

A BILL

*i n t i t u l e d*

An Act to amend the Patents Act 1983.

[ ]

**ENACTED** by the Parliament of Malaysia as follows:

**Short title and commencement**

**1.** (1) This Act may be cited as the Patents (Amendment) Act 2021.

(2) This Act comes into operation on a date to be appointed by the Minister by notification in the *Gazette* and the Minister may appoint different dates for the coming into operation of different provisions of this Act.

**General amendment**

**2.** The Patents Act 1983 [*Act 291*], which is referred to as the “principal Act” in this Act, is amended—

- (a) by substituting for the word “*Gazette*” wherever appearing the words “Official Journal” except in section 1; and
- (b) by substituting for the words “prescribed time” wherever appearing the words “prescribed period”.

**Amendment of section 3****3. Section 3 of the principal Act is amended—**

- (a) by inserting after the definition of “Corporation” the following definition:

‘ “Council for TRIPS” means the council established under the TRIPS Agreement;’;

- (b) by inserting after the definition of “filing date” the following definitions:

‘ “International Depositary Authority” means a depositary institution which has acquired the status of international depositary authority under the Budapest Treaty;

“micro-organism” means any organism of microscopic size and parts of an organism of microscopic size, including sterile organism, virus and viroid;’;

- (c) by inserting after the definition of “Minister” the following definition:

‘ “Official Journal” means the Intellectual Property Official Journal published by the Registrar under section 86A;’;

- (d) by inserting after the definition of “patented product” the following definition:

‘ “pharmaceutical product” means—

(a) any patented product; or

(b) any product manufactured through a patented process,

of the pharmaceutical sector that includes active ingredient necessary for its manufacture and diagnostic kit needed for its use;’;

(e) by inserting after the definition of “Registrar” the following definition:

‘ “resident” includes —

(a) a citizen of Malaysia who is residing in Malaysia;

(b) a non-citizen of Malaysia who —

(i) has obtained permanent resident status in Malaysia and is ordinarily residing in Malaysia;  
or

(ii) is residing in Malaysia by virtue of a valid pass lawfully issued to him under the Immigration Act 1959/63 [*Act 155*] to enter and remain in Malaysia;

(c) a body corporate incorporated, established or registered under any written law in Malaysia other than a foreign company;  
or

(d) an unincorporated body established or registered under any written law in Malaysia;’;

(f) in the definition of “right”, by substituting for the full stop at the end of that definition a semicolon; and

(g) by inserting after the definition of “right” the following definition:

‘ “TRIPS Agreement” means the Agreement on Trade-Related Aspects of Intellectual Property Rights, set out in Annex 1C to the Agreement Establishing the World Trade Organization.’.

**Amendment of section 13**

4. Paragraph 13(1)(b) of the principal Act is amended by substituting for the words “micro-organism processes” the words “micro-biological processes”.

**Amendment of section 14**

5. Paragraph 14(2)(b) of the principal Act is amended by substituting for the words “patent granted” the words “patent application published under section 33D”.

**Amendment of section 17B**

6. Section 17B of the principal Act is amended—

(a) by substituting for subsection (4) the following subsection:

“(4) A request for conversion under this section shall be filed with the Registrar within the prescribed period.”; and

(b) by inserting after subsection (4) the following subsection:

“(4A) Without prejudice to the power of the Registrar to allow conversion, the prescribed period referred to in subsection (4) shall not be extended under section 82.”.

**Amendment of section 18**

7. Subsection 18(2) of the principal Act is amended by substituting for the words “section 19” the words “the provisions of this Act”.

**Amendment of section 19**

8. Section 19 of the principal Act is amended in the proviso by substituting for the words “five years” the words “six years”.

**Amendment of section 21**

**9.** Section 21 of the principal Act is amended—

- (a) by renumbering the existing provision as subsection (1); and
- (b) by inserting after subsection (1) as renumbered the following subsection:

“(2) In this section, “Government” means the Federal Government or a State Government.”.

**Amendment of section 23A**

**10.** Section 23A of the principal Act is amended—

- (a) in the national language text—
  - (i) by renumbering the existing provision as subsection (1); and
  - (ii) in subsection (1) as renumbered, by substituting for the words “Tiada seorang pun yang bermastautin di Malaysia boleh” the words “Tiada seorang yang merupakan pemastautin boleh”;
- (b) in the English language text, in subsection (1), by substituting for the words “No person resident in Malaysia shall” the words “No person who is a resident shall”; and
- (c) by inserting after subsection (1) the following subsection:

“(2) An application for the grant of a written authority by the Registrar referred to in subsection (1) shall be made by the resident in the prescribed manner together with the payment of the prescribed fee.”.

**Amendment of section 25**

**11.** Section 25 of the principal Act is amended—

- (a) by inserting after the word “submitting” the words “to the Registrar”; and
- (b) by substituting for the words “the prescribed form to the Registrar” the words “the form as determined by the Registrar together with the payment of the prescribed fee”.

**Deletion of section 26A**

**12.** The principal Act is amended by deleting section 26A.

**Amendment of section 26B**

**13.** Section 26B of the principal Act is amended—

- (a) by substituting for subsection (1) the following subsection:

“(1) The applicant may, within the prescribed period, make a request to the Registrar for a divisional application to divide an application into two or more applications in the form as determined by the Registrar together with the payment of the prescribed fee, provided that each divisional application shall not go beyond the disclosure in the initial application.”;

- (b) by inserting after subsection (1) the following subsections:

“(1A) A request for the divisional application under subsection (1) shall not be allowed by the Registrar if before the date of such request, the initial application or the immediate preceding application relating to the initial application has been—

- (a) granted a patent;
- (b) refused;
- (c) deemed to be withdrawn;

(d) withdrawn; or

(e) abandoned.

(1B) Without prejudice to the power of Registrar to allow for divisional application, the prescribed period referred to in subsection (1) shall not be extended under section 82.”; and

(c) in subsection (2), by substituting for the words “priority date” the words “filing date and to any right of priority under section 27, if the right of priority is claimed,”.

#### **New section 26c**

**14.** The principal Act is amended by inserting after section 26B the following section:

#### **“Deposit of micro-organism**

**26c.** (1) If an invention involves a micro-organism 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, a sample of such micro-organism shall be deposited by the applicant or any other person with a National Depositary Authority or an International Depositary Authority not later than the filing date of the patent application.

(2) The deposit of micro-organism with the National Depositary Authority referred to in subsection (1) shall be made in the prescribed manner.

(3) The deposit of micro-organism with the International Depositary Authority referred to in subsection (1) shall be made in accordance with the Budapest Treaty.

(4) The deposit of micro-organism with the National Depositary Authority or the International Depositary Authority, as the case may be, shall be recognized as fulfilling the requirement of disclosure in a patent application.

(5) Any person may make a request for a sample of the micro-organism deposited under subsection (1) in the prescribed manner together with the payment of the prescribed fee and subject to the conditions as prescribed.

(6) For the purposes of this section, “Budapest Treaty” means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, done at Budapest on 28 April 1977.”.

### **Amendment of section 27**

**15.** Section 27 of the principal Act is amended—

(a) in subsection (1)—

(i) by substituting for the words “the priority” the words “the right of priority”; and

(ii) by inserting after the word “filed” the words “in respect of the same invention for which the application is made”; and

(b) by inserting after subsection (1A) the following subsection:

“(1B) Where the applicant fails to claim the right of priority during the period of twelve months referred to in subsection (1), the right of priority may be restored if—

(a) a request for restoration of right of priority is made by the applicant to the Registrar in the form as determined by the Registrar together with the payment of the prescribed fee; and

(b) such request under paragraph (a) fulfils the conditions as prescribed.”.

### **Amendment of section 28**

**16.** Section 28 of the principal Act is amended—

(a) in paragraph (1)(c), by inserting after the words “a description” the words “including a sequence listing, if any”;



(b) by inserting after subsection (1) the following subsection:

“(1A) For the purposes of paragraph (1)(d), where the application comprises more than ten claims, each subsequent claim shall be subject to the payment of the prescribed fee.”;

(c) by substituting for subsection (2) the following subsection:

“(2) Where the Registrar finds that the application made by the applicant does not fulfil the requirement under paragraph (1)(a), (b), (c) or (d), the Registrar shall request the applicant to file the required correction within the prescribed period.”;

(d) by inserting after subsection (2) the following subsection:

“(2A) Where the Registrar finds that the application made by the applicant does not fulfil the requirement under subsection (1A), the Registrar shall request the applicant to make payment of the prescribed fee for each subsequent claim within the prescribed period.”;

(e) by substituting for subsection (3) the following subsection:

“(3) Where—

- (a) the applicant complies with the request of the Registrar to file the required correction under subsection (2), the Registrar shall record as the filing date the date of receipt of the required correction;
- (b) the applicant does not comply with the request of the Registrar to file the required correction under subsection (2), the application shall be treated as abandoned;
- (c) the applicant complies with the request of the Registrar to make payment of the prescribed fee for each subsequent claim under subsection (2A), the Registrar shall record as the filing date the date of receipt of the application under subsection (1); or

- (d) the applicant does not comply with the request of the Registrar to make payment of the prescribed fee for each subsequent claim under subsection (2A), the Registrar shall record as the filing date the date of receipt of the application under subsection (1) for the first ten claims only.”;
- (f) in subsection (4), by inserting after the words “the missing drawings” the words “within the prescribed period”; and
- (g) by inserting after subsection (5) the following subsection:

“(6) The prescribed period referred to in subsections (2), (2A) and (4) shall not be extended by the Registrar under section 82.”.

#### **Amendment of section 29A**

#### **17. Section 29A of the principal Act is amended—**

- (a) in subsection (2), by substituting for the words “the applicant may, instead of requesting for a substantive examination, request for a modified substantive examination” the words “the applicant may, instead of filing a request for a substantive examination, file a request for a modified substantive examination within a prescribed period”;
- (b) in subsection (3), by substituting for the words “prescribed form” the words “form as determined by the Registrar”;
- (c) by deleting subsection (4);
- (d) by substituting for subsection (5) the following subsection:

“(5) If the applicant fails to—

  - (a) file a request for a substantive examination under subsection (1); or
  - (b) file a request for a modified substantive examination under subsection (2),

within the prescribed period, the application for a patent shall be deemed to be withdrawn at the end of that period.”;

(e) by substituting for subsection (6) the following subsections:

“(6) Notwithstanding paragraph (5)(b), the Registrar may, upon the request of the applicant in the form as determined by the Registrar together with the payment of the prescribed fee, allow a deferment of the filing of a request for a modified substantive examination referred to in subsection (2).

(6A) The deferment under subsection (6) may be allowed only on the grounds that the patent or other title of industrial property protection has not been granted or is not available by the expiration of the prescribed period for the filing of a request for modified substantive examination.”; and

(f) in subsection (7), by deleting the words “(1) or”.

### **Amendment of section 30**

**18.** Section 30 of the principal Act is amended by inserting after subsection (3) the following subsection:

“(3A) The amendment of the application made under subsection (3) shall not go beyond the disclosure in the initial application.”.

### **New section 31A**

**19.** The principal Act is amended by inserting after section 31 the following section:

#### **“Certified or non-certified copy of patent application or patent**

**31A.** An owner of a patent or a patent applicant may make a request to the Registrar for a certified or non-certified copy of any form or document concerning his patent application

or patent filed at the Patent Registration Office in the form as determined by the Registrar together with the payment of the prescribed fee.”.

### **Substitution of section 32A**

**20.** The principal Act is amended by substituting for section 32A the following section:

#### **“Notice of trust in Register**

**32A.** (1) A notice of any implied or constructive trust shall neither be accepted by the Registrar nor be entered in the Register.

(2) A notice of an express trust or a beneficiary of an express trust, or both, may be accepted by the Registrar and entered in the Register.

(3) Notwithstanding subsection (2), the Registrar shall not be affected by the notice of an express trust or a beneficiary of an express trust, and failure to enter such notice in the Register does not affect any right or duty under the trust.”.

### **Substitution of section 33**

**21.** The principal Act is amended by substituting for section 33 the following section:

#### **“Examination of Register and copies of or extracts from Register**

**33.** (1) Any person may make a request to the Registrar to examine the Register or to obtain certified or non-certified copies or extracts from the Register, in the form as determined by the Registrar together with the payment of the prescribed fee.

(2) In this section, “person” includes the Federal Government and a State Government.”.

**Amendment of section 33A**

**22.** Section 33A of the principal Act is amended by inserting after subsection (2) the following subsection:

“(3) No person in the employment of the Corporation shall be required to attend any court for the purpose of producing—

- (a) any document relating to a patent application or patent which may be obtained pursuant to the provisions of this Act; or
- (b) any document which is not to be made available to any third party in accordance with this Act.”.

**Amendment of section 33B**

**23.** Section 33B of the principal Act is amended—

- (a) in subsection (1), by inserting after the words “prescribed manner” the words “together with the payment of the prescribed fee”; and
- (b) in paragraphs (1)(a) and (b), by inserting after the words “owner of the patent” the words “or the inventor”.

**Amendment of section 33C**

**24.** Section 33C of the principal Act is amended—

- (a) by substituting for subsection (2) the following subsection:

“(2) For the purposes of the application under subsection (1), the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.”; and

- (b) by deleting subsection (4).

**New section 33D**

**25.** The principal Act is amended by inserting after section 33C the following section:

**“Publication of application**

**33D.** (1) Subject to section 30A, the Registrar shall publish in the Official Journal the prescribed information relating to a patent application to the extent that such information is in the possession of the Registrar—

- (a) after eighteen months from the filing date, or if right of priority is claimed, the priority date of a patent application; or
- (b) at the request of applicant for an early publication before the period specified in paragraph (a) in the form as determined by the Registrar together with the payment of the prescribed fee.

(2) A patent application shall not be published under subsection (1) if—

- (a) the patent application is abandoned, withdrawn, deemed to be withdrawn, or refused on or before the expiry of the period specified in paragraph (1)(a); or
- (b) the Registrar finds that the application contains any information which contravenes public order or morality.

(3) A request for an early publication under paragraph 1(b) shall not be revoked.

(4) This section shall not apply to an international application made under the Patent Cooperation Treaty.”.

**Amendment of section 34**

**26.** Section 34 of the principal Act is amended—

(a) by substituting for subsection (1) the following subsection:

“(1) Where a patent application has been published under section 33D, upon receipt of a payment of the prescribed fee, the Registrar shall make available for

public inspection in the prescribed manner the following information or document relating to a patent application to the extent that such information or document is in the possession of the Registrar—

- (a) the name, address and description of the applicant, and the name and address of his agent, if any;
- (b) the application number;
- (c) the filing date of the application, and if a right of priority is claimed, the priority date, the number of an earlier application, the name of a country in which the earlier application was filed, or where the earlier application is a regional or an international application, the name of the country for which and the office at which it was filed;
- (d) the particulars of the application including the description, claim or claims, drawings, if any, and the abstract and any amendments to the application, if any;
- (e) any change in ownership of the application and any reference to a licence contract relating to the application;
- (f) search and examination reports;
- (g) communications in respect of the patent application from the applicant to the Patent Registration Office as determined by the Registrar; and
- (h) patent and non-patent related literature citations submitted by the applicant or any other person to the Patent Registration Office.”;

(b) by deleting subsection (2);

(c) by substituting for subsection (3) the following subsection:

“(3) Where there is no request made by the applicant under paragraph 33D(1)(b), any person who intends to inspect the information or document relating to a patent application referred to in subsection (1) before the expiry of the eighteen months from the filing date, or if right of priority is claimed, the priority date of a patent application, shall make a request to the Registrar in the form as determined by the Registrar accompanied by—

(a) a written permission of the applicant; and

(b) a payment of the prescribed fee.

(d) in subsection (5), paragraph (6)(b) and subsection (9), by substituting for the words “made available for public inspection” the words “published under section 33D”.

#### **New section 34A**

**27.** The principal Act is amended by inserting after section 34 the following section:

##### **“Third party observation**

**34A.** (1) Any person may, within the prescribed period, make observations in the form as determined by the Registrar together with the payment of the prescribed fee on any matter relating to patentability of a patent application as may be prescribed and shall include the reason for such observations.

(2) In this section, “person” includes the Federal Government and a State Government.”.

#### **Amendment of section 35**

**28.** Subsection 35(2) of the principal Act is amended in the English language text by substituting for the words “a patentee” the words “an owner of a patent”.



**Amendment of section 35A**

**29.** Subsection 35A(1) of the principal Act is amended—

- (a) by substituting for the words “two years” the words “twelve months”; and
- (b) by substituting for the words “the prescribed form” the words “the form as determined by the Registrar together with the payment of the prescribed fee”.

**Amendment of section 36**

**30.** Section 36 of the principal Act is amended—

- (a) in subsection (1)—
  - (i) by substituting for the full stop at the end of paragraph (c) the words “; and”;
  - (ii) by inserting after paragraph (c) the following paragraph:

“(d) to deal with the patent as the subject of a security interest.”; and

(b) by inserting after subsection (4) the following subsection:

“(5) In proving to the contrary in any proceedings referred to in subsection (4), the person other than the owner of the patent or his licensee shall not be required to disclose any manufacturing or commercial secret if the court is satisfied that it is unreasonable or unnecessary to do so, or prejudicial to the manufacturing or commercial secret of that person.”.

**Amendment of section 37**

**31.** Section 37 of the principal Act is amended—

- (a) in subsection (1), by substituting for the words “and in particular not to acts done only for scientific research”

the words “and shall not extend to acts done for experimental or scientific research purposes”;

(b) in subsection (1A)—

(i) by inserting after the words “relevant authority” the words “either in Malaysia or outside Malaysia”; and

(ii) by substituting for the word “drugs” the words “pharmaceutical products”; and

(c) in subsection (3), by substituting for the words “temporarily in Malaysia” the words “which temporarily or accidentally enters Malaysia”.

### **Substitution of heading of Part VIII**

**32.** The principal Act is amended by substituting for the heading of Part VIII the following heading:

“PATENT APPLICATION AND PATENT AS OBJECT  
OF PROPERTY”.

### **Amendment of section 39**

**33.** Section 39 of the principal Act is amended—

(a) in the shoulder note, by substituting for the words “**Assignment and transmission of patent applications and patents**” the words “**Assignment, transmission and security interest transaction**”;

(b) in subsection (1), by inserting after the word “transmitted” the words “in the same way as other personal or moveable property”;

(c) by inserting after subsection (1) the following subsection:

“(1A) A patent may be the subject of a security interest in the same way as other personal or moveable property.”;

(d) by inserting after subsection (2) the following subsections:

“(2A) Any person who is a party to a security interest transaction in respect of a patent may apply to the Registrar in the prescribed manner to have such security interest transaction recorded in the Register.

(2B) Any security interest in respect of a patent may be enforced in the same way as other personal or moveable property.”;

(e) in subsections (3) and (4), by substituting for the words “or transmission” the words “, transmission or security interest transaction”; and

(f) by inserting after subsection (4) the following subsections:

“(5) The Registrar may amend any particulars relating to a security interest transaction in the Register on the application of any person who is a party to the security interest transaction in the prescribed manner together with the payment of the prescribed fee.

(6) The Registrar may remove the recorded security interest transaction from the Register on the application of any person who is a party to the security interest transaction in the prescribed manner.”.

### **Amendment of Part X**

**34.** Part X of the principal Act is amended by substituting for the words “the Corporation” wherever appearing the words “the Registrar”.

### **Amendment of section 48**

**35.** Section 48 of the principal Act is amended—

(a) in the definition of “beneficiary of the compulsory licence”, by deleting the word “and” at the end of that definition;

- (b) in the definition of “compulsory licence”, by substituting for the full stop at the end of that definition the words “; and”; and
- (c) by inserting after the definition of “compulsory licence” the following definition:
  - ‘ “eligible importing country” means—
    - (a) a least developed country which is a member of the World Trade Organization; and
    - (b) any other country which is a member of the World Trade Organization which—
      - (i) notifies the Council for TRIPS of its intention to act as an importer in accordance with Article 31*bis* and the Annex to the TRIPS Agreement; and
      - (ii) proves that it has insufficient or no manufacturing capacities in the pharmaceutical sector in accordance with the Appendix to the Annex to the TRIPS Agreement.’.

### **Amendment of section 49**

**36.** Section 49 of the principal Act is amended—

- (a) in paragraph (1)(b), by deleting the words “are sold at unreasonably high prices or”;
- (b) by inserting after subsection (1) the following subsection:

“(1A) Notwithstanding subsection (1), at any time after the grant of a patent, any person may apply to the Registrar for a compulsory licence—

  - (a) where the products produced in Malaysia under the patent for sale in the domestic market are sold at unreasonably high prices without any legitimate reason; or

(b) for the purposes of production of a pharmaceutical product in Malaysia and export of such pharmaceutical product to an eligible importing country to deal with its public health problem.”; and

(c) in subsection (2), by substituting for the words “A compulsory licence” the words “Except for paragraph (1A)(b), a compulsory licence”.

**Amendment of section 50**

**37.** Section 50 of the principal Act is amended—

(a) in subsection (1), by substituting for the word “royalty” the words “adequate remuneration”;

(b) by inserting after subsection (1) the following subsection:

“(1A) In addition to the requirements specified in subsection (1), an application for a compulsory licence under paragraph 49(1A)(b) shall comply with any other requirements as prescribed.”;

(c) by substituting for subsection (2) the following subsection:

“(2) Where an application for a compulsory licence is made pursuant to section 49 or a request for a compulsory licence is made pursuant to section 49A, the Registrar shall furnish a copy of the application or the request to the licensor or the licensee, as the case may be, for an opportunity to make observations on the application or request within the prescribed period.”; and

(d) by deleting subsection (3).

**Amendment of section 51**

**38.** Section 51 of the principal Act is amended by inserting after subsection (2) the following subsection:

“(3) The Registrar shall notify the Council for TRIPS upon the grant of a compulsory licence under paragraph 49(1A)(b).”.

**Amendment of section 52**

**39.** Section 52 of the principal Act is amended—

(a) in paragraph (b), by deleting the word “and” at the end of that paragraph;

(b) in paragraph (c)—

(i) by substituting for the word “royalty” the words “adequate remuneration”; and

(ii) by substituting for the full stop at the end of that paragraph the words “; and”; and

(c) by inserting after paragraph (c) the following paragraph:

“(d) any other conditions as may be determined by the Registrar.”.

**New section 52A**

**40.** The principal Act is amended by inserting after section 52 the following section:

**“Grant of compulsory licence shall not give rise to breach of contract**

**52A.** (1) The Registrar may grant a compulsory licence to the applicant notwithstanding that a licence contract has been entered into by the licensor and the licensee which provides that the licence is exclusive pursuant to subsection 44(2).

(2) The grant of a compulsory licence by the Registrar under subsection (1) shall not give rise to an action for breach of the licence contract referred to in subsection (1) by the licensee against the licensor.”.

### **Amendment of section 53**

**41.** Section 53 of the principal Act is amended by inserting after subsection (1) the following subsection:

“(1A) The limitation specified in paragraph 53(1)(b) shall not apply to the compulsory licence granted for the purposes of production and exportation of the pharmaceutical product under paragraph 49(1A)(b).”.

### **Amendment of section 54**

**42.** Subsection 54(4) of the principal Act is amended by inserting after the words “the declaration of the surrender” the words “and such declaration shall not be withdrawn”.

### **Amendment of heading of Part XI**

**43.** The heading of Part XI of the principal Act is amended by inserting after the word “SURRENDER” the words “, OPPOSITION”.

### **Amendment of section 55**

**44.** Subsection 55(5) of the principal Act is amended by inserting after the words “the declaration” the words “and such declaration shall not be withdrawn”.

### **New section 55A**

**45.** The principal Act is amended by inserting after section 55 the following section:

#### **“Opposition of patent**

**55A.** (1) Where no proceedings under any provision of this Act is instituted at the Court in relation to a patent,

any interested person may, within the prescribed period from the date of publication of the grant of the patent, commence opposition proceedings by filing a notice of opposition against the owner of the patent in relation to the grant of the patent to the Registrar in the prescribed manner on any of the grounds specified in paragraph 56(2)(a), (b) or (c) together with the payment of the prescribed fee.

(2) If the interested person is not a resident, the security for costs of the opposition proceedings as determined by the Registrar shall be given by the interested person at the time of filing the notice of opposition under subsection (1).

(3) After the filing of notice of opposition under subsection (1), any request or filing of documents made by the interested person or owner of the patent in relation to the opposition proceedings shall be made in the prescribed manner together with the payment of the prescribed fee.

(4) The Registrar may form an *ad hoc* opposition committee to give recommendation to the Registrar in making a decision on the notice of opposition.

(5) At the end of the opposition proceedings, the Registrar shall decide whether to—

(a) maintain the patent;

(b) maintain the patent with any amendment; or

(c) invalidate the patent.

(6) Where the Registrar decides to maintain the grant of a patent under paragraph (5)(a) or (b), no application under section 56 shall be made by the interested person in relation to the patent concerned except by way of counterclaim for invalidation under subsection 60(3) or appeal to the Court under section 88.

(7) Where the Registrar decides to maintain the grant of a patent with amendments under paragraph (5)(b), the amendments shall be deemed to have effect from the date of the grant of the patent.



(8) Any decision of the Registrar under this section or any appeal from such decision of the Registrar under section 88 shall not prevent any party to any infringement proceedings from invalidating the patent on any of the grounds referred to in section 56.

(9) In this section, “interested person” includes the Federal Government and a State Government.”.

### **Amendment of section 56**

**46.** Subsection 56(2) of the principal Act is amended—

- (a) in paragraph (c), by inserting after the semicolon at the end of that paragraph the word “or”;
- (b) in paragraph (d), by substituting for the words “; or” at the end of that paragraph a full stop; and
- (c) by deleting paragraph (e).

### **New section 56A**

**47.** The principal Act is amended by inserting after section 56 the following section:

#### **“Invalidation proceedings after filing notice of opposition**

**56A.** (1) Where the notice of opposition filed by an interested person under section 55A has not been decided by the Registrar, the interested person may not institute any Court proceedings against the owner of the patent for the invalidation of the patent concerned under section 56 unless—

- (a) both parties to the opposition proceedings agree for the invalidation proceedings to be instituted before the Court; or
- (b) the interested person is a defendant in an infringement proceedings.

(2) Before the interested person institutes the invalidation proceedings under section 56 by virtue of paragraph (1)(a) or (b), the interested person shall—

- (a) notify the Registrar of his intention to institute such proceedings; and
- (b) withdraw the notice of opposition filed under section 55A in the prescribed manner.”.

#### **Amendment of section 57**

**48.** Section 57 of the principal Act is amended—

- (a) in subsection (1), by inserting after the words “part of a claim” the words “under section 55A or 56”; and
- (b) by deleting subsection (2).

#### **Amendment of section 59**

**49.** Subsection 59(3) of the principal Act is amended by substituting for the words “five years” the words “six years”.

#### **Amendment of section 75**

**50.** Subsection 75(1) of the principal Act is amended by substituting for the word “Court” wherever appearing the word “court”.

#### **New section 76A**

**51.** The principal Act is amended by inserting after section 76 the following section:

##### **“Compounding of offences**

**76A.** (1) The Minister may, with the approval of the Public Prosecutor, make regulations prescribing—

- (a) any offence under this Act or any regulations made under this Act as an offence which may be compounded; and

(b) the method and procedure for compounding such offence.

(2) The authorized officer may, with the consent in writing of the Public Prosecutor, at any time before a prosecution is instituted, compound any offence which may be compounded by making a written offer to the person reasonably suspected of having committed the offence upon payment to the authorized officer a sum of money not exceeding fifty per centum of the amount of maximum fine to which the person would have been liable to if he had been convicted of the offence, within such time as may be specified in the written offer.

(3) A written offer under subsection (2) may be made at any time after the offence has been committed but before any prosecution for it has been instituted, and where the amount specified in the written offer is not paid within the time specified in the written offer, or such extended time as the authorized officer may grant, prosecution for the offence may be instituted at any time after that against the person to whom the written offer was made.

(4) Where an offence has been compounded under subsection (2), no prosecution shall be instituted in respect of the offence against the person to whom the offer to compound was made, and the authorized officer may forfeit or return any book, account, document or articles seized in connection with the offence, subject to such terms and conditions as the authorized officer thinks fit.

(5) All sums of money received by the authorized officer under this section shall be paid into and form part of the Federal Consolidated Fund.”.

### **Substitution of section 78F**

**52.** The principal Act is amended by substituting for section 78F the following section:

#### **“Person eligible for international application**

**78F.** (1) Any person who is a citizen of Malaysia residing outside Malaysia or a resident shall be entitled

to file an international application for a patent with the Patent Registration Office.

(2) The resident referred to in subsection (1) shall be subject to section 23A.”.

#### **Amendment of section 78G**

**53.** Subsection 78G(1) of the principal Act is amended by substituting for the words “the prescribed form” the words “the form as determined by the Registrar”.

#### **Amendment of section 78N**

**54.** Subsection 78N(1) of the principal Act is amended by substituting for the words “the making available for public inspection under section 34” the words “the publication of an application under section 33D”.

#### **Amendment of section 78o**

**55.** Section 78o of the principal Act is amended by inserting after subsection (1) the following subsection:

“(1A) If the applicant designates Malaysia for the purpose of obtaining a patent under this Act for an international application that involves a micro-organism 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, a sample of such micro-organism shall be deposited by the applicant or any other person with a National Depositary Authority or an International Depositary Authority not later than the filing date of the international application.”.

**Amendment of section 79**

**56.** Section 79 of the principal Act is amended—

(a) by substituting for subsection (1) the following subsection:

“(1) The Registrar may, upon a request made by an applicant for a patent in accordance with any regulations made under this Act, amend the patent application, or any document submitted at the Patent Registration Office in relation to the application, for the purpose of—

(a) correcting a clerical error or an obvious mistake;  
or

(b) changing the name or address of the applicant or inventor.”;

(b) by inserting after subsection (1) the following subsections:

“(1A) The request for an amendment referred to in paragraph (1)(b) shall not be allowed if the Court proceedings in relation to the right to the patent application under section 19 is pending.

(1B) The Registrar may, upon a request made by an applicant in accordance with any regulations made under this Act, amend the description, claim or claims, drawing, or abstract, of the patent application, provided that the amendment shall not go beyond the disclosure in the initial application as filed.”; and

(c) in subsection (2), by substituting for the words “subsection (1)” the words “this section”.

**Amendment of section 79A**

**57.** Section 79A of the principal Act is amended—

(a) by inserting after subsection (1) the following subsections:

“(1A) Where the Registrar finds that the request for amendment of patent under subsection (1) requires

an Examiner to re-examine the patent, the owner of a patent shall file a request for re-examination in the form as determined by the Registrar together with the payment of the prescribed fee within the prescribed period.

(1B) Notwithstanding subsection (1A), the applicant may on his own volition, make a request for re-examination of the patent in the form as determined by the Registrar together with the payment of the prescribed fee.”; and

(b) by substituting for subsection (3) the following subsection:

“(3) The Registrar shall not make an amendment under this section if there are—

(a) pending before a court any proceedings in which the validity of the patent may be put in issue; or

(b) pending before the Registrar any opposition proceedings under section 55A.”.

### **Amendment of section 80**

**58.** Section 80 of the principal Act is amended—

(a) in paragraph (1)(d), by substituting for the words “amend costs” the words “award costs, including assessment of the costs and the manner in which the costs is to be paid”;

(b) by inserting after subsection (1) the following subsection:

“(1A) A party to any proceedings before the Registrar who is desirous to obtain costs shall make an application to the Registrar in the prescribed manner.”;

(c) in subsection (2), by substituting for the words “paragraphs 1(a), (b) and (c)” the words “paragraphs 1(a) and (b)”;

(d) by inserting after subsection (2) the following subsection:

“(2A) If any person fails to comply with any order or direction made by the Registrar under paragraph 1(c) without any lawful excuse, his application under this Act shall be treated as abandoned.”; and

(e) by inserting after subsection (3) the following subsection:

“(4) Nothing in this Act shall prevent the disclosure of information by the Registrar to the National Competent Authority or relevant Competent Authority established under the Access to Biological Resources and Benefit Sharing Act 2017 [Act 795] for the purposes of the Patent Registration Office acting as a checkpoint under that Act concerning an application for a patent prior to the publication of a patent application referred to in section 33D.”.

#### **Amendment of section 81**

**59.** Section 81 of the principal Act is amended—

(a) by renumbering the existing provision as subsection (1); and

(b) by inserting after subsection (1) as renumbered the following subsection:

“(2) An opportunity of being heard referred to in subsection (1) shall be carried out in the prescribed manner upon payment of the prescribed fee.”.

#### **Amendment of section 82**

**60.** Section 82 of the principal Act is amended—

(a) by renumbering the existing provision as subsection (1);

(b) in subsection (1) as renumbered—

(i) by inserting after the words “Subject to” the words “subsection 17B(4A), subsection 26B(1B),”;

(ii) by inserting after the words “subsection 27(1A),” the words “subsection 28(6),”; and

(iii) by substituting for the words “the Court” the words “any court”; and

(c) by inserting after subsection (1) as renumbered the following subsection:

“(2) The request for extension of time after the expiration of a prescribed period under this Act or any regulations made under this Act shall be made within the period as prescribed.”.

### **Amendment of section 83**

**61.** Subsection 83(1) of the principal Act is amended by substituting for the words “a Court” the words “any court”.

### **Amendment of section 84**

**62.** Section 84 of the principal Act is amended—

(a) by inserting after subsection (5) the following subsection:

“(5A) Where the exploitation of a patented invention involves an importation of a pharmaceutical product into Malaysia for the purposes of paragraph (1)(a)—

(a) the Council for TRIPS shall be notified; and

(b) no remuneration shall be payable to the owner of the patent in Malaysia under subsection (3) if adequate remuneration is paid to the owner of the patent in the exporting country.”; and

(b) in subsection (8), by substituting for the words “The exploitation of the invention” the words “The exploitation of the patented invention”.



**Amendment of section 86**

**63.** Section 86 of the principal Act is amended—

(a) by inserting after subsection (3) the following subsection:

“(3A) The Registrar may cancel the registration of a patent agent on the grounds as may be prescribed.”;

(b) by substituting for subsection (4) the following subsection:

“(4) The appointment or change of a patent agent—

(a) shall be made in the form as determined by the Registrar together with the payment of the prescribed fee; and

(b) shall not be effective against any third person unless the appointment or change is registered in the Register of Patents Agents.”; and

(c) in subsection (5)—

(i) by substituting for the words “has neither his domicile nor residence in Malaysia” the words “is not a resident”; and

(ii) by deleting the words “in respect of his patent”.

**New section 86A**

**64.** The principal Act is amended by inserting after section 86 the following section:

**“Intellectual Property Official Journal**

**86A.** (1) The Registrar shall publish an Intellectual Property Official Journal which shall contain—

(a) all matters relating to patent application and patent which are required to be published under this Act or any regulations made under this Act; and

- (b) such other information or matters relating to patent application and patent as the Registrar deems necessary.
- (2) The Registrar shall make available the Official Journal to any person upon receipt of the payment of the prescribed fee.
- (3) Publication in the Official Journal shall constitute sufficient notice of any matter required to be published under this Act or any regulations made under this Act.
- (4) A copy of the Official Journal shall on its production in any legal proceedings be admitted as evidence without further proof being given that the copy was so published.
- (5) A copy of the Official Journal shall be *prima facie* evidence of the facts stated therein.
- (6) Where the Official Journal is published in more than one form, the date of publication of the Official Journal shall be deemed to be the date the Official Journal is first published in any form.”.

### **Amendment of section 87**

**65.** Subsection 87(2) of the principal Act is amended—

- (a) in paragraph (f), by deleting the words “forms,”; and
- (b) by inserting after paragraph (f) the following paragraphs:
  - “(fa) to prescribe the National Depository Authority and to regulate all matters relating to the National Depository Authority;
  - (fb) to regulate the filing or issuance of documents by electronic means;
  - (fc) to regulate all matters relating to patent agents;”.

**New section 87A**

**66.** The principal Act is amended by inserting after section 87 the following section:

**“Directive or practice notice by Registrar**

**87A.** (1) The Registrar may issue a directive or practice notice to any person in relation to any provision of this Act or any regulations made under this Act as the Registrar thinks necessary.

(2) The directive or practice notice issued by the Registrar under subsection (1) shall be published in the Official Journal and shall come into force on the date specified in such directive or practice notice.

(3) Any person who is specified in the directive or practice notice shall comply with the directive or practice notice.

(4) The Registrar may amend the whole or any part of the directive or practice notice issued under this section.

(5) Subsections (2) and (3) shall apply in respect of any amendment of the directive or practice notice made under subsection (4).

(6) Any application or patent under the Act shall be treated as abandoned, withdrawn, deemed to be withdrawn, invalidated or lapsed, as the case may be, if any directive or practice notice issued by the Registrar is not complied with by the person specified in such directive or practice notice.”.

**Amendment of section 88**

**67.** Section 88 of the principle Act is amended—

(a) in subsection (1), by deleting the words “or the Corporation”;  
and

(b) by substituting for subsection (2) the following subsection:

“(2) The procedures of appeal under subsection (1) shall be made in accordance with the rules of court in civil matters.”.

**New sections 88A, 88B, 88C, 88D and 88E**

**68.** The principal Act is amended by inserting after section 88 the following sections:

**“Costs of proceedings before court**

**88A.** In all proceedings before the court, the court may, in its discretion, award any party including the Registrar such costs as it may consider reasonable but the Registrar shall not be ordered to pay the costs of any of the parties.

**Protection against suit and legal proceedings**

**88B.** No action, suit, prosecution or other proceedings shall lie or be brought, instituted or maintained in any court against—

- (a) the Registrar, Deputy Registrar, Assistant Registrar or an Examiner in respect of any act ordered or done for the purpose of carrying into effect this Act; and
- (b) any other officer in respect of any act done or purported to be done by him under the order, direction or instruction of the Registrar,

if the act was ordered or done in good faith and in a reasonable belief that it was necessary for the purpose intended to be served by it.

**Service of application, order or judgment on Registrar**

**88c.** (1) A copy of every application to the Court relating to a patent application or patent in the proceedings including an appeal from such application shall be served on the Registrar by the parties to the application in the prescribed manner together with the payment of the prescribed fee.

(2) Upon receipt of a copy of the application including an appeal under subsection (1), the Registrar may change the status of the patent application or patent as the Registrar

deems fit, subject to further conditions, directions, order or judgement of the court.

(3) Any order or judgement made by the court upon the completion of the application including appeal under subsection (1) shall be served on the Registrar in the prescribed manner together with the payment of the prescribed fee by the party in whose favour the order or judgement is made or given.

(4) Upon receipt of the order or judgment under subsection (3), the Registrar shall—

- (a) record the court order or judgment in the Register; and
- (b) cause the order or judgment to be published in the Official Journal if the Registrar considers necessary.

### **Registrar not to be made party to certain proceedings**

**88D.** In the absence of a cause of action against the Registrar, the Registrar shall not be made a party to the following proceedings:

- (a) judicial assignment proceedings under section 19;
- (b) an appeal against the decision of the Registrar in granting compulsory licence under section 51;
- (c) an appeal against the decision of the Registrar in opposition proceedings under section 55A;
- (d) invalidation proceedings under section 56;
- (e) infringement proceedings under section 59; or
- (f) an appeal against the decision of the Minister under section 84.

### **Power to amend Schedule**

**88E.** The Minister may, by order published in the *Gazette*, amend the Schedule to this Act.”.

**Saving and transitional provisions**

**69.** (1) Any application or request made under the principal Act relating to a patent application or an application for a certificate for a utility innovation which is pending before the date of the coming into operation of this Act shall, on the date of the coming into operation of this Act, be dealt with in accordance with the provisions of the principal Act as if the principal Act had not been amended by this Act.

(2) Any application or request made under the principal Act relating to a patent or a certificate for a utility innovation which is pending before the date of coming into operation of this Act shall, on the date of the coming into operation of this Act, be dealt with in accordance with the provisions of the principal Act as if the principal Act had not been amended by this Act.

(3) Any action relating to a patent application or an application for a certificate for a utility innovation taken or commenced under the principal Act which is pending before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, be continued in accordance with the provisions of the principal Act as if the principal Act had not been amended by this Act.

(4) Any action relating to a patent or a certificate for a utility innovation taken or commenced under the principal Act which is pending before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, be continued in accordance with the provisions of the principal Act as if the principal Act had not been amended by this Act.

(5) Any approval, decision, directions, notice or report made or issued under the principal Act before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, continue in full force and effect as if the principal Act had not been amended by this Act.

(6) Any investigation, trial or proceedings commenced under the principal Act which is pending before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, be continued in accordance with the provisions of the principal Act as if the principal Act had not been amended by this Act.

(7) Notwithstanding subsections (1), (2), (3), (4), (5) and (6)—

- (a) paragraph 14(2)(b) of the principal Act as amended in section 5 of this Act shall, on the date of coming into operation of this Act, apply to a patent application published under the new section 33D as introduced in section 25 of this Act;
- (b) subsection 17B(4) of the principal Act as amended and the new subsection 17B(4A) as introduced in section 6 of this Act shall, on the date of coming into operation of this Act, apply to an application for a patent or application for a certificate for a utility innovation filed under the principal Act which is pending before the date of the coming into operation of this Act if the report made by the Examiner in accordance with subsection 30(1) or (2) of the principal Act is issued on or after the date of coming into operation of this Act;
- (c) section 19 of the principal Act as amended in section 8 of this Act and subsection 59(3) of the principal Act as amended in section 49 of this Act shall apply to a patent application or patent, as the case may be, if the period of five years specified in both section 19 and subsection 59(3) of the principal Act in relation to the patent application or patent has not expired on the date of coming into operation of this Act;
- (d) new subsection 26B(1B) as introduced in section 13 of this Act shall, on the date of coming into operation of this Act, apply to an application for a patent or application for a certificate for a utility innovation filed under the principal Act which is pending before the date of the coming into operation of this Act if, on or after the date of coming into operation of this Act—
  - (i) an objection is raised in an Examiner's report made under subsection 30(1) or (2) of the principal Act for non-compliance with section 26 of the principal Act; or
  - (ii) an Examiner's first report made under subsection 30(1) or (2) of the principal Act is issued by the Registrar;

- (e) subsection 29A(6) of the principal Act as amended in section 17 of this Act shall, on the date of coming into operation of this Act, apply to an application for a patent or application for a certificate for a utility innovation filed under the principal Act before the coming into operation of this Act, if any request for the deferment is made on or after the date of coming into operation of this Act for the filing of a request for a substantive examination or modified substantive examination;
- (f) new paragraph 33D(1)(a) as introduced in section 25 of this Act shall, on the date of coming into operation of this Act, apply to an application for a patent or application for a certificate for a utility innovation filed under the principal Act before the date of coming into operation of this Act if, on or after the date of coming into operation of this Act, the period of eighteen months from the filing date or priority date, if right of priority is claimed for that application, expires;
- (g) new paragraph 33D(1)(b) as introduced in section 25 of this Act shall, on the date of coming into operation of this Act, apply to an application for a patent or application for a certificate for a utility innovation filed under the principal Act before the coming into operation of this Act if, on the date of coming into operation of this Act, the period of eighteen months from the filing date or priority date, if right of priority is claimed for that application, has not expired;
- (h) subsection 34(3) of the principal Act as amended in section 26 of this Act shall, on the date of coming into operation of this Act, apply to an application for a patent or application for a certificate for a utility innovation filed under the principal Act before the date of coming into operation of this Act if the request for inspection under subsection 34(3) is made on or after the date of coming into operation of this Act;
- (i) new section 34A as introduced in section 27 of this Act shall, on the date of coming into operation of this Act, apply to an application for a patent or an application



for certificate for a utility innovation filed under the principal Act before the date of coming into operation of this Act and published under section 33D as introduced in section 25 of this Act;

- (j) subsection 35A(1) of the principal Act as amended in section 29 of this Act shall, on the date of coming into operation of this Act, apply to a patent or certificate for a utility innovation granted before the date of coming into operation of this Act if a notice of the lapsing of the patent or certificate for a utility innovation is published in the Official Journal on or after the date of coming into operation of this Act;
- (k) new paragraph 36(1)(d) as introduced in section 30 of this Act shall, on the date of coming into operation of this Act, apply to any patent or certificate for a utility innovation which is still in force;
- (l) new sections 55A and 56A as introduced in sections 45 and 47 of this Act respectively shall apply to a patent or certificate for a utility innovation granted on the date of coming into operation of sections 45 and 47 of this Act;
- (m) new subsection 79A(1A) as introduced in section 57 of this Act shall, on the date of coming into operation of this Act, apply to any request to amend a patent or certificate for a utility innovation filed before the date of coming into operation of this Act which is pending before the Registrar on the date of coming into operation of this Act;
- (n) new subsection 82(2) as introduced in section 60 of this Act shall, on the date of coming into operation of this Act, apply to any act or thing which is to be done under the principal Act and the prescribed period for such act or thing to be done has expired before the date of coming into operation of this Act;

- (o) new section 88A as introduced in section 68 of this Act shall, on the date of coming into operation of this Act, apply to all proceedings before the court which is pending on the date of coming into operation of this Act; and
  - (p) any matter which is required to be published in the *Gazette* under the provisions of the principal Act and still pending publication before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, be published in the Official Journal and such matter shall be deemed to have been published in the *Gazette* under the principal Act.
- (8) Subsections 37(1) and (3) of the principal Act as amended in paragraphs 31(a) and (c) of this Act shall, on the date of coming into operation of this Act, apply to any patent or certificate for a utility innovation which is still in force on the date of coming into operation of this Act;
- (9) Subsection 37(1A) of the principal Act as amended in paragraph 31(b) of this Act shall, on the date of coming into operation of paragraph 31(b) of this Act, apply to any patent or certificate for a utility innovation which is still in force on the date of coming into operation of paragraph 31(b) of this Act;
- (10) On the date of coming into operation of this Act, subsection 39(4) of the principal Act as amended in section 33 of this Act shall not affect any security interest transaction that have been entered into before the date of coming into operation of this Act.
- (11) Any matter published in the *Gazette* in accordance with the provisions of the principal Act before the date of coming into operation of paragraph 2(a) of this Act—
- (a) shall be deemed to have been published in the Official Journal and the new section 86A as introduced in section 64 of this Act shall apply accordingly without prejudice to any other written law; and
  - (b) shall continue to remain in full force and effect until otherwise published in the Official Journal.

EXPLANATORY STATEMENT

This Bill seeks to amend the Patents Act 1983 (“Act 291”).

2. *Clause 1* contains the short title and the provision on the power of the Minister to appoint the date of commencement of the proposed Act including the power to appoint different dates for the coming into operation of different provisions of the proposed Act.

3. *Clause 2* seeks to provide for certain general amendments to Act 291.

Paragraph 2(a) seeks to substitute the publication in the *Gazette* with the publication in the Intellectual Property Official Journal as constituting sufficient notice of any matter relating to patent application and patent required to be published under Act 291 or any regulations thereof.

Paragraph 2(b) seeks to substitute for the words “prescribed time” wherever appearing in Act 291 the words “prescribed period”.

4. *Clause 3* seeks to amend section 3 of Act 291 to provide for the definitions of “Council for TRIPS”, “International Depositary Authority”, “micro-organism”, “Official Journal”, “pharmaceutical product”, “resident” and “TRIPS Agreement”.

5. *Clause 4* seeks to amend paragraph 13(1)(b) of Act 291 to clarify that the products of micro-biological processes are patentable inventions.

6. *Clause 5* seeks to amend paragraph 14(2)(b) of Act 291 to clarify that the contents of a domestic patent application that have an earlier priority date than a patent application are prior art if such contents are included in the domestic patent application published under section 33D of Act 291.

7. *Clause 6* seeks to amend subsection 17B(4) of Act 291 to provide that a request for conversion from an application for patent into an application for a certificate for a utility innovation, and vice versa, shall be filed with the Registrar within the prescribed period. This *clause* also seeks to introduce a new subsection 17B(4A) into Act 291 to clarify that the prescribed period for a request for conversion shall not be extended under section 82 of Act 291.

8. *Clause 7* seeks to amend subsection 18(2) of Act 291 to clarify that the rights of an inventor to a patent shall be subject to the provisions of Act 291.

9. *Clauses 8 and 49* seek to amend section 19 and subsection 59(3) of Act 291 respectively to provide that the limitation period for commencing an application for the judicial assignment of a patent application or patent under section 19 of Act 291 and court proceedings for infringement of a patent under subsection 59(3) of Act 291 is six years.

10. *Clause 9* seeks to amend section 21 of Act 291 to clarify that the Federal or State Governments have the right to patent their inventions under Act 291.

11. *Clause 10* seeks to amend section 23A of Act 291 by introducing a new subsection (2) which requires a resident who wishes to make a patent application outside of Malaysia for an invention to obtain a written authority from the Registrar in the prescribed manner together with the payment of the prescribed fee.

12. *Clauses 11, 17, 29 and 53* seek to amend section 25, subsections 29A(3), 35A(1) and 78G(1) of Act 291 respectively to empower the Registrar to determine the form to be used for filing any declaration, application or request in relation to withdrawal of patent applications, substantive examination or modified substantive examination, reinstatement of lapsed patent and international application.

13. *Clause 12* seeks to delete section 26A of Act 291 as a consequential amendment to the amendment of section 79 of Act 291.

14. *Clause 13* seeks to amend section 26B of Act 291.

Paragraph 13(a) seeks to amend subsection 26B(1) of Act 291 to provide that a request to the Registrar for a divisional application to divide a patent application shall be made in the form as determined by the Registrar together with the payment of prescribed fee.

Paragraph 13(b) seeks to introduce new subsections (1A) and (1B) into section 26B of Act 291. With this amendment, a divisional application shall not be allowed if before the date of such request the initial patent application or the immediate preceding application relating to the initial application has been granted a patent, refused, deemed to be withdrawn, withdrawn or abandoned, and the prescribed period for making the request cannot be extended.

Paragraph 13(c) seeks to amend subsection 26B(2) of Act 291 to provide that a divisional application shall be entitled to the filing date and any right of priority claimed under section 27 of Act 291 of the initial application.

15. *Clause 14* seeks to introduce a new section 26C into Act 291. The proposed new section 26C of Act 291 seeks to provide for a procedure to deposit micro-organism which is not available to the public and cannot be described in the patent application with a National Depositary Authority or an International Depositary Authority as a part of the patent disclosure procedure in compliance with the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

16. *Clause 15* seeks to amend section 27 of Act 291.

Paragraph 15(a) seeks to amend subsection 27(1) Act 291 to provide that a patent applicant may, through a declaration in the patent application, claim the right of priority of an earlier national, regional or international patent application filed in relation to the same invention during the period of twelve months immediately preceding the filing date of the patent application containing the declaration pursuant to any international treaty or convention.

Paragraph 15(b) seeks to introduce a new subsection (1B) into section 27 of Act 291 to allow a patent applicant to make a request to the Registrar for the restoration of right of priority.

17. *Clause 16* seeks to amend section 28 of Act 291 to clarify on additional requirements to be complied with by a patent applicant, including the requirement to pay additional fees for a patent application that contains more than ten claims, to obtain a filing date in relation to a patent application filed under Act 291.

18. *Clause 17* seeks to amend section 29A of Act 291.

Paragraph 17(c) seeks to remove the requirements imposed on a patent applicant at the time of filing a request for substantive examination to provide to the Registrar certain information or supporting documents concerning the filing of any application for a patent or other title of industrial property protection filed outside Malaysia by such applicant or his predecessor in title under subsection 29A(4) of Act 291.

Paragraph 17(e) seeks to amend subsection 29A(6) of Act 291 to provide that a patent applicant may make a request for a deferment of the filing of a modified substantive examination only on the ground that the patent or a title of industrial property protection is not available by the expiration of the prescribed period. By virtue of this amendment, a patent applicant can no longer make a request for a deferment of the filing of a substantive examination.

19. *Clause 18* seeks to amend section 30 of Act 291 to introduce a new subsection (3A) into section 30 of Act 291. The proposed subsection (3A) seeks to provide that an amendment made to a patent application under section 30 of Act 291 shall not go beyond the disclosure in the initial application.

20. *Clause 19* seeks to introduce a new section 31A into Act 291 to provide that an owner of a patent or a patent applicant may make a request to the Registrar to obtain a certified or non-certified copy of any form or document concerning his patent application or patent filed at the Patent Registration Office.

21. *Clause 20* seeks to amend section 32A of Act 291 to allow a notice of an express trust or a beneficiary of an express trust to be accepted by the Registrar and entered in the Register.

22. *Clause 21* seeks to amend section 33 of Act 291 to clarify that any person including the Federal Government and a State Government may make a request to the Registrar to examine the Register and obtain certified or non-certified copies or extracts from the Register.

23. *Clause 22* seeks to introduce a new subsection (3) into section 33A of Act 291 to clarify that no person in the employment of the Corporation shall be required to attend court for the purpose of producing documents relating to a patent application or patent which may be obtained pursuant to the provisions of Act 291 or documents which are not to be made available to any third party in accordance with Act 291.

24. *Clause 23* seeks to amend section 33B of Act 291 to provide that an owner of a patent may make a request to the Registrar to amend the name or address of an inventor of the patent in addition to the existing provision which enables an owner of a patent to amend the name or address of himself.

25. *Clause 24* seeks to amend section 33C of Act 291 consequential to the introduction of a new section 88c into Act 291.

26. *Clause 25* seeks to introduce a new section 33D into Act 291 on the publication of a patent application by the Registrar in the Intellectual Property Official Journal and to allow a request by a patent applicant for an early publication. The proposed provision also seeks to clarify that the new section 33D of Act 291 shall not apply to an international application made under the Patent Cooperation Treaty.

27. *Clause 26* seeks to amend section 34 of Act 291 to provide for the public inspection of a patent application after the publication of the patent application under the new section 33D of Act 291. No person shall be allowed to inspect a patent application before the publication of a patent application under section 33D without the written permission of the applicant of the patent and the approval of the Registrar.

28. *Clause 27* seeks to introduce a new section 34A into Act 291 to provide that any person is allowed to make observations in writing to the Registrar on the patentability of a patent application within a prescribed period.

29. *Clause 29* seeks to amend subsection 35A(1) of Act 291 to provide that an application for reinstatement of a lapsed patent may be made within the period of twelve months from the date the notice of lapsing of a patent is published in the Intellectual Property Official Journal.

30. *Clause 30* seeks to amend section 36 of Act 291.

Subparagraph 30(a)(ii) seeks to introduce a new paragraph (1)(d) into section 36 of Act 291 to allow a patent to be dealt with as a security interest.

Paragraph 30(b) seeks to introduce a new subsection (5) into section 36 of Act 291 to provide that any person other than the owner of the patent or his licensee shall not be required to disclose any manufacturing or commercial secret in discharging the burden of proof imposed upon him to prove that a product was not obtained by the patented process if the court is satisfied that it is unreasonable or unnecessary to do so, or prejudicial to the manufacturing or commercial secret of that person.

31. *Clause 31* seeks to amend section 37 of Act 291 to clarify matters relating to limitation of rights under the patent.

32. *Clause 32* seeks to amend the heading of Part VIII of Act 291 by substituting for the existing heading the new heading of "PATENT APPLICATION AND PATENT AS OBJECTS OF PROPERTY".

33. *Clause 33* seeks to amend section 39 of Act 291 to provide that a patent is recognized in the same way as other personal or moveable property that may be the subject of security interest and to allow security interest transactions to be recorded in the Register.

34. *Clause 34* seeks to amend Part X of Act 291 to empower the Registrar to grant compulsory licence under this Part.

35. *Clauses 35, 36, 37, 38, 39 and 41* seek to amend sections 48, 49, 50, 51, 52 and 53 of Act 291, respectively, to comply with the obligation under Article 31*bis* of the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”) to allow the grant of a compulsory licence for the production of pharmaceutical product in Malaysia and exportation of that pharmaceutical product to an eligible importing country to address its public health problem.

36. *Clause 40* seeks to introduce a new section 52A into Act 291 to provide that the Registrar may grant a compulsory licence notwithstanding an exclusive licence contract has been entered into between the licensor and a licensee. The new provision also seeks to provide for protection of the licensor from any action for breach of contract by the licensee resulting from the granting of the compulsory licence by the Registrar.

37. *Clauses 42 and 44* seek to amend subsections 54(4) and 55(5) of Act 291 to clarify that when a declaration for the surrender of the grant of compulsory licence or patent has been submitted to the Registrar, such declaration of surrender shall not be withdrawn.

38. *Clause 43* seeks to amend the heading of Part XI of Act 291 by substituting for the existing heading the new heading of “SURRENDER, OPPOSITION AND INVALIDATION OF PATENT”.

39. *Clauses 45* seeks to introduce a new section 55A into Act 291 to provide for an opposition proceedings against the owner of a patent in relation to the grant of the patent before the Registrar.

40. *Clause 47* seeks to introduce a new section 56A into Act 291 to clarify matters relating to the institution of invalidation proceedings in Court under section 56 of Act 291 in a situation when opposition proceedings before the Registrar under section 55A of Act 291 is pending.

41. *Clause 48* seeks to amend section 57 of Act 291 to clarify the effects of invalidation of a patent under the new sections 55A and 56 of Act 291.

42. *Clause 49* seeks to amend subsection 59(3) of Act 291 to provide that the infringement proceedings may not be instituted after six years from the act of infringement.

43. *Clause 51* seeks to introduce a new section 76A into Act 291 to provide for the compounding of offences.

44. *Clause 52* seeks to amend section 78F of Act 291 to provide that any person who is a citizen of Malaysia residing outside Malaysia or a resident shall be eligible to file an international application with the Patent Registration Office.

45. *Clause 54* seeks to amend subsection 78N(1) of Act 291 to clarify that the publication of an international application made by the International Bureau designating Malaysia as a designated office has the same effect as the publication of a patent application under the new section 33D of Act 291 if the international publication is transmitted to and received by the Patent Registration Office.

46. *Clause 55* seeks to introduce a new subsection 78O(1A) into Act 291. The proposed new section 78O(1A) of Act 291 seeks to provide for a procedure to deposit micro-organism which is not available to the public and cannot be described in the patent application with a National Depositary Authority or an International Depositary Authority as a part of the patent disclosure procedure in compliance with the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure. This procedure applies to an international patent application which designates Malaysia for the purpose of obtaining a patent under Act 291.

47. *Clause 56* seeks to amend section 79 of Act 291.

Paragraph 56(a) seeks to amend subsection 79(1) of Act 291 to provide that an applicant of a patent may make a request to the Registrar to amend the patent application or any document submitted at the Patent Registration Office in relation to the name or address of the applicant or inventor of the patent. This is in addition to the existing provision which enables the applicant of a patent to amend the patent application or any document submitted at the Patent Registration Office for the purpose of correcting a clerical error or an obvious mistake.

Paragraph 56(b) seeks to introduce new subsections (1A) and (1B) into section 79 of Act 291 to provide for restrictions to the power of the Registrar to amend a patent application.

48. *Clause 57* seeks to amend section 79A of Act 291 to provide for the request by the owner of a patent for a re-examination of a patent after the patent is granted.

49. *Clause 58* seeks to amend section 80 of Act 291.

Paragraphs 58(a) and (b) seeks to clarify on matters relating to the procedure to obtain costs and the power of the Registrar to award costs under Act 291.

Paragraphs 58(c) and (d) seek to clarify on the effect of non-compliance by an applicant with any order or direction of the Registrar to produce any document or article.

50. *Clause 59* seeks to introduce a new subsection (2) into section 81 of Act 291 to clarify on matters relating to hearing conducted before the Registrar.



51. *Clause 60* seeks to amend section 82 of Act 291 to clarify on matters relating to extension of time under Act 291.

52. *Clause 62* seeks to amend section 84 of Act 291 to comply with the obligation under Article 31*bis* of the TRIPS Agreement in relation to the importation of patented pharmaceutical products by the Government agency or any third person designated by the Minister to deal with the public health problem.

53. *Clause 63* seeks to amend section 86 of Act 291 to clarify on matters relating to cancellation, appointment or change of a patent agent.

54. *Clause 64* seeks to introduce a new section 86A into Act 291 to provide for the publication of an Intellectual Property Official Journal. The Intellectual Property Official Journal will substitute the *Gazette* for the publication of all matters relating to patent applications and patents under Act 291. The proposed section also provides that a copy of the Intellectual Property Official Journal shall on its production in any legal proceedings be admitted as evidence without further proof being given that the copy was so published and a copy of the journal shall be *prima facie* evidence of the facts stated therein.

55. *Clause 65* seeks to amend subsection 87(2) of Act 291 to empower the Minister to prescribe the National Depository Authority and to make regulations on matters relating to the National Depository Authority, the filing or issuance of documents by electronic means and patent agents.

56. *Clause 66* seeks to introduce a new section 87A into Act 291 to empower the Registrar to issue directives or practice notices to any person in relation to any provision of Act 291 or regulations made under Act 291.

57. *Clause 67* seeks to amend section 88 of Act 291 to remove the provision relating to an appeal by an aggrieved person from a decision of the Corporation and an appeal from a decision of the Registrar to the High Court shall no longer be treated as an appeal from the subordinate court to the High Court.

58. *Clause 68* seeks to introduce new sections 88A, 88B, 88C, 88D and 88E into Act 291.

The new section 88A of Act 291 seeks to empower the court to award cost to any party in the proceedings before the court and the Registrar shall not be ordered to pay the costs of any of the parties.

The new section 88B of Act 291 seeks to protect the Registrar, Deputy Registrars, Assistant Registrars, Examiners and any other officer of the Corporation against any action, suit, prosecution or other proceedings for acts ordered or done in good faith in carrying into effect of Act 291.

The new section 88C of Act 291 seeks to provide that a copy of every application to the Court including an appeal relating to any patent application or patent shall be served on the Registrar by the parties to the application. Furthermore, the new section also requires a party in whose favour the order or judgement is made or given to serve the order or judgement on the Registrar.

The new section 88D of Act 291 seeks to clarify that the Registrar shall not be made a party to certain legal proceedings where there is no cause of action against the Registrar.

The new section 88E of Act 291 seeks to empower the Minister to amend the schedule to Act 291.

59. *Clause 69* contains saving and transitional provisions.

60. Other amendments not specifically dealt with in this Explanatory Statement are minor or consequential in nature.

*FINANCIAL IMPLICATIONS*

This Bill will not involve the Government in any extra financial expenditure.

[PN(U2)2868]