



# POST-GRANT PATENT OPPOSITION IN MALAYSIA: A NEW ADMINISTRATIVE PATHWAY FOR PATENT CHALLENGES

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### Introduction

When the Patents (Amendment) Act 2022 (“**Amendment Act**”) was enacted, it notably introduced a new patent opposition proceeding under **section 55A of the Patents Act 1983** as an alternative to court proceedings for challenging granted patents. Recently, the Patents (Amendment) Regulations 2025 (“**Regulations**”) and Practice Notice No. 1/2025 issued by the Registrar of Patents on 10th October 2025, which came into force on 31st December 2025, outlined the procedures and timeline for the new patent opposition mechanism within the local framework.

### Initiating the Opposition Proceedings

#### Interested Person

Opposition proceedings may now be initiated before the Patent Registration Office by any interested person against the patent owner to challenge a granted patent. Before diving in, we should highlight that

the term “*any interested person*” is not strictly defined under the Regulations. Accordingly, it would appear that a post-grant opposition can be filed by any person, whether or not they are adversely affected by the patent in question, and this includes a patent agent. This stands in contrast to patent invalidation proceedings before the Court, which requires the plaintiff to meet the higher threshold of being an aggrieved person. However, it should be noted that where the interested person is not a resident, security for costs in monetary form is required, and this will be kept by the Intellectual Property Corporation of Malaysia (“**MyIPO**”) until the final disposal of the opposition proceedings.

#### Notice of Opposition

From a bird’s-eye perspective, the inclusion of a post-grant opposition mechanism serves as a preliminary safeguard that filters and manages challenges raised against a granted patent. Under this system, an interested person may initiate an opposition by filing a Notice of Opposition with MyIPO, within **six (6) months from the date of publication of the grant of patent**,<sup>1</sup> and must be accompanied by: -

<sup>1</sup> Patents (Amendment) Regulations 2025, subregulation 43A(1)

- (i) **Patent Form No. 26** detailing the grounds of opposition;
- (ii) Official fee of **RM2,500.00** to oppose the grant of patent, or **RM1,500.00** against the grant of certificate for utility innovation;
- (iii) A supporting statement; and
- (iv) Evidence in support by way of a statutory declaration.<sup>2</sup>

It should be highlighted that the six-month deadline to file a Notice of Opposition must be calculated from the date of publication as reflected in the Online Journal. It is important to note that an extension of time to the opposition period or deadline to file a Notice of Opposition is not allowed.

Upon filing the Notice of Opposition, any interested person may file additional ground(s) of opposition by submitting the following, so long as it is filed within the six-month opposition period: -

- (i) **Patent Form No. 26B**;
- (ii) Official fee of **RM350.00**;
- (iii) A supporting statement; and
- (iv) Evidence in support by way of a statutory declaration.<sup>3</sup>

As of now, all filings must be completed manually as the online filing system has yet to be able to support patent opposition submissions. The Notice of Opposition shall not be entertained if there is a failure to comply with the abovementioned requirements, and this includes filing the Notice of Opposition outside the prescribed six-month period or that no security of costs is being provided by the interested person.<sup>4</sup>

As such, interested person(s) who wish to oppose a granted patent should be mindful of the prescribed timeline and fulfil all necessary formality requirements to ensure that their oppositions are neither time-barred nor rejected on technical grounds.

#### Counterstatement

Upon receipt of the Notice of Opposition, the Registrar shall notify the same to the patent owner or patent agent on record. The patent owner then has up to **three (3) months** from the date of issuance of the Notice of Opposition or Additional Grounds of Opposition to file a Counterstatement using **Patent Form No. 26C** with payment of an official fee of **RM250.00**.<sup>5</sup> For utility innovation, the relevant form is **Patent Form No. 26D** with a prescribed fee of

<sup>2</sup> Ibid, subregulation 43A(2)

<sup>3</sup> Ibid, subregulation 43B(1)

<sup>4</sup> Ibid, subregulations 43A(3) and 43B(2)

<sup>5</sup> Patents (Amendment) Regulations 2025, subregulations 43E(1) and 43E(2)

**RM150.00.** The Counterstatement must be accompanied by statements to support the grant of the patent and rebuttals to the grounds of opposition, as well as evidence to support the abovementioned statements submitted by way of statutory declaration.

It is possible to obtain an extension of time of **one (1) month** to file the Counterstatement. However, it is crucial to note that failure to file a Counterstatement will prevent the patent owner from proceeding in the opposition proceedings as the Registrar may issue a decision accordingly pursuant to **section 55A(5) of the Patents Act 1983**.<sup>6</sup>

Upon or after filing the Counterstatement, the patent owner has the option of filing a request to amend the patent by filing **Patent Form No. 26E** with an official fee of **RM150.00**. Such request shall only be made for the purpose of responding to the Notice of Opposition and Additional Grounds of Opposition (if any).<sup>7</sup>

#### Evidence in Reply and Written Submissions

The Registrar shall then issue a copy of the patent owner's Counterstatement and request to amend the patent to the

interested person. The interested person may then file with the Registrar, within **three (3) months** of the issuance of the Counterstatement, an Evidence in Reply by way of statutory declaration and a response to the patent owner's request to amend the patent.<sup>8</sup> It should be noted that the Evidence in Reply must be strictly confined to matters in response to the patent's owner evidence only. The Registrar shall then issue a copy of the Evidence in Reply and response to the request to the patent owner.

Upon the submission of the relevant documents by the interested person and/or patent owner, the Registrar may notify both parties to file a written submission within **three (3) months** from the date of issuance of the notification to file the written submission, to which shall not contain new evidence.<sup>9</sup> In the event such notification has been issued by the Registrar, no leave for the submission of further evidence may be granted.<sup>10</sup> MyIPO will only issue its determination after the deadline for filing written submissions has lapsed.

<sup>6</sup> Patents Act 1983, section 55A(5)

<sup>7</sup> Patents (Amendment) Regulations 2025, subregulation 43E(4)

<sup>8</sup> Ibid, subregulation 43H

<sup>9</sup> Ibid, subregulation 43J

<sup>10</sup> Ibid, subregulation 43J(3)

### Recommendation and Decision by Ad Hoc Committee

Upon receipt of all documents from both parties, an *ad hoc* opposition committee (“**Opposition Committee**”) composed of senior patent examiners will be formed to examine the documents, make recommendations, and issue decisions. During its first sitting, the Opposition Committee may recommend to the Registrar that the patent be maintained, maintained subject to amendment, or invalidated.<sup>11</sup>

In the event that the initial recommendation by the Opposition Committee is to invalidate the patent, the Registrar may allow the patent owner to amend its patent and such request can be made by filing **Patent Form No. 26E** along with a payment of prescribed fee of **RM150.00** within **two (2) months** from the date of notification issued by the Registrar to amend the patent in question, provided a Counterstatement was filed.<sup>12</sup> However, any amendments made should not extend the protection conferred at the time of grant of the patent and must be within the permitted scope specified by the Registrar

in the notification. It should be noted that any amendment to convert the patent to a utility innovation, or *vice versa*, is not permitted in post-grant opposition proceedings. If a request to amend does not comply with the stipulated requirements, the Registrar shall issue a notification to the patent owner on the non-compliance, and the patent owner shall make the necessary amendments within **two (2) weeks** from the date of issuance of the notification.<sup>13</sup>

After the amendments have been duly submitted, the Committee will have a second sitting to examine the amendments and submit a second recommendation to the Registrar, who will then issue a final decision to the parties to the proceedings. Again, the Registrar may either maintain the patent, maintain the patent in its amended form, or invalidate the same. If any party is not satisfied with the final decision of the Registrar, an appeal can be filed to the High Court within **one (1) month** from the date the final decision is issued by

<sup>11</sup> Ibid, subregulation 43K (1)

<sup>12</sup> Ibid, subregulations 43K (2), (3). On an additional note, no extension of time shall be allowed to the patent owner to make the amendment after the expiry of the prescribed period.

<sup>13</sup> Ibid, subregulations 43K (4), (6)



the Registrar to the interested person and patent owner.<sup>14</sup>

It is also worth noting that MyIPO may award costs to the party in whose favour the decision is rendered. Accordingly, it is essential for parties, when filing their Notice of Opposition or Counterstatement, to indicate their intention to seek costs by ticking the relevant box on the form. Failure to indicate intention to seek costs will result in MyIPO not awarding any costs, regardless of the outcome of the proceedings. It is our understanding that MyIPO will, in due course, issue guidelines on the amount of costs that may be awarded by MyIPO.

At this juncture, we should mention that where more than one Notice of Opposition is filed by different interested persons against a patent on the ground of lack of novelty by relying on different prior art(s), it remains to be seen if the Opposition Committee will review all such prior arts collectively or separately. This is crucial as combining multiple prior art documents to examine whether a patent is novel, or better known as patent mosaicking, is generally not permitted when assessing the novelty of an invention under Malaysian

laws. If the Opposition Committee reviews and combines prior arts raised by different interested persons, this would mean that the patent owner may have no recourse to respond to the same, apart from the opportunity to amend the patent following the Opposition Committee's initial recommendation. As such, we await and welcome further clarification from MyIPO on this issue as to how this potential unfairness to the patent owner may be appropriately addressed in due course.

#### Supplemental Information

It should be noted that failure to comply with any of the prescribed requirements at any stage of the opposition proceedings will result in the relevant requests and/or applications being deemed abandoned or refused.<sup>15</sup> Accordingly, it is crucial that all filings are made within the prescribed timelines as set out in the table below and accompanied by the necessary documentation and payments: -

<sup>14</sup> Patents Act 1983, section 88

<sup>15</sup> Ibid, subregulations 43D(2), 43D(3), 43G(2), 43G(3), and 43K(7)

| Stage  | Relevant Parties                      | Prescribed Period   |
|--|---------------------------------------|---|
| Notice of Opposition and Additional Ground(s) of Opposition (if any) | Interested person(s)                  | Six (6) months from the date of publication of the grant of the patent <sup>16</sup>  |
| Counterstatement and Request to Amend Patent                         | Patent owner                          | Three (3) months from the date of issuance of the Notice of Opposition or Additional Grounds of Opposition <sup>17</sup>                                    |
| Evidence in Reply  | Interested person(s)                  | Three (3) months from the date of issuance of the copy of Counterstatement and the document(s) in relation to the request to amend the patent <sup>18</sup> |
| Written Submissions  | Patent owner and Interested person(s) | Three (3) months from the date of issuance of the Registrar's notification to file the written submission <sup>19</sup>                                     |
| Request to Amend Patent Upon Opposition Committee's Recommendation   | Patent owner                          | Two (2) months from the date of notification issued by the Registrar, giving the  |

<sup>16</sup> Ibid, subregulation 43A(1)

<sup>17</sup> Ibid, subregulation 43E(1)

<sup>18</sup> Ibid, subregulation 43H(1)

<sup>19</sup> Ibid, subregulation 43J(1)

| Stage   | Relevant Parties                         | Prescribed Period  |
|---|--|--|
|   |  | opportunity to amend the patent <sup>20</sup>  |
| Amendment to a Request to Amend Patent Upon Opposition Committee's Recommendation | Patent Owner                             | Two (2) weeks from the date of issuance of notification by the Registrar <sup>21</sup> |
| Appeal to the Court   | Patent owner and/or Interested person(s) | One (1) month from the date of the final decision                                      |

Any request for an extension of time in opposition proceedings, where applicable, must be filed before the expiry of the relevant statutory period or prescribed deadline. The Registrar shall grant the request only once, provided that the requested extension does not exceed **one (1) month**.<sup>22</sup> MyIPO has acknowledged that the procedural timeline for requesting an extension of time, as set out in the table above, is inconsistent with **section 82 of the Patents Act 1983**,<sup>23</sup> and **Regulation 53 of the Patents Regulations 1986**.<sup>24</sup>

These provisions stipulate that a request for extension of time made after the expiration of a prescribed period under the **Patents Act 1983** or any regulations made thereunder shall be made not later than **six (6) months** from the expiration of the prescribed period. In view of the inconsistency in the statutory provisions stipulated in the Patents Act 1983, Patents Regulations 1986 and the newly issued Regulations in respect of the timeline for request for extension of time, we understand that MyIPO intends to issue a

<sup>20</sup> Ibid, subregulation 43K(3)

<sup>21</sup> Ibid, subregulation 43K(6)

<sup>22</sup> Ibid, subregulation 43R(1)

<sup>23</sup> Patents Act 1983, s 82. N.B. The provision states that the Registrar may, unless otherwise expressly directed by any Court, extend the time for a time is specified within which an act or thing is to be done, either before or after its expiration, upon payment of the prescribed fee within the period prescribed in the Regulations.

<sup>24</sup> Patent Regulations 1986 P.U.(A) 327/86, regulation 53. N.B. The regulation provides that a request for an extension of time under section 82 of the Patents Act 1983 shall be made to the Registrar on Form 21 along with the prescribed fee.



formal directive in due course to clarify and address this inconsistency and to clarify that any request for extension of time under the post-grant patent opposition proceedings will be governed by the strict timeline indicated under the **subregulation 43R(1)** of the new Regulations.

On a separate note, all documents in relation to opposition proceedings, including evidence, shall be filed in the national language (Malay) or English. Otherwise, such evidence that is not in the national language or in English must be supplemented by a certified translation.<sup>25</sup> Where any documents exchanged in the course of the opposition proceedings require amendment, the interested person or patent owner may apply to do so by means of submitting a request through **Patent Form No. 26G**, along with a fee of **RM150.00** within **one (1) month** from the date of issuance of notification by the Registrar.<sup>26</sup> In the event the submission of further evidence becomes necessary, the interested person or patent owner may seek leave from the Registrar to file further evidence by using **Patent Form No. 26F** with a payment of **RM300.00**. The other party may respond within **one (1) month**

from the date of the issuance of the copy for further evidence.<sup>27</sup>

## Conclusion

The introduction of post-grant opposition proceedings in Malaysia represents a significant and welcome development in the patent enforcement landscape. The opposition mechanism offers a more streamlined, cost-efficient and time-effective alternative to court-based invalidation proceedings, while preserving the ability of interested parties to challenge the validity of granted patents.

The effectiveness of this new regime will, however, depend on how the Registrar and Opposition Committee exercise their procedural discretion in practice, particularly in relation to evidentiary control, amendments, costs and the management of multiple oppositions. As early decisions begin to emerge, they will play a critical role in shaping confidence in the system and determining whether the post-grant opposition framework strikes an appropriate balance between accessibility, procedural fairness and patent certainty within Malaysia's broader patent enforcement framework.

<sup>25</sup> Ibid, subregulation 43(T)

<sup>26</sup> Ibid, subregulation 43D(1)

<sup>27</sup> Ibid, subregulation 43I

*This article was written by our Intellectual Property, Media, Sports & Gaming partners, Sri Sarguna Raj, Steven Cheok Hou Cher & Nicole Chong, with the assistance of Soo An Qi, Lim Chaw Zen, Michelle Yap Siew Hui and Emily Ong Wenyen (Managing Associate, Associates & Pupil). It contains general information only. It does not constitute legal advice or an expression of legal opinion and should not be relied upon as such.*