

Enforcement of Post-Grant Opposition and File Wrapper Provisions

Following the introduction of new provisions that provide for **opposition** of Malaysian patents under the Patents (Amendment) Act 2022, these provisions will now officially come into effect on **31 December 2025**.

With implementation of the new Sections 55A and 56A, any interested person, may file an opposition to a Malaysian patent granted by the Malaysian IP Office (MyIPO) on or after **31 December 2025**.

Opposition must be filed **within six months** of publication of patent grant in the Intellectual Property Official Journal (IPOJ). This deadline is not extendible.

If the opponent is a non-resident of Malaysia, a **security for cost** must be paid when filing the Notice of Opposition.

Opposition can only be based on the following grounds:

- claimed invention does not meet the definition of an invention,
- subject matter of the patent is excluded from patent protection,
- subject matter of the patent lacks novelty, inventive step and/or industrial applicability,
- description or claims does not comply with the Patent Regulations,
- any drawings necessary for understanding the invention have not been provided.

Notice of opposition must be filed in writing to MyIPO by submitting the opposition form, stating the grounds for opposition and including supporting evidence. Any evidence that is not in English must be accompanied by a verified English translation.

The patent owner will have an extendible **three-month term** (from issuance of copy of notice of opposition by the Registrar) to submit a Counterstatement.

The opponent may respond to the Counterstatement by submitting evidence in reply within **three months** (extendible) of issuance of the Counterstatement by the Registrar.

Written submissions by both the opponent and the patent owner fall due within **three months** (extendible) from issuance of the relevant notifications by the Registrar.

An *ad hoc* Opposition Committee (OC) will be formed by the Registrar.

If the OC is minded to invalidate the patent, the Registrar will notify the patent owner and give the patent owner an opportunity to amend the patent. Any such amendment must be made within a non-extendible **two-month term**.

At the conclusion of the opposition proceedings, there are three possible outcomes:

- The patent remains as originally granted.
- The patent is maintained in an amended form.
- The patent is revoked.

Based on the final recommendation from the OC, the final decision issued by the Registrar may be appealed to the High Court within **one month** from the date of notification of the decision.

Additionally, **amended Section 34(1)** will also come into force on **31 December 2025**. This brings about a "**file wrapper**" **system** where amongst other pertinent information and documents, search and/or examination reports issued by MyIPO as well as the applicant's response to examination reports will be made available for public inspection.

If any of the above is of particular interest to you or your client, please do feel free to reach out directly to any of our Patent Professionals or to our general email address, patent@henrygoh.com.

Henry Goh & Co Sdn Bhd

13 October 2025