted any proceedings in Court under any provisions of the Patents Act.

The grounds that may be relied on by an interested person are:

- that what is claimed as an invention in the patent is not an "invention", is a non-patentable invention, is prohibited by any law or regulation, except where the performance of that act would be contrary to public order or morality, or is not patentable because it does not comply with the provisions of patentable inventions, is not novel, does not involve an inventive step or is not industrially applicable;
- that the description or the claim does not comply with the regulations; and
- that any drawings which are necessary for the understanding of the claimed invention have not been furnished

It is to be noted that the grounds of invalidation that may be relied on by an interested person in an opposition proceeding before the Registrar is more limited as compared to an invalidation proceeding instituted in the High Court.

At the end of the opposition proceedings, the Registrar shall decide whether to maintain the patent, maintain the patent with any amendment; or invalidate the patent. Where the Registrar decides to maintain the grant of a patent, the interested person shall be barred from commencing invalidation proceedings under section 56 of the Patents Act except by way of counterclaim for the invalidation or appeal to the Court.

At the date of this writing of this article, section 55A has yet to come into force.

Third Party Observation

The 2022 Amendment also introduced a new section 34A which essentially allows any person within the prescribed period to make observations on any matter relating to patentability of a patent application.¹⁴

The third party observation shall be:

- for the purposes of an application, limited to the ground of novelty specified under section 14 of the Patents Act or inventive step specified under section 15 of the Patents Act; or
- for the purposes of application for the grant of a certificate of utility innovation, limited to the ground of novelty specified under section 14 of the Patents Act; and

¹¹ Section 30(4) of Patents Act 1983; Section 18 of the 2022 Amendment

¹² Section 33(1A) of the Patents Act 1983; Section 33 of the 2022 Amendment

¹³ Section 55A of the Patents Act 1983; Section 45 of the 2022 Amendment

¹⁴ Section 34A of the Patents Act 1983; Section 27 of the 2022 Amendment

- accompanied by –
 - (a) an explanation on the grounds of the observation; and
 - (b) documentary evidence by way of statutory declaration to support the explanation on the grounds of the observation.

Deferment of Substantive Examination No Longer Available

Pursuant to the 2022 Amendment, the Patents Act now only allows deferment for the filing of request for a modified substantive examination (no longer for both substantive and modified substantive examination). This deferment may be allowed only on the grounds that the patent has not been granted or is not available by the expiration of the prescribed period for the filing of the request for modified substantive examination.¹⁵

Malaysia *En Route* to the Budapest Treaty

The 2022 Amendment clarifies that micro-biological processes are patentable inventions.¹⁶ In conjunction with this change, sections 26C and 78O(1A) are added to the Patents Act to introduce a procedure to deposit a sample of micro-organisms which is not available to the public and cannot be described in the application for a patent in such a manner as to enable the invention to be carried out by a person having ordinary skill in the art with a National Depositary Authority or an International Depositary Authority.¹⁷ This procedure is to meet the legal requirement of sufficiency of disclosure for a patent application which is in compliance with the Budapest Treaty.

At the date of writing this article, section 26C and 78O(1A) have yet to come into force.

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DISCLAIMER:

*This article is for general information only and should not be relied upon as legal advice.
The position stated herein is as at the date of publication on 12 April 2022.*

¹⁵ Section 29A(6) & 6A of the Patents Act 1983; Section 17 of the 2022 Amendment

¹⁶ Section 13 of the Patents Act 1983; Section 4 of the 2022 Amendment

¹⁷ Sections 26C and 78O of the Patents Act 1983