

Act A648
Patents (Amendment) Act 1986

Long Title & Preamble

An Act to amend the Patents Act 1983.

BE IT ENACTED by the Duli Yang Maha Mulia Seri Paduka Baginda Yang di-Pertuan Agong with the advice and consent of the Dewan Negara and Dewan Rakyat in Parliament assembled, and by the authority of the same, as follows:

Section 1. Short title and commencement.

This Act may be cited as the **Patents (Amendment) Act 1986** and shall come into force on such date as the Minister may appoint by notification in the *Gazette*

Section 2. Amendment of section 3.

Section 3 of the Patents Act 1983 (Act 291), which in this Act is referred to as "the principal Act", is amended by inserting the words "and the Register for Certificates for Utility Innovations" after the word "Patents" in the definition of "Register".

Section 3. Amendment of section 4.

Section 4 of the principal Act is amended -

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

"(1) There shall be established a Patents Board which shall be a body corporate with perpetual succession and a common seal and which may sue and be sued and whose functions shall be-

(a) to issue certificates for utility innovations;

(b) to consider applications for compulsory licences under subsection (2) of section 51;

(c) to appoint Examiners; and

(d) to advise the Minister generally on matters pertaining to this Act.";

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

"(1A) The Board may delegate any of its functions under paragraphs (a) and (b) of subsection (1) to any person it deems fit."; and

(c) by substituting for the words "the Secretary General of" which appear in paragraphs (b) and (c) of subsection (2) the words "a representative from".

Section 4. Amendment of section 7.

Section 7 of the principal Act is amended by substituting for the word "Schedule" the words "First Schedule".

Section 5. New section 7A.

The principal Act is amended by inserting the following section after section 7:

"7A. Protection in respect of acts done in pursuance of this Act.

A member of the Board or an Examiner shall not be personally liable for or in respect of any act, matter or thing done or omitted to be done in good faith and in the proper exercise of any of his duties or functions as a member of the Board or an Examiner under this Act."

Section 6. Amendment of section 9.

Section 9 of the principal Act is amended by inserting the following subsections after subsection (3):

"(4) The Minister may, by notification in the *Gazette*, establish such number of branch offices of the Patent Registration Office as he may deem necessary for the purposes of this Act.

(5) Any application or other document required or permitted to be filed at the Patent Registration Office may be filed at any branch office of the Patent Registration Office and such application or other document shall be deemed to have been filed at the Patent Registration Office."

Section 7. Amendment of section 13.

Section 13 of the principal Act is amended by substituting for subsection (1) the following subsection:

"(1) Notwithstanding the fact that they may be inventions within the meaning of section 12, the following shall not be patentable:

(a) discoveries, scientific theories and mathematical methods;

(b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes;

(c) schemes, rules or methods for doing business, performing purely mental acts or playing games;

(d) methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body:

Provided that this paragraph shall not apply to products used in any such methods."

Section 8. Amendment of section 14.

Section 14 of the principal Act is amended -

- (a) by inserting the word "date" after the word "filing" in paragraphs (a) and (b) of subsection (2);
- (b) in the national language text, by inserting the words "yang lebih awal" after the words "tarikh prioriti" in paragraph (b) of subsection (2); and
- (c) by substituting for the words "six months" in paragraph (b) of subsection (3) the words "one year".

Section 9. Amendment of section 15.

Section 15 of the principal Act is amended by substituting for the words "the prior art to the patent application claiming the invention" the words "any matter which forms part of the prior art under paragraph (a) of subsection (2) of section 14".

Section 10. New Part IV A.

The principal Act is amended by inserting the following heading after section 16:

**"PART IVA
UTILITY INNOVATIONS".**

Section 11. Amendment of section 17.

Section 17 of the principal Act is amended by substituting therefor the following section:

"17. Definition.

For the purposes of this Part, "utility innovation" means any implement, tool, product or process which is of practical utility by reason of its form, configuration, construction or composition and which is new to Malaysia."

Section 12. New section 17A.

The principal Act is amended by inserting the following section after section 17 in the new Part IVA:

"17A. Application.

(1) Except as otherwise provided in this Part, the provisions of this Act, subject to the modifications in the Second Schedule, shall apply to utility innovations in the same manner as they apply to inventions.

(2) Sections 11,12, 15, 16, 26, Part X, and sections 89 and 90 shall not apply to utility innovations."

Section 13. New section 23A.

The principal Act is amended by inserting the following section after section 23:

"23A. Applications by residents to be filed in Malaysia first.

(1) No person resident in Malaysia shall, without written authority granted by the Registrar, file or cause to be filed outside Malaysia an application for a patent for an invention unless-

(a) an application for a patent for the same invention has been filed in the Patent Registration Office not less than two months before the application outside Malaysia; and

(b) either no directions have been issued by the Registrar under section 30A in relation to the application or all such directions have been revoked."

Section 14. New section 26A and 26B.

The principal Act is amended by inserting the following sections after section 26:

"26A. Amendment of application.

The applicant may amend the application: Provided that the amendment shall not go beyond the disclosure in the initial application.

26B. Division of application.

(1) The applicant may divide the application into two or more applications ("divisional applications"):

Provided that each divisional application shall not go beyond the disclosure in the initial application.

(2) Each divisional application shall be entitled to the filing date and, where appropriate, the priority date of the initial application."

Section 15. Amendment of section 30.

Section 30 of the principal Act is amended -

(a) by substituting for the figures "28" in subsection (2) the figures "29";

(b) by inserting the words "filing date or, where appropriate," after the words "having the same" in subsection (5); and

(c) by inserting the words "to grant a patent in pursuance of more than one of" after the word "refuse" in subsection (5).

Section 16. New section 30A.

The principal Act is amended by inserting the following section after section 30:

"30A. Prohibition of publication of information which might be prejudicial to the nation.

(1) Subject to any direction of the Minister, where an application for a patent is filed or is deemed to have been filed at the Patent Registration Office and it appears to the Registrar that the application contains information the publication of which might be prejudicial to the interest or security of the nation, he may issue directions prohibiting or restricting the publication of that information or its communication whether generally or to a particular person or class of persons.

(2) Subject to any direction by the Minister, the Registrar may revoke any direction issued by him under subsection (1) prohibiting or restricting the publication or communication of any information contained in an application for a patent if he is satisfied that such publication or communication is no longer prejudicial to the interest or security of the nation.

(3) Where directions issued by the Registrar under subsection (1) are in force in respect of an application, the application may proceed to the stage where it is in order for the grant of a patent but no patent shall be granted in pursuance of such application.

(4) Nothing in this section prevents the disclosure of information concerning an invention to a Ministry or a Government department or authority for the purpose of obtaining advice as to whether directions under this section should be made, amended or revoked."

Section 17. Amendment of section 32.

Section 32 of the English text of the principal Act is amended by substituting for the word "revocation" the word "invalidation".

Section 18. Amendment of section 34.

Section 34 of the principal Act is amended by inserting the words "or the office of any Examiner" after the words "Patent Registration Office" wherever they appear in subsection (3).

Section 19. Amendment of section 35.

The proviso to subsection (2) of section 35 of the principal Act is amended by deleting the words "and that the patentee may pay in advance the whole or any portion of the aggregate of the prescribed annual fees".

Section 20. Amendment of section 36.

Section 36 of the principal Act is amended by inserting the following subsection after subsection (3):

"(4) For the purposes of this section, if the patent has been granted in respect of a process for obtaining a product, the same product produced by a person other than the owner of the patent or his licensee shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process."

Section 21. Amendment of section 37.

Subsection (3) of section 37 of the principal Act is amended by inserting the word "temporarily" after the words "land vehicle".

Section 22. Amendment of section 38.

Subsection (1) of section 38 of the English text of the principal Act is amended by substituting for the words "Provided further than" in the second proviso to that subsection the words "Provided further that".

Section 23. Amendment of section 42.

Section 42 of the principal Act is amended by substituting therefor the following section:

"42. Entry in the Register.

(1) A licensor may in accordance with the regulations as prescribed by the Minister apply to the Registrar for an entry to be made in the Register to the effect that any person may obtain a licence.

(2) At any time after an entry has been made in the Register, any person may apply to the licensor through the Registrar for a licence.

(3) Where a licence contract is concluded between the parties, the contracting parties shall inform the Registrar accordingly and the Registrar shall record such fact in the Register.

(4) Upon a request in writing signed by or on behalf of the contracting parties, the Registrar shall, on payment of the prescribed fee, record in the Register such particulars relating to the contract as the parties thereto might wish to have recorded:

Provided that the parties shall not be required to disclose or have recorded any other particulars relating to the said contract.

(5) Where a licence contract is terminated, the contracting parties shall inform the Registrar of the termination and the Registrar shall record such termination in the Register.

(6) The licensor may in accordance with the regulations as prescribed by the Minister apply to the Registrar for the cancellation of the entry made under subsection (1)."

Section 24. Amendment of section 45.

Section 45 of the English text of the principal Act is amended by inserting the word "upon" after the words "in so far as it imposes".

Section 25. Amendment of section 46.

Section 46 of the principal Act is amended by deleting the words "the registration of" in paragraph (e).

Section 26. New section 49A.

The principal Act is amended by inserting the following section after section 49:

"49A. Application for compulsory licence based on interdependence of patents.

(1) If the invention claimed in a patent ("later patent") cannot be worked in Malaysia without infringing a patent granted on the basis of an application benefiting from an earlier filing date or, where appropriate, priority date ("earlier patent"), and if the invention claimed in the later patent constitutes, in the opinion of the Board, an important technical advance in relation to the invention claimed in the earlier patent, the Board, upon the request of the owner of the later patent, the licensee of a licence contract under the later patent or the beneficiary of a compulsory licence under the later patent, may grant a compulsory licence to the extent necessary to avoid infringement of the earlier patent.

(2) If a compulsory licence is granted under subsection (1), the Board, upon the request of the owner of the earlier patent, the licensee of a licence contract under the earlier patent or the beneficiary of a compulsory licence under the earlier patent, may grant a compulsory licence under the later patent."

Section 27. Amendment of section 50.

Section 50 of the principal Act is amended -

(a) by inserting the words "or section 49A" after the words "section 49" in subsection (1); and

(b) by inserting the words ", or section 49A," after the words "section 49" in subsection (2).

Section 28. Amendment of section 51.

Subsection (1) of section 51 of the principal Act is amended by inserting the words "or section 49A" after the words "section 49".

Section 29. Amendment of section 55.

Section 55 of the principal Act is amended by inserting the following subsection after subsection (3):

"(3A) Where a compulsory licence has been granted in respect of a patent, the Registrar shall not accept or record the said surrender except upon receipt of a signed declaration by which the beneficiary of the compulsory licence consents to the said surrender."

Section 30. New sections 62A and 62B.

The principal Act is amended by inserting the following sections before section 63 in Part XIII:

"62A. Applications in contravention of section 23A.

Any person who files or causes to be filed an application for a patent in contravention of section 23A commits an offence and is liable on conviction to a fine not exceeding fifteen

thousand ringgit or to imprisonment for a term not exceeding two years or to both.

62B. Publication of information in contravention of Registrar's directions.

Any person who publishes or communicates information in contravention of any direction issued by the Registrar under section 30A commits an offence and is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both."

Section 31. New section 66A.

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

" 66A. Unregistered persons practising, etc., as a patent agent.

Any person who carries on business, practises, acts, describes himself, holds himself out, or permits himself to be described or held out, as a patent agent without being registered under this Act commits an offence and is liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both."

Section 32. Amendment of section 82.

Section 82 of the principal Act is amended by inserting the words ", upon payment of the prescribed fee" after the word "expiration".

Section 33. Amendment of section 84.

Section 84 of the principal Act is amended -

(a) by substituting for the words "in any written law" the words "in this Act", and

(b) by substituting for the words "shall not be liable to pay any compensation or to make any payment" in paragraph (b) the words "shall pay reasonable compensation".

Section 34. Amendment of section 85.

Section 85 of the principal Act is amended by inserting the words "by the Minister" after the words "regulations made".

Section 35. Amendment of section 86.

Section 86 of the principal Act is amended by substituting therefor the following section:

"86. Patent agents.

(1) There shall be kept at the Patent Registration Office a Register of Patents Agents.

(2) No person shall carry on business, practise, act, describe himself, hold himself out, or permit himself to be described or held out, as a patent agent unless he is registered in the Register of Patents Agents.

(3) The registration of a patent agent mentioned in subsection (2) shall be in accordance with the regulations as may be prescribed by the Minister under this Act.

(4) The appointment or change of a patent agent shall not be effective against any third person unless it is registered in the Register of Patents Agents.

(5) A person who has neither his domicile nor residence in Malaysia may not proceed before the Patent Registration Office or institute or appear in a suit under the provisions of this Act in respect of his patent except through a patent agent."

Section 36. Amendment of section 89.

Section 89 of the principal Act is amended -

(a) by substituting for the word "Ordinance" which first appears the word "Act"; and

(b) by substituting for the marginal reference "9/51" the marginal reference "Act 215."

Section 37. New section 90.

The principal Act is amended by inserting the following section after section 89:

"90. Transitional.

(1) Where an application has been made under an Act or Ordinance repealed under section 89, the Registrar may issue a certificate on such application as if the Act or Ordinance had not been repealed, and such certificate shall remain in force -

(a) so long as the original patent remains in force in the United Kingdom; or

(b) until the expiration of twenty years from the date of application, whichever is the earlier.

(2) Where a patent has been granted under the United Kingdom Patents Act 1977 not earlier than twenty-four months before the coming into force of this Act, the owner of the patent may, within a period of twelve months from the coming into force of this Act, make an application for a certificate and the Registrar may issue a certificate on such application as if the Act or Ordinance repealed under section 89 had not been repealed, and such certificate shall remain in force-

(a) so long as the original patent remains in force in the United Kingdom; or

(b) until the expiration of twenty years from the date of the application,

whichever is the earlier.

(3) The Registrar may amend, modify, renew, cancel or revoke a certificate issued under subsection (1) or (2) in accordance with the powers conferred upon him by the relevant provisions of this Act relating to patents.

(4) Where, prior to the coming into force of this Act, an application for a patent has been made under the United Kingdom Patents Act 1977 or an application designating the

United Kingdom has been filed at the European Patent Office, the applicant may, within a period of twelve months from the coming into force of this Act, make an application for the grant of a patent under this Act, and such application shall be accorded the filing date and the right of priority which have been accorded to it in the United Kingdom."

Section 38. Amendment of Schedule.

The existing Schedule to the principal Act is amended by substituting for the heading "SCHEDULE" the heading "FIRST SCHEDULE".

Section 39. New Second Schedule.

The principal Act is amended by inserting the following Schedule after the existing Schedule to the Act:

"SECOND SCHEDULE

(Section 17A)

MODIFICATIONS TO THE PROVISIONS OF THE ACT APPLICABLE TO UTILITY INNOVATIONS

(1) Provisions of the Act	(2) Modifications
Section 3	Substitute "certificate for a utility innovation" and "application for a certificate for a utility innovation" for "patent" and "patent application" respectively in the definition of "right".
Section 13	1. Substitute "utility innovations" for "inventions". 2. Substitute "eligible for a certificate for a utility innovation" for "patentable".
Section 14	Substitute therefor the following: "14. Novelty. (1) A utility innovation is new to Malaysia if it is not anticipated by prior art. (2) Prior art shall consist of - (a) everything disclosed to the public in Malaysia by written publication, by oral disclosure, by use or in any other way, prior to the filing date or, where appropriate, priority date of the application for a certificate for a utility innovation claiming the utility innovation; (b) the contents of a domestic application for a certificate for a utility innovation having an earlier filing date or, where appropriate, priority date than the application referred to in paragraph (a) to the extent that such contents are included in the certificate for a utility innovation granted on the basis of

the said domestic application.

(3) A disclosure made under paragraph (a) of subsection (2) shall be disregarded -

(a) if such disclosure occurred within one year preceding the date of the application and if such disclosure was by reason or his predecessor in title;

(b) if such disclosure occurred within one year preceding the date of the application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title."

PART V
(except as otherwise
provided below)

1. Substitute "certificate for a utility innovation" for "patent".

2. Substitute "innovator" for "inventor".

3. Substitute "utility innovation" for "invention".

4. Substitute "a utility innovation" for "an invention".

Section 19

Substitute therefor the following:

"19. Judicial assignment of application for a utility innovation or a certificate for a utility innovation.

Where the essential elements of the utility innovation claimed in -

(a) an application for a certificate for a utility innovation; or

(b) a certificate for a utility innovation,

have been unlawfully derived from an invention or a utility innovation for which the right to the patent or the certificate for a utility innovation belongs to another person, such other person may apply to the Court for an order that the said application or certificate be assigned to him:

Provided that the Court shall not entertain an application for the assignment of a certificate for a utility innovation after three years from the date of the grant of the certificate."

PART VI
(except as otherwise
provided below)

1. Substitute "certificate for a utility innovation" for "patent".

2. Substitute "innovator" for "inventor".

3. Substitute "utility innovation" for "invention".

4. Substitute "an application for a certificate for a utility innovation for a patent application".

- Section 28 Substitute "the claim" for "a claim or claims" in paragraph (d) of subsection (1).
- Section 29
1. Substitute "the claim" for "one or more claims" in subsection (1).
 2. In subsection (4)-
 - (a) substitute "subsection (5)" for 'subsections (5) and (6)';
 - (b) substitute "the utility innovation for which a certificate is sought is new to Malaysia and is of practical utility by reason of its form, configuration, construction or composition" for "the invention for which a patent is sought is new and involves an inventive step".
 3. Delete subsection (6).
- Section 31
1. In subsection (2) -
 - (a) substitute "Board" for "Registrar";
 - (b) substitute "the Board" for "he";
 - (c) substitute "a certificate for a utility innovation" for "a certificate of grant of the patent and a copy of the patent" in paragraph (a);
 - (d) substitute the following paragraph for paragraph (b):

"(b) direct the Registrar to record the certificate for a utility innovation in the Register for Certificates for Utility Innovations."
 2. In subsection (4), substitute "Board" for "Registrar".
- Section 32
1. Substitute "Register for Certificates for Utility Innovations" for "Register of Patents".
 2. Substitute "certificates for utility innovations" and "the application for a certificate for a utility innovation" for "patents" and "the patent application" respectively.
- Section 34 Substitute "any application for a certificate for a utility innovation" for "any patent application".
- Section 35 Substitute therefor the following:
- "35. Duration of certificate for a utility innovation.
- (1) Subject and without prejudice to the provisions of this Act, a certificate for a utility innovation shall expire five years after the date of its grant.

(2) Notwithstanding subsection (1), the owner of a certificate for a utility innovation may, before the expiration of the period of five years mentioned in subsection (1), apply for an extension for an additional period of five years and may, before the expiration of the second period of five years, apply for an extension for a further period of five years.

(3) An application for extension under subsection (2) shall be accompanied by an affidavit of the owner of the certificate for the utility innovation showing that the utility innovation is in commercial or industrial use in Malaysia, or satisfactorily explaining its non-use, and shall also be accompanied by the prescribed fee.

(4) Where the owner of a certificate for a utility innovation intends to keep the certificate in force, he shall, twelve months before the date of expiration of the third and each succeeding year during the term of the certificate, pay the prescribed annual fee:

Provided, however, that a period of grace of six months shall be allowed after the date of such expiration upon payment of such surcharge as may be prescribed."

PART VII
(except as otherwise
provided below)

1. Substitute "certificate for a utility innovation" for "patent".
2. Substitute "utility innovation for which a certificate has been granted" for "patented invention".
3. Substitute "application for a certificate for a utility innovation" for "patent application".
4. Substitute "utility innovation" for "invention".

Section 37

1. In subsection (2)-
 - (a) substitute a full stop for the semicolon at the end of paragraph (iii);
 - (b) delete paragraph (iv).
2. Delete "the provisions on compulsory licences as provided in sections 51 and 52 and by" in subsection (5).

Section 38

- In subsection (1)-
- (a) substitute a full stop for the colon at the end of the first proviso;
 - (b) delete the second proviso.

PART VIII

1. Substitute "An application for a certificate for a utility innovation or a certificate for a utility innovation" for "A patent application or patent".
2. Substitute "an application for a certificate for a utility innovation or

a certificate for a utility innovation" for "a patent application or patent".

3. Substitute "the application for a certificate for a utility innovation" for "the patent application".

4. Substitute "certificate for a utility innovation" for "patent".

5. Substitute "utility innovation for which a certificate has been granted for patented invention".

PART IX

1. Substitute "certificate for a utility innovation" for "patent".

2. Substitute "utility innovation" for "invention".

3. Substitute "utility innovation for which a certificate has been granted" for "patented invention".

4. Substitute "application for a certificate for a utility innovation" for "patent application".

PART XI (except as otherwise provided below)

1. Substitute "certificate for a utility innovation" for "patent".

2. Substitute "utility innovation" for "invention".

Section 55

Delete subsections (2) and (3A).

Section 56

1. Substitute the following paragraph for paragraph (a) of subsection (2):

"(a) that what is claimed as a utility innovation in the certificate for a utility innovation is not a utility innovation within the meaning of section 17 or is excluded from protection under section 13 or subsection (1) of section 31;"

2. Substitute "some parts of a claim, such parts of a claim" for "some of the claims or some parts of a claim, such claims or parts of a claim" in subsection (3).

PART XII (except as otherwise provided below)

Substitute certificate for a utility innovation" for "patent".

Section 59

Substitute "two" for "five" in subsection (3).

Section 61

Substitute the following subsection for subsection (1):

"(1) For the purposes of this section, "beneficiary" means any licensee unless the licence contract provides that the provision of this subsection do not apply or provides different provisions."

Section 62

1. Delete "(a)" after "(3)" in subsection (3).

2. Delete paragraph (b) of subsection (3).

PART XIII
(except as otherwise
provided below)

1. Substitute "certificate for a utility innovation" for "patent".

2. Substitute "product in respect of which a certificate for a utility innovation has been granted" for "patented product".

3. Substitute "utility innovation" for "invention".

Section 64

1. Substitute "product or process in respect of which a certificate for a utility innovation has been granted" for "patented product or process" in subsection (1).

2. Delete 'the word "patent" or "patented" or' in subsection (2).

PART XV (except in
section 86)

1. Substitute "certificate for a utility innovation" for "patent".

2. Substitute "utility innovation" for "invention".

3. Substitute "certificates for utility innovations" for "patents".

Section 86

Substitute "his certificate for a utility innovation" for "his patent" in subsection (5).".