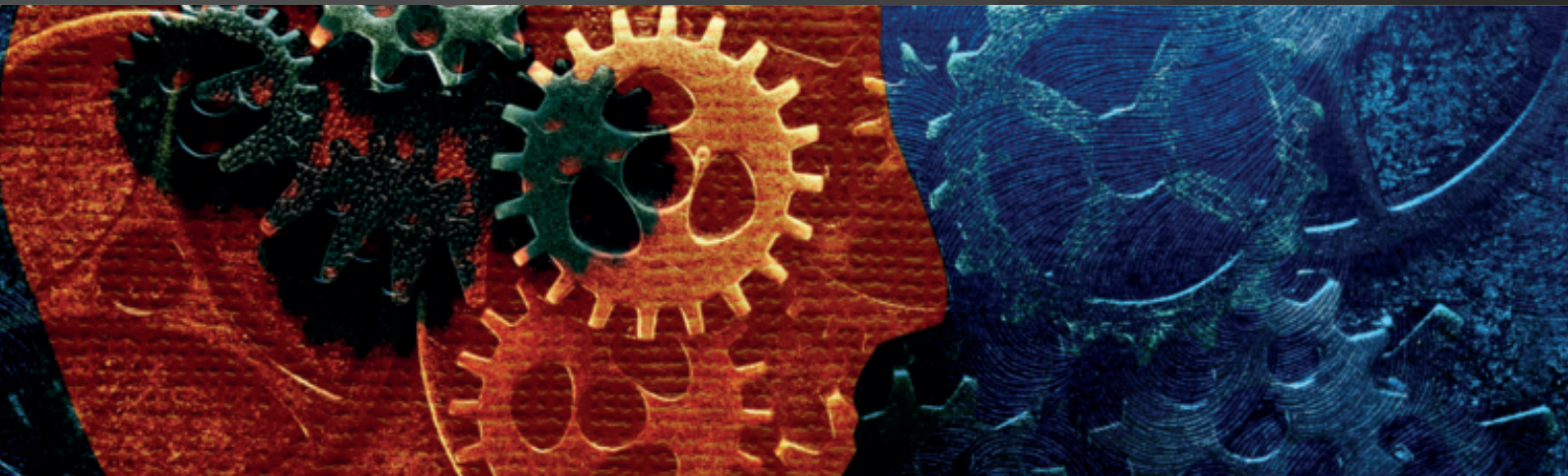


International Comparative Legal Guides



Patents 2020

A practical cross-border insight into patent law

10th Edition

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1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

Patent infringement lawsuits in Malaysia are heard before a High Court judge in a specialised Intellectual Property (IP) Court. Under the Courts of Judicature Act 1964, the High Court has jurisdiction to try all civil proceedings, *inter alia*, where the cause of action arose, or where the defendant resides or has its place of business, or where the infringing acts are alleged to have taken place.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

In 2016, under Practice Direction No. 4, the Chief Justice of Malaysia issued a directive stating that High Court Judges and Deputy Registrars may, at pre-trial case management stage, issue directions for the parties involved to facilitate the settlement of the matter before the court by way of mediation. The said Practice Direction proposed the following methods of mediation:

- (a) by Judge-led mediation;
- (b) by the then Kuala Lumpur Regional Centre for Arbitration (now Asian International Arbitration Centre); or
- (c) by other mediators agreed by both parties.

1.3 Who is permitted to represent parties to a patent dispute in court?

As infringement proceedings take place before a judge in the High Court, the parties have to be represented by practising Advocates and Solicitors who are members of the Malaysian Bar.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

To commence proceedings, the claimant will have to file with the Court a Writ of Summons, together with the prescribed fees. This Writ will then have to be served on the defendant. Generally, it may take about two years from the date of filing for the matter to go to full trial.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

Yes, under an order for discovery, the Court may at any time, in a matter initiated by a Writ, order a party to disclose documents to the other party. The party seeking disclosure of the documents will have to apply for the court order. If the Court finds that an issue in the matter should be first determined before an order for discovery is made, it may order for said issue to be determined before giving any directions on discovery.

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

- 1) The claimant files a Writ of Summons together with a Statement of Claim (or indorsement of the Writ), pays the prescribed fee, and serves the indorsed Writ on the defendant.
- 2) The defendant has to enter appearance within 14 days of service of the Writ.
- 3) The defendant then has to file his/her defence and/or counter-claim within 14 days of entering appearance.
- 4) The claimant then has 14 days in which he/she may file a reply to the defendant's defence, and/or file a defence to the counter-claim.
- 5) Pleadings are deemed closed 14 days after (3) or 14 days after (4) above.

Subsequently, during pre-trial case management stage, the Court will issue directions on, *inter alia*, documents and witness statements to be filed and exchanged by the parties. Technical documents, such as patent-related documents, and evidence from expert witnesses in the form of sworn affidavits should also be filed and exchanged during this stage.

1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

During the trial, the plaintiff argues his/her case first by calling and examining his/her witnesses. This step, known as examination-in-chief, is for the plaintiff to present his/her evidence. Examination-in-chief is carried out using witness statements. The defendant is given the opportunity to cross-examine the plaintiff's evidence, followed by a possible re-examination of the witness by the plaintiff again. Once the plaintiff has called all his/her witnesses and examined them, the plaintiff then concludes his/her case. The defendant then has the choice of calling his/her own witnesses. The

examination-in-chief, cross-examination and re-examination are then repeated. Once the defendant has examined-in-chief and re-examined his/her witnesses, he/she will then bring the defence arguments to a close. This concludes the trial in the Court.

The plaintiff and defendant will then have to submit, depending on the Court's directions, written submissions and submissions-in-reply. Once the submissions are handed in, the Court will announce a date for issuing its judgment.

Pleadings may be amended once before close of pleadings, without the leave of the Court. Any subsequent amendments, or any amendments after the close of pleadings will require the Court's permission.

1.8 How long does the trial generally last and how long is it before a judgment is made available?

A trial usually lasts three to 21 days depending on the complexity of the subject matter, and a judgment is usually available two to five months after the end of the trial.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

As of 2018, there are no procedures available that provide a shorter, more flexible or more streamlined process in infringement proceedings.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

Judgments are made available to the public, and may be accessed through legal reports/journals.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

The Malaysian Courts adhere to the principle of *stare decisis*. The High Court is bound by decisions made by the superior Courts, i.e. the Court of Appeal and the Federal Court. Decisions of foreign jurisdictions may be used as persuasive authorities.

1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?

There are judges that have undergone the relevant training in order to preside over IP cases. To the best of our knowledge, although the judges may have had experience in dealing with previous IP cases including patent cases, they do not have the technical or scientific expertise/background in addition to legal expertise. Generally, besides relying on their experience in presiding over previous IP cases, they will also rely on the evidence and examination of expert witnesses put forth by the parties.

1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

- i) The owner of the patent shall have the right to institute Court proceedings against any person who has performed or is performing an act that infringes the patent. A contract licensee or a beneficiary of a compulsory licence may, if he/she proves that he/she has requested the owner of the patent to initiate proceedings but said owner has failed to do so within three months of the request, institute proceedings against the infringer.
- ii) Any aggrieved person may institute Court proceedings to invalidate a patent.
- iii) Any interested person may institute declaratory proceedings against the owner of the patent, asking the Court to declare that the performance of a specific act does not constitute an infringement of the patent. If such an act is already the subject of infringement proceedings, then the defendant in the infringement proceedings may not institute declaratory proceedings.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

- (i) A Court can declare a particular act to be non-infringing.
- (ii) The Malaysian Patents Act 1983 does not provide for declarations to claim coverage over a technical standard or a hypothetical activity.

1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

There are no provisions in the Malaysian Patents Act 1983 that make mention of secondary (or contributory) infringement. Any infringing product would have to fall within the scope of the claims of the patent. However, under section 59(2) of the Act, the owner of a patent may file "imminent" infringement proceedings against any person who has performed acts which make it likely that an infringement will occur.

1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

Yes, the party can be liable for infringement by using a product obtained directly from a patented process, even if said process was carried on outside the jurisdiction.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

The Malaysian courts apply the purposive construction approach when analysing construction of claims in both (a) invalidation, and (b) infringement proceedings. The Courts are likely to apply the three-stage test known as the *Improver* questions, established in the *Improver v Remington* case:

- (i) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim, if no –
- (ii) Would this (i.e., that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art? If no, the variant is outside the claim, if yes –

- (iii) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, the variant is outside the claim.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

In a case where it is the plaintiff (patent owner) who first commences patent infringement proceedings, the defendant may in its defence and counterclaim assert that the patent is invalid and seek a declaration that the patent is invalid. In a case where a plaintiff commences invalidation proceedings against a patent owner to invalidate the patent, the patent owner (defendant) may in its counterclaim assert that the plaintiff is infringing his patent.

There is also the possibility that a patent owner may commence patent infringement proceedings at about the same time that the alleged infringer commences invalidation proceedings to invalidate the patent. In such a situation, the Court may order the matters to be consolidated.

If there are both infringement and validity issues, regardless of whether they are present in the same suit or in different suits, the Court has the discretion to deal with both issues together or may opt to deal with the invalidity issue first. However, it is more common for issues of validity to be heard first before the infringement issue is heard as validity plays a key role in determining the outcome of the infringement claim. Nevertheless, even if the Court were to hold that the patent is invalid, very often it will still proceed to consider whether there would be infringement if the patent had been held valid.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the “Formstein defence”)?

There are no known cases in which the so-called “Formstein defence” has been reportedly used. In Malaysia, the Courts apply the principle of purposive construction of the claims. There has been no indication to date that the Courts are persuaded or are inclined to follow the doctrine of equivalents established in *Actavis v Eli Lilly*, the UK Supreme Court case.

1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

Other grounds include:

- What is claimed as an invention in the patent is not an invention per section 12 Patents Act 1983.
- The invention is one of the non-patentable inventions under section 13 Patents Act 1983.
- The performance of any act in respect of the claimed invention is contrary to public order or morality, as per section 31(1) Patents Act 1983.
- The invention is not industrially applicable.
- The description or claims of the patent do not comply with the Patents Regulations 1986.
- Omission of drawings necessary to understand the claimed invention.

- The right of the patent does not belong to the person to whom the patent was granted.
- The person to whom the patent was granted, or the person’s agent, deliberately provided or caused to be provided incomplete or incorrect information to the Registrar of Patents.

1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

Proceedings involving infringement or invalidation can only be stayed by the Court. The Court has the discretion to make an order for a single Court to hear separate infringement and invalidation proceedings involving the same invention. The Court may also, at its discretion, stay infringement proceedings in order to first make a determination of the validity of the patent in issue.

1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?

The following examples are possible grounds of defence in non-infringement or invalidity proceedings:

- (i) Committing an infringing act after a patent has been gazetted as “lapsed” and before the said patent has been reinstated in the *Gazette*.
- (ii) Committing infringing acts solely for scientific research.
- (iii) Acts done to make, use, offer to sell or sell a patented invention solely for uses reasonably related to the development and submission of information to the relevant authority which regulates the manufacture, use or sale of drugs.
- (iv) An infringing act in respect of products which have been put on the market by the owner of the patent, by a party who derives the rights from prior manufacture or use of the patented invention, by a licensee, or by a beneficiary of a compulsory licence.
- (v) Using a patented invention on any foreign vessel aircraft, spacecraft or land vehicle temporarily in Malaysia.
- (vi) Acts done to exploit the invention after its patent term has expired.
- (vii) A person who in good faith in Malaysia makes the product or uses the process, which was the subject of the patent application at the priority date of the patent application. Also, a person who in good faith in Malaysia made serious preparations to make the said product or use the said process.
- (viii) Committing any infringing acts as a beneficiary of a compulsory licence.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available?

- (a) Preliminary injunctions are available both (i) on an *ex parte* basis, and (ii) on an *inter partes* basis. A party applying for a preliminary injunction must provide to the court (1) full and frank disclosure, and (2) undertaking as to damages. Preliminary injunctions are granted based on the guidelines established in the *American Cyanamid* case:
 - (i) there must be a serious triable issue;
 - (ii) inadequacy of damages as remedy;
 - (iii) balance of convenience favours the granting of an injunction; and
 - (iv) maintaining the *status quo* between parties.

The plaintiff may have to provide to the Court a bond or a similar financial instrument as undertaking in the event the Court subsequently finds that the preliminary injunction was wrongly granted. An applicant outside of the jurisdiction may also be required to furnish security of costs. To date, the use of preventive Writs (protective letters) is not applicable in Malaysian Courts.

- (b) Final injunctions are available as a remedy at the conclusion of the trial.

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive damages available?

Damages are usually assessed after the trial stage of infringement/invalidity proceedings. The court may direct parties to perform disclosure and will require the submission of affidavit evidence by the parties. There are generally two forms of monetary remedies arising from infringement/invalidation proceedings. Damages are classified into three broad categories, namely loss of business profit, loss of opportunity, and loss of reputation/goodwill. The court places the burden on the winning party to provide evidence of the aforementioned losses. Account of profits is not awarded as a right of the winning party, and is assessed by considering the profits derived by the use of the invention rather than profits derived from sale of the infringing product.

Punitive damages are available, though rarely awarded as the court prefers to award compensatory damages. If punitive/exemplary damages are sought, they have to be specifically pleaded for at the pleadings stage.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

In proceedings involving patent infringement/invalidation, only civil remedies are available to the winning party. In the event one party does not obey a Court order, the other party may apply for an order of committal against the offending party for failure to comply with the order. The Court may then order the offending party to be fined or jailed for contempt of Court.

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

Other forms of relief could include delivery-up and/or destruction of the infringing products and/or instruments/machines used to manufacture the infringing product. The plaintiff may also require the defendant to publish an apology in the local media and/or inform the purchasers directly of the infringing product. Cross-border relief is unlikely to be granted as patent rights are territorial in nature.

1.27 How common is settlement of infringement proceedings prior to trial?

The Court generally favours mediation/negotiation to litigation. Please refer to question 1.2 above.

1.28 After what period is a claim for patent infringement time-barred?

Patent infringement proceedings may not be instituted after five years following the act of infringement.

1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

The losing party has the right to appeal to the Court of Appeal against the High Court decision based on a point of fact or point of law, or both. However, in order to subsequently file an appeal to the Federal Court, the losing party will require leave to appeal to the Federal Court, on the basis of point of law or public interest.

1.30 What are the typical costs of proceedings to first instance judgment on (i) infringement, and (ii) validity? How much of such costs are recoverable from the losing party?

The typical costs of proceedings in an infringement or invalidation case are very much dependent on factors such as the complexity of the subject matter, the number of independent claims within the disputed patent, the number of witnesses and expert witnesses, length of trial, number of counsels and their level of experience, among others. Generally, a High Court trial can cost from approximately USD50,000 to USD150,000, inclusive of pre-trial costs.

1.31 For jurisdictions within the European Union: What steps are being taken in your jurisdiction towards ratifying the Agreement on a Unified Patent Court, implementing the Unitary Patent Regulation (EU Regulation No. 1257/2012) and preparing for the unitary patent package? Will your country host a local division of the UPC, or participate in a regional division? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

As of January 2019, Malaysia does not have any formal or informal mutual recognition of judgments arrangements with other countries. However, under the Reciprocal Enforcement of Judgments Act 1958 (“REJA 1958”), the High Court can enforce foreign judgments from countries and territories listed under the First Schedule of REJA 1958, namely the UK, Hong Kong, Singapore, Sri Lanka, India (excluding certain states/territories), New Zealand and Brunei, subject to the fulfilment of conditions set out by the Act. The foreign judgment must have been a final and conclusive judgment issued by a superior Court in the foreign country listed in the First Schedule, under such judgment there must be a payable sum of money where such a sum is not due to taxes/charges and/or is not due to a fine/penalty.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant, and if so, how?

Yes, the patent owner may apply *ex parte* to the Registrar to amend a granted patent. In accordance with Patents Act 1983, the Registrar may amend the description, claims, or drawings of the granted patent, or any other document associated with the patent, for the purpose of correcting a clerical error or an obvious mistake, or for

any other reason acceptable to the Registrar. The owner of the patent has to submit to the Registrar a request to amend the patent, and such request must be accompanied by the prescribed fee.

2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

Section 79A of the Patents Act 1983 prohibits the amendment of a patent if there are pending court proceedings in which the validity of the said patent may be put in issue.

2.3 Are there any constraints upon the amendments that may be made?

Any amendments cannot have the effect of disclosing a matter which extends beyond what was disclosed before the amendment. The amendments also cannot have the effect of extending the protection conferred at the time the patent was granted.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

Where the Patents Act 1983 is concerned, any terms or conditions within a patent licence contract that impose restrictions not derived from the rights conferred on the owner of the patent or unnecessary for safeguarding such rights are deemed invalid. However, certain restrictions concerning, *inter alia*, the scope, extent or duration of the exploitation of the patented invention, and obligations imposed on the licensee to refrain from acts capable of negatively/adversely affecting the validity of the patent, are not considered to be invalid restrictions. The terms within a patent licence contract must also adhere to any prevailing legislations, including the Contracts Act 1950 and the Competition Act 2010.

3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

Yes, though the issuance of a compulsory licence is not common. Any person may apply to the Registrar for a compulsory licence, after three years from the grant of a patent or four years from the filing date of the patent application, based on the following circumstances: there has been no production/application of the patented product/process in Malaysia without any legitimate reason; there is no product produced in Malaysia under the patent for sale in any domestic market; or there are products produced in Malaysia under the patent but which are sold at unreasonably high prices or do not meet public demand without any legitimate reasons. A person may also apply for a compulsory licence based on an interdependence on an existing patent that is still valid in Malaysia.

The terms are proposed by the applicant, and the application for a compulsory licence is made to the Registrar using the prescribed form and fee. The Registrar will examine the proposed terms and application and, once satisfied that requirements have been met, will send a copy to the owner/beneficiary of the patent. The Board will then consider the application and give its decision.

4 Patent Term Extension

4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

A term of a patent cannot be extended.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable, and if not, what types are excluded?

The following types of subject matter are excluded from patentability:

- (i) discoveries, scientific theories, and mathematical methods;
- (ii) plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living microorganisms, microbiological processes and the products of such microorganisms;
- (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games; and
- (iv) methods for the treatment of the human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

The Patents Act 1983 does not expressly place a duty on the applicant to disclose prejudicial prior art. However, under rule 20 of the Patents Regulations 1986, the applicant is required to state in the request for grant of a patent or at any other time any disclosure which the applicant is aware of and which, in his opinion, should be disregarded for prior art purposes under section 14(3) of the Patents Act 1983.

5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

No, there are no opposition proceedings in Malaysia.

5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

Any person aggrieved by a decision or order of the Registrar or Malaysian Intellectual Property Office may appeal to the High Court. If the appeal is dismissed at the High Court, the person may then appeal to the Court of Appeal. Subsequently, the person may appeal at the Federal Court subject to getting leave to appeal at the Apex Court.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

Disputes over rights to priority and ownership of the invention are usually resolved via civil proceedings at the High Court. However, the parties are encouraged to settle the disputes through alternative dispute resolution methods before embarking on litigation at the Courts.

5.6 Is there a “grace period” in your jurisdiction, and if so, how long is it?

Any prior disclosure of the invention before the filing date can be disregarded if such disclosure occurred within 12 months prior to the patent application date, and if such disclosure was a result of, *inter alia*:

- (i) acts committed by the applicant or predecessor in title; or
- (ii) abuse of the rights of the applicant or predecessor in title.

5.7 What is the term of a patent?

A patent is valid for 20 years from the filing date of the application. If a patent application was filed before 1 August 2001 and was pending on that date, the patent granted on that application is valid for 20 years from the date of filing, or 15 years from the date of grant, whichever is the longer. For a patent granted before 1 August 2001 and still in force on that date, the duration of its validity is 20 years from the date of filing, or 15 years from the date of grant, whichever is longer.

5.8 Is double patenting allowed?

Double patenting is not allowed.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

To date, there is no mechanism for seizing or preventing the importation of infringing products.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

The Competition Act 2010 does not contain any provisions that prevent relief for patent infringement being granted.

7.2 What limitations are put on patent licensing due to antitrust law?

The Competition Act 2010 does not place any limitations on patent licensing. However, as a safeguard against possible abuses, the Patents Act 1983 provides for compulsory licences, and prohibits invalid clauses within licence contracts. Further, under section 84 of the Patents Act 1983, where an authority has determined that the manner in which a patent owner or a licensee has exploited said patent is anti-competitive, the Government may permit a government agency or designated third party to exploit a patented invention even without the agreement of the patent owner.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

Based on the Courts’ preference to dispose of litigious disputes, the Courts are likely to schedule technical trials together with infringement/invalidation proceedings. As of January 2019, there have been no reported patent cases in Malaysia involving FRAND. Further, there are no provisions within the Patents Act 1983 and Patents Regulations 1986 that expressly provide for FRAND licences.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

The written judgment in the Federal Court case of *Spind Malaysia Sdn Bhd v Justrade Marketing Sdn Bhd & Anor* [2018] 4 CLJ was published, where the Court held, *inter alia*, that the inventive concept of a patent must necessarily be identified by reference to its claims, not from the patent specification as a whole. The Court also reaffirmed its decision in the earlier Federal Court case of *SKB Shutter Manufacturing Sdn Bhd v. Seng Kong Shutter Industries Sdn Bhd & Anor* [2015] 9 CLJ 405, that it is the claims that must be considered when determining novelty and the inventive step. The starting point for the assessment of novelty and inventiveness is to construe the scope of the claims. The Court held that a purposive approach is to be adopted to give effect to what the person skilled in the art (POSITA) would have understood the patentee to be claiming. The Court also went on to elaborate on the *Windsurfing* test, stating that the test should generally be applied for the purpose of considering whether an alleged invention is inventive.

The Court of Appeal also published its written judgment in *Merck Sharp & Dohme Corp & Anor v Hovid Bhd* [2019] 3 CLJ 339, where, *inter alia*, the Court held that once an independent claim is found by the Court to be invalid, all other dependent claims that follow from said independent claim are held invalid as well. The consequence of the finding on this point will have a significant impact on how claims are drafted for patents in Malaysia, especially in light of section 79A(3) of the Patents Act 1983, which prohibits any amendments to a patent if the validity of said patent is the subject of Court proceedings. It should be noted that leave to appeal this point of law to the Federal Court has been granted to the appellant.

8.2 Are there any significant developments expected in the next year?

The Malaysian Government has yet to ratify the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP), which it is a signatory to, and which came into force on 30 December 2018. Among the sectors that are included in the CPTPP is Intellectual Property. Should the Government proceed with ratifying the Agreement, there may be proposals to introduce new provisions or amend existing provisions in the Patents Act 1983, especially regarding new agricultural chemical products and certain pharmaceutical products. However, as of April 2019, there have been no official announcements on this matter.

8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

With regard to contentious matters in which preliminary injunctions are sought by the plaintiff, the IP Court is generally more inclined to schedule an early trial date for proceedings. Also, under *Practice Direction No. 4 of 2016*, the IP Court is likely to direct both parties, during the pre-trial case management stage, to facilitate the settlement of the dispute before the Court through mediation or through other alternative dispute resolution methods.



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of our clients' brands in the marketplace. Our lawyers have a good rapport with relevant government agencies, working closely with them on enforcement matters.

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