

Contributing firm
Henry Goh & Co Sdn Bhd



Author
Dave A Wyatt

Legal framework

The protection of industrial designs in Malaysia is governed by the Industrial Designs Act 1996 and the Industrial Designs Regulations 1999, which came into force on September 1 1999.

Malaysia is a signatory to the Paris Convention and a World Trade Organisation member state. It is also expected to accede to the Hague Agreement by 2015 under the Association of Southeast Asian Nations Economic Community Blueprint commitments.

The Malaysian industrial designs legislation is standalone and has little similarity to the patent legislation. In order to be protected, a design must be applied to an article of manufacture by an industrial process and must have eye appeal. The definition of an 'article' specifically includes handicrafts.

There is no formal official search or substantive examination. Applications undergo only a formal examination, although objections of a substantive nature are occasionally raised.

The Intellectual Property Corporation of Malaysia (MyIPO) also conducts a cross-check of its own records for conflicting registrations in terms of novelty, but the citation of prior art is rare.

The act was amended significantly in 2013, including a switch from national to worldwide novelty and extension of the protection term from 15 to 25 years.

Unregistered designs

Malaysian law does not provide for unregistered design rights. Therefore, it is particularly important to register designs in Malaysia wherever possible. The new term of protection of 25 years should make design registration a more attractive option. The relationship between copyright and registered design rights is discussed below.

Registered designs

Only the original owner of an industrial design is entitled to apply for its registration. The author is the original owner of an industrial design by default. However, where the design is created in the course of employment or is commissioned for money or equal worth, the

employer or the person commissioning the design shall be treated as the original owner, unless there is an agreement between the parties to the contrary.

As a computer-generated design has no human author, the person who made the arrangements necessary to create the design is taken to be the author.

The existing design registration law remains tied to the industrial age. An 'industrial design' is defined as features of shape, configuration, pattern or ornament which are applied to an article by any industrial process or means and which, in the finished article, appeal to and are judged by the eye. An 'article' is defined as any article of manufacture or handicraft. It includes any part of such an article or handicraft only if that part is made and sold separately.

The protection of designs does not extend to any method or principle of construction, meaning that industrial design registration cannot be exploited to obtain patent-like protection, but rather is confined to the aesthetic appearance of a specific article. Features of shape or configuration that are dictated solely by function are discounted when assessing registrability of a design. Similarly, 'must-match' features cannot contribute to registrability.

Finally, an industrial design that is contrary to public order or morality shall not be registrable. Local sensitivities are taken into account when assessing morality, as Malaysia has a multicultural society.

The scope of protection is determined by the representations of the design and the name of the article. Spare parts are not explicitly excluded from registration, but this may be the effect of the various exclusions contained in the definitions of protectable subject matter. For example, car body panels would fail under must-match consideration. Other parts may not qualify as an article or part of an article, and parts that are hidden or consist solely of functional features, or have no eye appeal, may similarly be unregistrable, or at least invalid if registered.

That said, the nature of the formal examination system is such that the majority of applications do proceed to registration.

An interesting point arises in regard to graphical user interfaces, such as screen layouts

for smart devices and televisions. A number of such applications have been submitted to MyIPO recently, and some have been accepted. However, there is a question mark over whether such designs meet the standard of being "applied to an article by an industrial process or means".

As for the cost of obtaining registration, a straightforward application for a single design may be registered for around \$1,000 if no objections are raised during prosecution. For a multiple application, each additional design after the first may add around another \$500 to \$600 to the overall costs. Upon registration, no further official fees are payable until the first renewal falls due five years later.

Procedures

An application for registration comprises:

- the completed application form;
- an original power of attorney;
- a statement briefly explaining the applicant's derivation of title from the author;
- one set of representations of the design; and
- payment of the official fees.

Apart from the power of attorney, all papers may be signed by the appointed Malaysian agent. If priority is claimed, a certified copy of the priority application and its verified English translation are required, although these may be submitted after the application date.

The representations consist of drawings or photographs showing several views of the design applied to the article. There is no prescribed minimum number of views. Each view must be numbered and labelled with a brief description to indicate the type of view. If priority is claimed, there will normally be objections if the views filed do not match those of the priority document. However, some minor deviations may be justified based on differing national practice.

The first sheet of the representations must carry a statement of novelty, which indicates the features of the design for which novelty is claimed. This statement is not a claim to what is protected, like a patent claim. However, it can be used to highlight particular features or to de-emphasise the importance of features shown in dotted lines. MyIPO generally prefers applicants to use standard wordings for the statement of novelty.

When filing the application, the applicant is now required to indicate which views of the design are to be published in the *Official Journal* and annexed to the certificate on registration. An official fee is payable for each view published.

The application must name the article.

Care should be taken when choosing the article name, since this is relevant to the question of whether a third party's product may constitute an infringement. The applicant must also state the relevant class and sub-class according to the Locarno international classification.

An application may include multiple designs, provided that each design belongs to the same Locarno class. Apart from this limitation, the designs and the articles to which they are applied may be unrelated to each other. Each additional design attracts a further filing fee as well as publication fees. The different designs in a multiple application are protected independently, and have individual registration numbers and certificates issued.

Upon filing an application, a serial number is allocated immediately. The application then proceeds to formal examination. If there are any objections, an adverse report will be issued, normally with a three-month response term. A three-month extension of time is also possible, on payment of official fees.

An application will proceed directly to registration once it is found to be in order. The details of the registration are then published in the *Official Journal* (up until July 2013, publication was in the government *Gazette*). There are no provisions for deferring publication on registration. The only option available to an applicant that wishes to defer publication is to cause a delay in prosecution. However, an application that is not in order for registration within 12 months of its filing date, due to default or neglect on the part of the applicant, shall be deemed withdrawn.

There are no provisions for opposition. Instead, any party may apply to the High Court for revocation of a registration on the grounds that the design was not new or that the registration was procured by unlawful means. Revocation may be sought as an original action or by way of counterclaim in an infringement suit.

For the purposes of novelty, prior art consists of a design previously disclosed to the

public, as well as any design that is the subject of an earlier-dated Malaysian registration. Before July 2013, a local novelty standard applied, meaning that only prior disclosures in Malaysia counted under the first limb. However, the 2013 amendments to the act adopted worldwide novelty.

Although infringement requires the article to be the same as that set out in the registration document, novelty is assessed based on the design itself – that is, irrespective of the article to which it is applied. Thus, a design applied to one article will lack novelty over prior art consisting of the same design applied to a different article.

An earlier design need not be identical to the registered design in order to count as an anticipation. The registered design will still lack novelty if it differs from the earlier design only in immaterial details or features commonly used in the relevant trade. The scope of protection will depend on the degree to which the registered design can be distinguished from the prior art. An incremental design will have a narrow scope of protection, whereas a radically different design will enjoy broader protection.

An aggrieved or interested person may apply to the High Court or the registrar for rectification of the Designs Register. Rectification of the register cannot be used as a substitute for revocation of a design, but rather can only add to, delete or amend an entry in the register. An application for rectification can be opposed by the registered owner.

Enforcement

There is a cause of action for infringement against anyone that, without the licence or consent of the registered design owner, applies the design or an obvious or fraudulent imitation thereof to any article in respect of which the design is registered, or imports, sells, hires, offers or keeps for sale or hire any such article.

Pursuant to case law, 'obvious' means that it is immediately apparent to the eye that the offending design is an imitation. On the other hand, a 'fraudulent' imitation means that the offending design is not necessarily an obvious copy of the registered design, and may even contain differences designed to disguise the copying, but which can nonetheless be deemed immaterial.

There is a statutory limitation period of five years from the act of infringement within which to commence action. It takes about nine months from filing a court action to fixing a trial date. The whole proceedings may take up to two years, depending on the complexity of the case.

Upon successful proof of infringement and defence of any counterclaim for revocation, the remedies that the court may grant include damages or an account of profits. It may also order an injunction to prevent further or imminent infringement. The court may refuse monetary relief if the defendant satisfies the court that it was unaware of the registration at the time of the infringement, and that it had previously taken all reasonable steps to ascertain whether the design had been registered.

Ownership changes and right transfers

The original owner of a design may assign its rights, including the right to apply for registration, to any other party. The assignment must be in writing. If an application has been filed or the design has been registered, an application to record the change of ownership should be made to MyIPO.

Apart from an assignment, ownership changes by way of transmission or other operation of law and security interest transactions may be recorded. For a registered design, the application should be made within six months of the transaction date. Otherwise, the court may refuse to award costs to the new owner in an infringement action. An entry in the register will be made on approval of the application. However, for an assignment of a pending application, the entry will be made only on registration of the design.

Related rights

When the act came into force in 1999, simultaneous amendments were made to the Copyright Act 1987 that substantially reduced the application of copyright law to designs and, in particular, the creation of three-dimensional articles.

First, Section 7(5) states that copyright shall not subsist in any registered design. In any event, a design is not a work eligible for copyright. This provision seeks to prevent overlapping rights under copyright and designs law.

Second, Section 13A provides that there is generally no infringement of any copyright in a design document or model that records or embodies a design by making an article to the design, or copying or reproducing an article made to the design. Here, a 'design' is defined broadly as any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration. This definition is sufficiently broad to cover both designs that are capable of registration and those that are not capable of registration. The effect of this provision is not to take away the copyright that exists in the design document or model, but rather to limit severely what constitutes infringement of that copyright. Effectively, if an industrial design is not registered, it can now be reverse engineered without infringement of copyright.

Third, Section 13B limits to 25 years the term within which the owner of copyright in an artistic work can rely on copyright to protect industrial exploitation by making articles that reproduce the artistic work.

Thus, copyright law in Malaysia has become a barren ground for design owners seeking protection of their designs, and registration of designs under the act is highly recommended and often essential to secure meaningful protection.

As for any overlap with trademark rights, at present Malaysian trademark law still takes a traditional and fairly conservative view of what constitutes a trademark. Trademark registrations for the shapes of goods are not widely sought, although this may change when the Trademarks Act 1976 is finally modernised and Malaysia accedes to the Madrid Protocol. [WTR](#)



Henry Goh & Co Sdn Bhd

217, Jalan Imbi, 55100 Kuala Lumpur
Malaysia

Tel +603 2118 8688

Fax +603 2118 8777

Web www.henrygoh.com



Dave A Wyatt

Executive director

dave@henrygoh.com

Dave A Wyatt is an executive director and head of the patent and industrial design department at Henry Goh. He is a UK chartered patent attorney, European patent attorney and registered Malaysian patent, industrial design and trademark agent.

He has lectured on patent practice and drafting for the Malaysian patent agent examinations. His comprehensive in-house training has led to the successful registration of 12 Malaysian patent agents within the firm.

He is a member of several IP and engineering professional organisations.