

MALAYSIA

New Directions from the Malaysian Patent Office

The Malaysian Intellectual Property Office (MyIPO) has recently issued three new practice directions. These practice directions are intended to clarify MyIPO's practice in relation to (1) the filing of amendments to patent applications after a clear report has been issued, (2) the filing of divisional applications after a clear report has been issued, and (3) the filing date of an application where inadequate fees had been paid.

MyIPO will issue a clear report after an examination of the application if the application has satisfied all the formal and legal requirements for a patent to be granted.

Amendments

Applications. Under Section 26A of the Malaysian Patents Act 1983, the applicant may amend its application at any stage of application process provided that the proposed amendment does not go beyond the disclosure in the initial application.

MyIPO will generally issue a clear report if the claims are in conformity with the claims in a corresponding patent granted by any one of the six prescribed jurisdictions, i.e., the United States, European Union, the United Kingdom, Australia, Japan, Korea or China (prescribed patent offices) and proceed to issue the patent shortly thereafter.

With the new practice direction, the applicant will be given two months after the issuance of a clear report to file any amendments. If the applicant does not wish to file any amendments, it should inform MyIPO accordingly so that MyIPO can then issue the patent without waiting for the two months to lapse.

Granted patents. A patentee may apply to amend a granted patent provided that the proposed amendment does not have the effect of disclosing a matter not found in the initial application or extending the protection conferred at the time of the grant of the patent.

However, under Section 79A(3) of the act, the Registrar of Patents has no power to make any amendment if there are proceedings pending before any court where the validity of the patent

may put in issue.

Therefore, a patentee should review its patent carefully and make any necessary amendments prior to filing any infringement proceedings or making any assertions of patent infringement lest a potential infringer/licensee respond with an application to invalidate the patent in court.

The highest court in Malaysia, the Federal Court, in the recent case of *SKB Shutters Manufacturing Sdn Bhd v. Seng Kong Shutter Industries Sdn Bhd & Anor* [2015] 9 CLJ 405, has taken a very strict interpretation of Section 79A(3): if an independent claim is found to be invalid, then all other claims which are dependent on it will consequentially be invalid as the patentee will not be able to amend these dependent claims into independent claims.

While amendments to Section 79A to overcome this drastic effect of a strict interpretation are being pondered, a patentee may be able to rely on a different section of the act, Section 56(3), which allows the court to invalidate part of a claim and the partial invalidity be declared in the form of a limitation on the claim in order to save the dependent claims.

Divisional Applications

With the new practice direction, it is now clear that the applicant will have three months from the issuance of a clear report to divide an application. The effect is that MyIPO should not issue a patent grant for at least three months after the issuance of a clear report.

It important to bear in mind that the filing of a divisional application must be accompanied by a request for examination if the deadline to request for examination for the parent application has passed. If a modified examination had been requested for the parent application, a modified examination must also be requested for the divisional application. A problem which frequent arises is that is no corresponding granted patent for the divisional application from any one of the prescribed patent offices.

Hence, it may be less risky for an applicant to opt for full examination instead of expedited examination if it is anticipated that it may be necessary to divide the application at a later stage. Further, there is little cost savings by requesting for expedited examination. Even if an applicant had requested for



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full examination, it may still voluntarily conform its application to any of the corresponding patents granted in any of the prescribed patent offices to expedite the examination process.

Excess Claims

MyIPO will record as the filing date the date of its receipt of the application together with the prescribed filing fee. There is an additional fee of RM20 (US\$2.58) for each claim exceeding 10 in an application. If it is later discovered that the filing fees paid are not sufficient for the actual number of claims filed, the application will be accorded a new filing date when the payment for the unpaid excess claims is made under the new practice direction. In order to retain the original filing date, an applicant may have to delete the less significant claims, re-word or combine claims to reduce the number of claims to that as originally filed.

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