

# LHAG Insights

Intellectual Property, Sports & Gaming



## ABOUT THE AUTHOR



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### 10 Key Amendments to Patent Law

The Patents (Amendment) Act 2022 came into force on 18 March 2022.<sup>1</sup> It made various amendments to the Patents Act 1983. Here are 10 key amendments:

- (1) Limitation Period for Infringement [Section 59(3) – Amended]
  - The limitation period for instituting legal proceedings for patent infringement is increased from five years to six years.
- (2) Opposition Proceedings [Section 55A – New]
  - Any “*interested person*” may, within the prescribed period from the date of publication of the grant of the patent, commence opposition proceedings to invalidate the patent.
  - Security for costs determined by the Registrar shall be payable by any “*interested person*” who is not a resident.
  - The Registrar’s decision in opposition proceedings is confined to:
    - maintaining the patent;

<sup>1</sup> Patent Registration Office (MyIPO) Notice on Coming into Force of Patents (Amendment) Act 2022 (Notice 1/2022), dated 17 March 2022  
<https://www.myipo.gov.my/wp-content/uploads/2022/03/NOTIS-KUAT-KUASA-AKTA-PATEN-PINDAAN-2022.pdf>

- maintaining the patent with amendments; or
  - invalidating the patent.
- (3) Invalidation Proceedings Post Filing of Opposition [Section 56A – New]
  - Where an opposition proceeding under s 55A (*supra*) is pending the Registrar’s decision, the “*interested person*” may not institute Court proceedings for invalidation unless:
    - With the consent of both parties to the opposition proceedings; or
    - The “*interested person*” is a defendant in an infringement proceeding.
- (4) Patent as Security Interest [Sections 36(1)(d) and 39(1A) – New Subsections]
  - The owner of a patent has exclusive rights to deal with the patent as a subject of a security interest, in the same way as other personal or movable property.
- (5) Notice of Trust in Register [Section 32A – Amended]
  - A notice of an express trust or a beneficiary of an express trust, or both, may be entered into the Register. Any failure by the Registrar to enter such notice in the Register does not affect the right or duty under the trust concerned.
- (6) International Application [Section 78F – Amended]
  - A citizen of Malaysia residing outside Malaysia is entitled to file an international application with the Patent Registration Office.
- (7) Compulsory Licence [Section 52A – New]
  - The Registrar may grant a compulsory licence to the applicant, notwithstanding the existence of a licence contract between the licensor and the licensee.
  - No cause of action for breach of licence by the licensee against the licensor shall accrue by the grant of such licence.

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(8) Costs [Section 88A – New]

- In all court proceedings, the court may award any party (including the Registrar) costs. However, the Registrar shall not be ordered to pay costs to any party.

(9) No Proceedings against Registrar [Section 88B — New]

- No action, suit, prosecution or other proceedings can be instituted against the Registrar (or any other officer under the direction of the Registrar) in respect of any act ordered or done for the purpose of carrying into effect the Act, if the act was ordered or done in good faith and in a reasonable belief that it was necessary.

(10) No Joinder of Parties against Registrar [Section 88D — New]

- In the absence of a cause of action against the Registrar, the Registrar shall not be made a party to proceedings concerning:
  - judicial assignment proceedings under s 19;
  - an appeal against the Registrar's decisions in granting compulsory licence under s 51;
  - an appeal against the Registrar's decisions in opposition proceedings under s 55A;
  - invalidation proceedings under s 56;
  - infringement proceedings under s 59; and
  - an appeal against the Minister's decision under s 84.

**Chng Keng Lung and Seaw Ja Yee** (Pupil-in-Chambers)

If you have any queries, please contact team partner [Chng Keng Lung](mailto:ckl@lh-ag.com) ([ckl@lh-ag.com](mailto:ckl@lh-ag.com)).