



Mr Wong Sai Fong



Ms Michelle Loi

Malaysia resists international influence

Litigation in Malaysia must reflect local laws and not simply rely on foreign corresponding cases, as Mr Wong Sai Fong and Ms Michelle Loi demonstrate.

There is now much international flavour being injected into patent invalidation proceedings in Malaysia. In days gone by, the validity of a Malaysian granted patent was determined strictly on the *Malaysian Patents Act 1983* and *Patents Regulations 1986*¹ and upon an interpretation of the provisions of them.

Now, litigants proceed as a matter of course, and on the misconceived assumption, that the impact of invalidation or opposition proceedings mounted against the corresponding patent of the Malaysian Patent in other jurisdictions and the decisions reached on them must necessarily apply to or play a part in influencing the determination of the outcome of proceedings in Malaysia. Some even take the view that the scope of protection of the Malaysian Patent should be equal to the best, or that which is most advantageous in terms of the breadth in the scope of protection, of these foreign corresponding patents. Hence, they take the view they are entitled to amend their patent post grant if that object had not been achieved by the granted Malaysian Patent.

It is not uncommon for litigants to rely on grounds for invalidation pled in these foreign proceedings under the laws of foreign jurisdictions. Sometimes, these are not specified grounds under the Malaysian Patents Act and Regulations. Often, there is adduced into evidence those which were relied upon in the foreign invalidation and opposition proceedings including any affidavit evidence exchanged. There is no appreciation of the fact that in any invalidation proceedings in Malaysia, the issue of validity is a matter for trial. This includes an evaluation of the documentary materials cited in support and the oral testimony of witnesses who are skilled in the field of the invention after their evidence is tested by cross-examination and re-examination, unlike opposition or invalidation proceedings in some jurisdictions where the issue of validity is decided on affidavit evidence and, on occasions, assisted by court-appointed technical assessors without the opportunity to cross-examine and re-examine the deponents of supporting and opposing affidavits.

Sample cases

Illustrative of this tendency are two recent cases discussed below. One is a pharmaceutical and the other a medical device patent. Both these Malaysian granted patents have corresponding applications or granted patents in other jurisdictions. The patentability or validity of these foreign

Résumés

Mr Wong Sai Fong

Mr Wong has represented many multi-nationals in litigation and intellectual property enforcement matters. He also frequently appears as Senior Counsel in the High Court, Court of Appeal and Federal Court on behalf of solicitors, and is often asked by intellectual property protection and enforcement coalitions to propose amendments to existing intellectual property laws or new laws to provide for better efficiency in the enforcement of intellectual property rights, and sits as a member on ad hoc government committees set up to review existing intellectual property laws or to propose amendments to existing laws.

His non-litigation work includes advising on information technology, e-commerce telecommunications, franchising, entertainment, media, sponsorship and merchandising matters and related agreements. He has been involved in unfair trade practice cases, the mediation or settlement of intellectual property related disputes, and representation of clients in dispute resolution matters.

Ms Michelle Loi

Michelle's area of practice is primarily contentious in nature. She has acted in court proceedings involving patent, trademark, copyright and design infringement, breaches of confidential information, and passing off. Her IP litigation experience transcends across a broad range of industries that include medical devices, food, movie, fashion, glove manufacture, oil palm, ink jet cartridges, digital transmission system, and pharmaceutical patents. She also represents clients in the Malaysian Intellectual Property Offices' opposition procedures as well as trade mark prosecution proceedings, and advises on domain name disputes. With respect to non-contentious areas, Michelle advises on Personal Data Protection Act, Food Act and Regulations, gaming regulations, franchising, as well as the IP and IT aspects of commercial transactions which include licensing and technology transfers, software and computer agreements.

corresponding applications and patents are being objected to or are challenged.

In the case of *Pfizer Ireland Pharmaceuticals v Ranbaxy (Malaysia) Sdn Bhd*² Ranbaxy sought amongst others to invalidate Pfizer's Malaysian Patent MY-111446-A. It relied on, as a ground, Pfizer's corresponding European Patent EP 070255 B2 having been revoked by the Board of Appeals of the European Patent Office (EPO). To make good its defence to the invalidation attack, Pfizer sought to amend its granted Malaysian Patent MY-111446-A to have it conform to its corresponding US Patent 6,469,012, the validity of which was upheld by the US Court. In wanting to rely on the grounds advanced and evidence adduced in the invalidation proceedings related to the invalidated European Patent and to resist the invalidation of the Malaysia Patent, both parties paid no regard to the Malaysian Patents Act and Regulations, evidential or procedural laws.

Pfizer made an application for post grant amendment to its Malaysian Patent to effect the desired conformance despite an express prohibition by Section 79A (3) of the Patents Act 1983³ that prohibits the Registrar of Patents from considering any amendments if the validity of the patent sought to be amended post grant is already in issue in any court proceedings. It is quite explicit that an application to amend a patent post grant must be made to the Registrar in the first instance. Pfizer, however, proceeded by way of an interlocutory summons application to the High Court. Not unexpectedly, the High Court refused Pfizer's application. Pfizer's appeal was likewise dismissed.

Another inclination is to plead and adduce indiscriminately into evidence, the file wrapper history of the application prosecution and opposition proceedings and the pleadings and transcripts of court proceedings on foreign corresponding patents without there being adhered to, the spirit and intent of the time-honoured obligation to plead sufficiently the Particulars of Objections to support the case of invalidation put forth so that issues for trial could be identified and narrowed, and in response in the defence that are relevant to the grounds for invalidation specified in the Patents Act and Regulations. This, if not done, unnecessarily protracts the discovery process. It occasions a greater number of case management sessions. Unavoidably, there will be interlocutory applications for further and better particulars or applications seeking to administer interrogatories. It adds to the costs of proceedings and wastage of judicial time and resources.

Whilst it is permissible to adopt the arguments and evidence of foreign proceedings on corresponding patents, such of them as are adopted must be relevant and applicable to the grounds for invalidation specified in the Patents Act and Regulations. Those that are supportive of grounds for invalidation under the laws of foreign jurisdictions with no equivalents or persuasive force under the Patents Act and Regulations should not be relied upon in the hope and expectation that the judge will be persuaded and influenced into arriving at a similar finding whether for the plaintiff or defendant.

An attempt to rely on the outcome of foreign proceedings relating to a corresponding patent without defining the relevance, scope and purpose for such reliance is seen in the decision of the Court of Appeal in the case of *Med 8 Sdn Bhd & 4 Ors v B. Braun Melsungen AG* [unreported]⁴. Braun sued Med 8 for infringement of its Malaysian Patents MY-141712-A and MY-143155-A. The invention of these patents relates to the safety needle feature within an intravenous safety catheter (IVC). Not unexpectedly, Med 8 resisted the infringement claims and counter-claimed for invalidation of both patents, citing in their defence and counter-claim, the various foreign proceedings and decisions in Germany, India, Australia and Japan that involved foreign patents that correspond to the Malaysian Patents at issue.

Med 8 relied as well at trial, on the arguments and documentary materials adduced in these foreign jurisdiction proceedings.

The thrust of Med 8's case at the appellate court was that since these corresponding foreign patents have been invalidated in their respective jurisdictions, the consequence must be that the Malaysian Patents would have to likewise be invalidated. Upon the Appellate Court being appraised of the differences between invalidation proceedings in the Malaysian Court and foreign opposition and invalidation proceedings, both at the Registry and court level in each of these jurisdictions, and the differences in the manner of adduction and evaluation of evidence between them, Med 8's submissions were not accepted and its appeal dismissed with costs. As an illustration, one of the major differences that came to light between invalidation proceedings before the Malaysian High Court and the opposition proceedings at the EPO was that in the EPO opposition proceedings, no oral evidence or testimony from any "expert" ordinarily skilled in the art of the field of the invention was required. In invalidation proceedings in Malaysia, the ordinarily skilled witness is called upon to take the witness stand to give oral evidence and is subject to cross-examination on their evidence in chief and re-examined on their answers given in cross-examination. EPO opposition proceedings were not court proceedings but opposition proceedings before the European Patent Office. Med 8 was unable to show whether the EPO proceedings applied the same standard of evidential proof as would be applied by the Malaysian High Court or whether such law, both substantive and procedurally applied and legislation considered in the EPO proceedings, would be have been equally applicable or persuasive to the Malaysian Court conducting the trial of the matter.

Med 8 faced the same difficulty in its attempt to rely on the proceedings and evidence used in the other cited jurisdictions. Perhaps it is well worth nothing that the High Court, at the trial stage, had disallowed admission of all affidavit evidence and related decisions and findings on corresponding patents in any of these foreign jurisdictions without there being pleaded and particularized what the relevant facts are that will justify and support such "imported" evidence and decisions of foreign proceedings and without there being shown the relevance of such evidence. The Malaysia trial court was also not prepared to admit such evidence without the deponents of affidavits used in the foreign proceedings being subject to cross-examination and re-examination on their affidavit evidence. The Court of Appeal, when faced with a similar attempt by Med 8 to adduce such foreign evidence and findings afresh at the appellate stage, equally dismissed such an attempt.

The Malaysian courts will no doubt adopt a cautious approach and will not readily accept there being adduced into evidence extraneous grounds not found in the Patents Act and Regulations or evidence adduced in support of such extraneous grounds in invalidation proceedings that are related to foreign corresponding patents.

¹ Section 11 of the Patents Act 1983 provides that "an invention is patentable if it is new, involves an inventive step and is industrially applicable." Thus, an invention is to be adjudged from these three requisites.

² [2013] 3 CLJ 61

³ Section 79A(3) provides that the Registrar shall not make an amendment under [section 79] if there are pending before any court proceedings in which the validity of the patent may be put in issue.

⁴ *Med 8 Sdn Bhd & 4 Ors v. B. Braun Melsungen AG & Anor* [Civ. Appeal No. W-03(IPCV)-2717-11-Year 2012. The case was heard on 8 April 2013 and the panel of the appellate judges unanimously dismissed *Med 8 Sdn Bhd & 4Ors'* appeal.