



LAWS OF MALAYSIA

Act 552

INDUSTRIAL DESIGNS ACT 1996

(Incorporated the changes made up to 1st July 2013)

PART I

PRELIMINARY

1. Short title, commencement and application
2. Extent of application
3. Interpretation

PART II

ADMINISTRATION

4. Registrar, Deputy Registrars and Assistant Registrars
5. Industrial Designs Registration Office
6. Register of Industrial Designs
7. Notice of trust
8. Inspection of Register
9. Certified copies to be evidence

PART III

REGISTRATION OF INDUSTRIAL DESIGN

10. Ownership of registered industrial designs
11. Right to apply and obtain registration

12. Registrable industrial design
13. Industrial design contrary to public order or morality
- 13A. Certain registrations not to be extended or restored
14. Application for registration
15. Multiple application
16. Filing date
17. Priority date and right of priority under treaty or convention
18. Withdrawal of application
19. Amendment of application
20. Division of application after amendment
21. Examination
22. Registration and publication
23. Registration of the same industrial design in respect of other articles
24. Rectification of Register

PART IV

PERIOD OF REGISTRATION

25. Period of registration
26. Restoration of lapsed registration
27. Revocation of registration and grant of compulsory licence
28. Order of Court

PART V

REGISTERED INDUSTRIAL DESIGN AS PERSONAL PROPERTY

29. Registered industrial design is personal property
30. Recording of assignment, *etc.*
31. Joint ownership

PART VI
INFRINGEMENT

- 32. Infringement of registered industrial design
- 33. Infringement proceedings
- 34. Defence in action for infringement
- 35. Remedies for infringement

PART VII
OFFENCES

- 36. Falsification of Register, *etc.*
- 37. False representation of registration
- 38. Use of title “Industrial Designs Registration Office”
- 39. Offences by body corporate

PART VIII
OTHER POWERS OF THE REGISTRAR

- 40. Amendment of registered industrial design
- 41. General powers of Registrar
- 42. Exercise of discretionary power
- 43. Extension of time

PART IX
MISCELLANEOUS

- 44. Service by post
- 45. Agent
- 46. Appeal
- 46A. Intellectual Property Official Journal
- 47. Regulations

- 48. Convention countries
- 49. Repeal and saving provisions
- 50. Transitional

LAWS OF MALAYSIA

Act 552

INDUSTRIAL DESIGNS ACT 1996

An Act to provide for the registration of industrial designs in Malaysia and for matters connected therewith.

[1 September 1999, P.U. (B) 304/1999]

BE IT ENACTED by the 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:

PART I

PRELIMINARY

Short title, commencement and application

1. (1) This Act may be cited as the Industrial Designs Act 1996 and shall come into force on such date as the Minister may, by notification in the *Gazette*, appoint.

(2) This Act shall apply throughout Malaysia.

Extent of application

2. This Act shall apply to applications for the registration of industrial designs made after the commencement of this Act and to registrations of industrial designs made on such applications.

Interpretation

3. (1) In this Act, unless the context otherwise requires—

“appointed date” has the same meaning as is assigned to that expression in the Intellectual Property Corporation of Malaysia Act 2002 [Act 617];

“article” means any article of manufacture or handicraft, and includes any part of such article or handicraft if that part is made and sold separately but does not include an integrated circuit or part of an integrated circuit within the meaning of the Layout-Designs of Integrated Circuits Act 2000 [Act 601], or a mask used to make such an integrated circuit;

“Assistant Registrar” means the person appointed or deemed to have been appointed to be an Assistant Registrar under subsection 4(2) or (3);

“author” means the person who creates a design;

“convention country” means a country in respect of which there is in force for the time being an order under section 48 declaring it to be a convention country for the purposes of this Act;

“Corporation” means the Intellectual Property Corporation of Malaysia established under the Intellectual Property Corporation of Malaysia Act 2002;

“Court” means the High Court or a judge thereof;

“Deputy Registrar” means the person appointed or deemed to have been appointed to be a Deputy Registrar under subsection 4(2) or (3);

“industrial design” means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged by the eye, but does not include—

(a) a method or principle of construction; or

(b) features of shape or configuration of an article which —

(i) are dictated solely by the function which the article has to perform; or

(ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part;

“legal personal representative”, in relation to a deceased person, means a person to whom probate of the will of the deceased person, letters of administration of the estate of the deceased person or other like grant, has been granted whether in Malaysia or elsewhere;

“Minister” means the Minister for the time being charged with the responsibility for intellectual property;

“Official Journal” means the Intellectual Property Official Journal published by the

Registrar under section 46A;

“owner” means the person who is registered as the owner of the registered industrial design or, if there are two or more such persons, each of those persons;

“original owner” has the meaning assigned to it by section 10;

“prescribed” means prescribed by or under this Act or any regulations made under this Act, and where no mode is mentioned, means prescribed from time to time by order published in the *Gazette*;

“Register” means the Register of Industrial Designs kept under this Act;

“registered” means registered under this Act;

“registered industrial design” means an industrial design registered under this Act;

“Registrar” means the Registrar of Industrial Designs as designated in subsection 4(1);

“representation”, in relation to an article to which an industrial design is applied, means a drawing, tracing or specimen of the article to which the industrial design is applied or a photograph of such drawing, tracing or specimen;

“set of articles” means a number of articles that are of the same general character and ordinarily on sale together, or intended to be used together, being articles to each of which there is applied an industrial design that is the same as, or which differs only in immaterial details or in features commonly used in the relevant trade from, the industrial design applied to the other articles or to any of them;

“statement of novelty”, in relation to an industrial design, means a statement relating to the representation of an article to which the industrial design is applied that indicates those features of the representation in respect of which novelty is claimed.

(2) A reference in this Act to an article shall be read as including a reference to—

- (a) a set of articles;
- (b) each article in a set of articles; and
- (c) both a set of articles and each article in that set, as the case requires.

PART II
ADMINISTRATION

Registrar, Deputy Registrars and Assistant Registrars

4.(1) The Director General of the Corporation shall be the Registrar of Industrial Designs.

(2) The Corporation may appoint, on such terms and conditions as it may determine, from amongst persons in the employment of the Corporation, such number of Deputy Registrars of Industrial Designs, Assistant Registrars of Industrial Designs and other officers as may be necessary for the proper administration of this Act, and may revoke the appointment of any person so appointed or deemed to have been so appointed under subsection (3).

(3) The persons holding office as Deputy Registrars, Assistant Registrars and other officers under this Act before the appointed date who were given an option by the Government of Malaysia to serve as employees of the Corporation and have so opted shall on the appointed date be deemed to have been appointed as Deputy Registrars, Assistant Registrars and such other officers under subsection (2).

(4) Subject to the general direction and control of the Registrar and to such conditions or restrictions as may be imposed by the Registrar, a Deputy Registrar or an Assistant Registrar may exercise any function of the Registrar under this Act, and anything by this Act appointed or authorized or required to be done or signed by the Registrar may be done or signed by any Deputy Registrar or Assistant Registrar and the act or signature of a Deputy Registrar or an Assistant Registrar shall be as valid and effectual as if done or signed by the Registrar.

(5) The Registrar shall have a seal of such device as may be approved by the Corporation and the impressions of such seal shall be judicially noticed and admitted in evidence.

Industrial Designs Registration Office

5.(1) An Industrial Designs Registration Office and such number of branch offices of the Industrial Designs Registration Office as may be necessary for the purposes of this Act shall be established.

(2) *(Deleted by Act A1140).*

(3) *(Deleted by Act A1140).*

(4) Any application or other document required or permitted to be filed at the Industrial Designs Registration Office may be filed at any branch office of the

Industrial Designs Registration Office and such application or other document shall be deemed to have been filed at the Industrial Designs Registration Office.

Register of Industrial Designs

6.(1) The Registrar shall keep and maintain a register called the Register of Industrial Designs.

(2) There shall be entered in the Register—

- (a) the names and addresses of owners of registered industrial designs;
- (b) notices of assignment and of transmissions of registered industrial designs; and
- (c) such other matters as may from time to time be prescribed or as the Registrar may think fit.

(3) The Register shall be kept in such form and on such material as may be prescribed.

Notice of trust

7. Notice of a trust whether express, implied or constructive shall not be entered in the Register or be accepted by the Registrar.

Inspection of Register

8.(1) The Register shall be open to the inspection of the public at such times and in accordance with such conditions as may be prescribed.

(2) A certified true copy or extract of any entry in the Register sealed with the seal of the Registrar shall be given to any person requiring the same on payment of the prescribed fee.

Certified copies to be evidence

9.(1) The Register shall constitute *prima facie* evidence of all matters required or authorized by this Act to be entered therein.

(2) The Registrar may supply a copy of or an extract from—

- (a) any entry or document in the Register; or

(b) a document or publication in the Industrial Designs Registration Office,

certified by writing under his hand and seal to be a true copy or extract.

(3) A copy or extract so certified and sealed shall be admissible in evidence as of equal validity with the original in all courts and proceedings without further proof or production of the original.

(4) The Registrar may certify, by writing under his hand and seal—

(a) that an entry, matter or thing required by or under this Act to be made or done, or not to be made or done, has, or has not, as the case may be, been made or done; or

(b) that a book, document or publication in the Industrial Designs Registration Office was made available for public inspection on the date specified in the certificate,

and such a certificate shall be received as *prima facie* evidence of the matters specified in the certificate in any legal proceedings.

PART III

REGISTRATION OF INDUSTRIAL DESIGN

Ownership of registered industrial designs

10.(1) Subject to this section, the author of an industrial design shall be treated for the purposes of this Act as the original owner of the industrial design.

(2) Where an industrial design is created in pursuance of a commission for money or money's worth, the person commissioning the industrial design shall, subject to any contrary agreement between the parties, be treated as the original owner of the industrial design.

(3) Where, in a case not falling within subsection (2), an industrial design is created by an employee in the course of his employment, his employer shall, subject to any contrary agreement between the parties, be treated as the original owner of the industrial design.

(4) The original owner of an industrial design or the assignee of any interest in an industrial design may assign in writing to another person the whole or any part of his interest in the industrial design.

(5) Where an industrial design, or the right to apply an industrial design to

any article, becomes vested, whether by assignment, transmission or operation of law, in any person other than the original owner, either alone or jointly with the original owner, that other person or, as the case may be, the original owner and that other person shall be treated for the purposes of section 11 as the original owner of the industrial design or as the original owner of the industrial design in relation to that article.

(6) In the case of an industrial design generated by computer in circumstances such that there is no human author, the person by whom the arrangements necessary for the creation of the industrial design are made shall be taken to be the author.

Right to apply and obtain registration

11.(1) The original owner of an industrial design is entitled to make an application for the registration of the industrial design.

(2) Where two or more persons own interests in an industrial design, all of the persons owning such interests, acting jointly, are, subject to any agreement among such persons to the contrary, entitled to make an application for the registration of the industrial design.

Registrable industrial design

12.(1) Subject to this Act, an industrial design shall not be registered unless it is new.

(2) An industrial design for which an application for registration is made shall not be considered to be new if, before the priority date of that application, it or an industrial design differing from it only in immaterial details or in features commonly used in the relevant trade—

(a) was disclosed to the public anywhere in Malaysia or elsewhere; or

(b) was the subject matter of another application for registration of an industrial design filed in Malaysia but having an earlier priority date made by a different applicant in so far as that subject matter was included in a registration granted on the basis of that other application.

(3) For the purposes of paragraph (2)(a), an industrial design shall not be deemed to have been disclosed to the public solely by reason of the fact that, within the period of six months preceding the filing date of an application for registration—

(a) it appeared in an official or officially recognized exhibition; or

(b) it has been disclosed by a person other than the applicant or his predecessor in title as a result of an unlawful act committed by that other person or another person.

Industrial design contrary to public order or morality

13. Industrial designs that are contrary to public order or morality shall not be registrable.

Certain registrations not to be extended or restored

13A. Notwithstanding any other provision of this Act, where before the commencement of the Layout-Designs of Integrated Circuits Act 2000 an industrial design applicable to an integrated circuit or part of an integrated circuit within the meaning of that Act or an industrial design applicable to a mask used to make such an integrated circuit was registered under this Act, that registration shall not be extended or restored at any time on or after that commencement.

Application for registration

14. (1) An application for the registration of an industrial design—

- (a) shall be made in the prescribed form and shall be filed at the Industrial Designs Registration Office;
- (b) shall be accompanied by the prescribed number of representations of the article to which the industrial design is applied;
- (c) shall contain a statement of novelty in respect of the industrial design to which the application relates; and
- (d) shall be accompanied by the prescribed filing fee.

(2) Where the applicant's ordinary residence or principal place of business is outside Malaysia, he shall appoint an agent in Malaysia upon whom notice or process relating to the application for registration of an industrial design may be served, and if the applicant fails to appoint an agent, the Registrar may refuse to proceed with the application until such agent has been appointed.

Multiple application

15. Two or more industrial designs may be the subject of the same application,

provided they relate to the same class of the International Classification for Industrial Designs or to the same set or composition of articles.

Filing date

16. The filing date of an application for the registration of an industrial design shall be the earliest date on which all of the following conditions are satisfied in relation to the application:

- (a) the documents mentioned in section 14 identify the applicant or applicants;
- (b) the prescribed number of representations of the article to which the industrial design is applied is filed at the Industrial Designs Registration Office; and
- (c) the prescribed filing fee is paid.

Priority date and right of priority under treaty or convention

17. (1) Subject to this section, the priority date of an application for the registration of an industrial design is the filing date of the application.

(2) An application may, pursuant to any international treaty or convention to which Malaysia is party, contain a declaration claiming the priority of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in or for any state party to the said treaty or convention; and in any such case, the priority date shall be the earliest date on which such earlier national, regional or international applications were filed:

Provided that the application made under this Act has been filed within six months from such earliest date.

(3) Where the application contains a declaration under subsection (2), the Registrar may require the applicant to furnish, within the prescribed time, a copy of the earlier application certified as correct by the office with which it was filed.

(4) The effect of the declaration referred to in subsection (2) shall be as provided in the treaty or convention referred to in that subsection.

(5) Where any of the requirements of this section or any regulations pertaining thereto have not been complied with, the declaration referred to in subsection (2) shall be deemed to be invalid.

Withdrawal of application

18. The applicant for registration of an industrial design may, by notice in writing to the Registrar, withdraw the application at any time during its pendency, and any such withdrawal shall be irrevocable.

Amendment of application

19. (1) The Registrar may, on request to him in the prescribed manner, amend an application for the registration of an industrial design.

(2) An amendment under subsection (1) shall not be made if, as a result of the amendment, the scope of the application would be increased by the inclusion of any matter that was not in substance disclosed in the application initially filed.

Division of application after amendment

20. (1) Where a request for amendment under section 19 has been granted, and the amendment has the effect of excluding one or more industrial designs from the initial application, the applicant may at any time during the pendency of the initial application make a further application, referred to in this section as a “divisional application”, for registration of the industrial design or designs so excluded.

(2) A divisional application shall be entitled to the priority date of the initial application.

Examination

21. (1) Where an application for the registration of an industrial design has been accorded a filing date and the application is not withdrawn, the Registrar shall cause the application to be examined to determine whether it complies with the formal requirements.

(2) Where, as a result of the examination, it is determined that the application does not meet the formal requirements the Registrar shall notify the applicant and give him an opportunity to make observations on such finding and to amend the application within a specified period so as to comply with those requirements.

(3) If, within the specified period, the applicant fails to satisfy the Registrar that the formal requirements have been complied with, or to amend the application so as to comply with them, the Registrar may refuse to register the industrial design.

(4) The Registrar shall not refuse to register an industrial design under

subsection (3) until the applicant has been given an opportunity to be heard.

(5) In this section, “formal requirements” means the requirements of this Act and of any regulations made under this Act which are designated by such regulations as formal requirements for the purposes of this Act.

Registration and publication

22. (1) Where the Registrar is satisfied that an application for the registration of an industrial design complies with the requirements of section 21, he shall—

- (a) register the industrial design by recording the prescribed particulars in the Register; and
- (b) issue to the applicant a certificate of registration of the industrial design in the prescribed form.

(2) As soon as possible thereafter, the Registrar shall cause to be published in the Official Journal—

- (a) a notice that the industrial design has been registered; (b) the name and address of the registered owner; and
- (c) any other matters constituting or relating to the industrial design which in his opinion it is desirable to publish.

(3) The certificate of registration shall be *prima facie* evidence of the facts stated therein and of the validity of the registration.

Registration of the same industrial design in respect of other articles

23. (1) Where an industrial design has been registered in respect of any article and the owner thereof makes an application—

- (a) for registration, in respect of one or more other articles, of the registered industrial design; or
- (b) for registration, in respect of the same or one or more other articles, of an industrial design consisting of the registered industrial design with modifications or variations not sufficient to alter the character or substantially to affect the identify thereof,

the application shall not be refused, and the registration made on that application shall not be invalidated by reason only of the previous registration, or of any

disclosure or use after the priority date in respect of the application for the previous registration, of the industrial design registered on that application.

(2) The period of registration of an industrial design registered by virtue of this section shall not extend beyond the period of registration of the original registered industrial design and any extended period thereof.

Rectification of Register

24. (1) Subject to the provisions of this Act—

- (a) the Court may, on the application in the prescribed manner, of any person aggrieved by or interested in the non-inclusion in or omission from the Register of any entry, or by or in any entry made in the Register without sufficient cause, or any entry wrongfully remaining in the Register, or any error or defect in any entry in the Register, make such order for including, making, expunging or varying any such entry or for the correcting of any such error or defect as it deems fit;
- (b) the Court may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the Register;
- (c) in case of fraud in the registration, assignment or transmission of a registered industrial design or if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;
- (d) an order of the Court rectifying the Register shall direct that notice of the order be served on the Registrar in the prescribed manner and the Registrar shall upon receipt of the notice rectify the Register accordingly.

(2) Notwithstanding subsection (1), the Court shall not make any order on the application of a person other than the Registrar until notice of such application has been given to the Registrar who shall be entitled to appear and be heard on the application.

(3) Any application for the rectification of the Register, which under subsection (1) is to be made to the Court and where the applicant is other than the Registrar himself, may, at the option of the applicant, be made in the first instance to the Registrar except where an action concerning the industrial design in question is pending.

(4) The Registrar may at any stage of any application for rectification of the Register made to him refer any such application to the Court, or he may, after hearing the applicant in any such application and the owner as well where the applicant is a person other than the owner of the registered industrial design, determine the question between them.

PART IV

PERIOD OF REGISTRATION

Period of registration

25. (1) The registration of an industrial design shall be deemed to have come into force on the filing date of the application for the registration of the industrial design and shall subsist for five years thereafter.

(2) The period of registration of an industrial design may be extended for four further consecutive terms of five years each, if an application for extension is made in the prescribed form, and the prescribed extension fee is paid before the expiration of the current term.

(3) A period of grace of six months from the date on which any unpaid extension fee was due shall be granted for the payment of such extension fee, subject to the payment of such surcharge as may be prescribed.

(4) Where an application for extension is not made or an extension fee is not paid in accordance with this section, the registration shall lapse, and a notice of lapse of the registration shall be published in the Official Journal.

Restoration of lapsed registration

26. (1) Within one year from the date on which the notice of lapse of the registration of an industrial design was published in the Official Journal, the owner or his successor-in-title may apply for the restoration of the registration of the industrial design by—

- (a) filing a request for restoration in the prescribed form;
- (b) payment of any outstanding extension fee and a prescribed surcharge for restoration; and
- (c) filing a statement setting out the circumstances that led to the failure to extend the registration of the industrial design.

(2) Where the Registrar is satisfied that the failure to extend the registration was due to an accident or mistake, he may publish in the Official Journal a notice of intention to restore the lapsed registration.

(3) Any interested person may, within three months from the date of such publication, give notice to the Registrar of opposition to the restoration of the registration and shall serve a copy of the notice on the applicant for restoration.

(4) Where no notice of opposition is given in accordance with subsection (3) within the period of three months following the date of the publication referred to in subsection (2), the Registrar shall restore the registration of the industrial design, which shall have effect as if that registration had not lapsed, and he shall publish a notice in the Official Journal that the registration has been so restored.

(5) Where a notice of opposition is given in accordance with subsection (3), the Registrar shall, after giving the opponent and the applicant for restoration an opportunity to be heard, decide the matter, and where he decides to restore the registration, the registration shall have effect as if it had not lapsed, and he shall publish a notice in the Official Journal that the registration has been so restored.

(6) Actions or proceedings shall not be taken in respect of an infringement of the registered industrial design committed between the date on which the registration of the industrial design ceased to be in force and the date of the publication in the Official Journal of the restoration of the industrial design.

(7) Any person aggrieved by the Registrar's decision on the grant or refusal of restoration under this section may appeal to the Court.

Revocation of registration and grant of compulsory licence

27. (1) At any time after the registration of an industrial design, any person may apply to the Court—

- (a) for the revocation of the registration of the industrial design on the ground, subject to section 12, that the industrial design has been disclosed to the public prior to the priority date of the application for registration of the industrial design;
- (b) for the cancellation of the registration of the industrial design on the ground that the registration of the industrial design has been procured by unlawful means; or
- (c) for the grant of a compulsory licence in respect of the industrial design on the ground that the industrial design is not applied in Malaysia by any industrial process or means to the article in respect of

which it is registered to such an extent as is reasonable in the circumstances of the case,

and the Court may make such order on the application as it considers just.

(2) Paragraphs (1)(a) and (1)(b) shall be without prejudice to the right of the owner of an industrial design to request the Registrar for the revocation of a registered industrial design of which he is owner, or to the power of the Registrar to order the revocation of the registration of an industrial design on any other ground as he thinks fit.

Order of Court

28. No order which is inconsistent with any treaty, convention, arrangement or engagement with any country outside Malaysia shall be made by the Court under section 27.

PART V

REGISTERED INDUSTRIAL DESIGN AS PERSONAL PROPERTY

Registered industrial design is personal property

29. (1) A registered industrial design is personal property and is capable of assignment, transmission or being dealt with by operation of law in the same way as other personal or moveable property, subject to the provisions of this section.

(2) Any transmission of a registered industrial design or an application for the registration of an industrial design is subject to any rights vested in any other person of which notice is entered in the Register or of which notice is given to the Registrar.

(3) An assignment of a registered industrial design or an application for the registration of an industrial design shall not be effective unless it is in writing and signed by or on behalf of the assignor and the assignee or, as the case may be, a personal representative thereof.

(4) Subsection (3) shall apply to assignment by way of security as in relation to any other assignment.

(5) A registered industrial design may be the subject of a security interest in the same way as other personal or moveable property.

(6) The owner of a registered industrial design may grant a licence to any person

to use that registered industrial design.

(7) Any rights in respect of a registered industrial design may be enforced in like manner as in respect of any other personal or moveable property.

Recording of assignment, etc.

30. (1) Where a person becomes entitled to –

- (a) a registered industrial design by way of an assignment or transmission or by operation of law or by a security interest transaction; or
- (b) an application for the registration of an industrial design by way of assignment or transmission,

he shall apply to the Registrar in the prescribed manner to record his title or interest in the Register.

(2) The Registrar shall record the particulars of the title or interest referred to in subsection (1) in the Register.

(3) No assignment or transmission or operation of law or security interest transaction in respect of a registered industrial design shall have effect against third parties unless recorded in the Register.

Joint ownership

31. (1) Where an industrial design is registered in favour of two or more persons, each of them shall, subject to any agreement between them to the contrary, be entitled to an equal undivided share in the registered industrial design.

(2) Where two or more persons are joint owners of a registered industrial design, then, subject to this section and to any agreement between them to the contrary—

- (a) each of them shall be entitled, by himself or through his agents, to do any act, for his own benefit and without the consent of or the need to account to the other or others, which would apart from this subsection amount to an infringement of the registered industrial design; and

- (b) any such act shall not amount to an infringement of the registered industrial design.

(3) Where two or more persons are joint owners of a registered industrial

design, then, subject to any agreement between them to the contrary, none of them shall without the consent of the other or others grant a licence with respect to the use of the registered industrial design, or assign or mortgage his interest in the registered industrial design.

(4) The provisions of this section shall have effect in relation to a right to apply for the registration of an industrial design as they have effect in relation to a registered industrial design, and references to a registered industrial design shall include references to a right to apply for the registration of an industrial design.

PART VI

INFRINGEMENT

Infringement of registered industrial design

32. (1) Subject to the provisions of this Act, the owner of a registered industrial design shall have the exclusive right to make or import for sale or hire, or for use for the purposes of any trade or business, or to sell, hire or to offer or expose for sale or hire, any article to which the registered industrial design has been applied.

(2) Subject to section 30, a person infringes the rights conferred by the registration of an industrial design if he, without the licence or consent of the owner of the industrial design, does any of the following things while the registration is still in force:

- (a) applies the industrial design or any fraudulent or obvious imitation of it to any article in respect of which the industrial design is registered;
- (b) imports into Malaysia for sale, or for use for the purposes of any trade or business, any article to which the industrial design or any fraudulent or obvious imitation of it has been applied outside Malaysia without the licence or consent of the owner; or
- (c) sells, or offers or keeps for sale, or hires, or offers or keeps for hire, any of the articles described in paragraphs (a) and (b).

(3) Notwithstanding subsection (1), the right of the owner of a registered industrial design shall not extend to acts in respect of an article to which the registered industrial design is applied by or with the consent of the owner after the article has been lawfully imported into or sold in Malaysia.

Infringement proceedings

33. (1) The owner of a registered industrial design shall have the right to institute legal proceedings against any person who has infringed or is infringing any of the rights conferred by the registration of the industrial design.

(2) The owner of a registered industrial design shall have the same right against any person who has performed acts which make it likely that an infringement will occur.

(3) The proceedings mentioned in subsections (1) and (2) may not be instituted after five years from the act of infringement.

(4) For the purposes of this section, “owner of a registered industrial design” means the registered owner and includes an assignee, a licensee or the beneficiary of a compulsory licence granted under section 27; but if any proceedings are instituted by a person other than the registered owner, it must be proved that that person had made a prior request to the registered owner to institute proceedings for the infringement complained of by him and that the registered owner had refused or failed to institute the proceedings within three months from the receipt of the request, without prejudice however to the registered owner’s right to join in such proceedings.

Defence in action for infringement

34. Any ground on which the registration of an industrial design may be revoked is available as a defence in an action for infringement of a registered industrial design.

Remedies for infringement

35. (1) If the owner of a registered industrial design proves that an infringement has been committed or is being committed, the Court may award damages or an account of profits and may grant an injunction to prevent further infringement and any other legal remedies.

(2) If the owner of a registered industrial design proves that acts are being performed which make it likely that an infringement will occur, that Court may grant an injunction to prevent infringement and any other legal remedies.

(3) The Court may refuse to award damages, or to make an order for an account of profits, in respect of an infringement, if the defendant satisfies the Court—

(a) that, at the time of the infringement, he was not aware that the industrial design was registered; and

(b) that he had, prior to that time, taken all reasonable steps to ascertain whether the industrial design had been registered.

(4) The Court shall refuse to award costs to the owner of a registered design who becomes entitled to the registered industrial by way of assignment or transmission or by operation of law or by a security interest transaction in respect of an infringement unless –

(a) an application to record his title or interest is made under section 30 before the end of the period of six months beginning from the date of the relevant transaction; or

(b) the Court is satisfied that it was not practicable for the said application to be made before the end of that period and that an application was made as soon as practicable thereafter.

PART VII

OFFENCES

Falsification of Register, etc.

36. Any person who—

(a) makes or causes to be made a false entry in the Register;

(b) makes or causes to be made a false entry in any certified copy of a document or publication in the Industrial Designs Registration Office;

(c) makes or causes to be made a false document purporting to be a copy of an entry in the Register;

(d) produces or tenders or causes to be produced or tendered in evidence any document mentioned in paragraph (b) or (c) knowing such document or any entry therein to be false; or

(e) falsely makes a claim that he is the owner of the registered industrial design or represents that he is acting in the capacity of, or on behalf of the owner of the registered industrial design,

shall be guilty of 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.

False representation of registration

37. (1) Any person who falsely represents that anything disposed of by him for value is an article protected by an industrial design registration commits an offence and shall be liable on conviction to a fine not exceeding fifteen thousand ringgit or to imprisonment for a term not exceeding two years or to both.

(2) For the purposes of subsection (1), a person who for value disposes of any article having stamped, engraved or impressed thereon or otherwise applied thereto the words “registered industrial design” or any other word or words expressing or implying that the article is one to which a registered industrial design has been applied, shall be taken to represent that the article is one protected by an industrial design registration.

(3) Subsection (1) does not apply where the representation is made in respect of an industrial design after the registration in respect of that industrial design has expired or been revoked and before the end of a period which is reasonably sufficient to enable that person to take steps to ensure that the representation is not made or does not continue to be made.

(4) In proceedings for an offence under this section, it shall be a defence for any person to prove that he used due diligence to prevent the commission of the offence.

(5) This section shall have effect in relation to a right to apply for the registration of an industrial design as they have effect in relation to a registered industrial design, and references to a registered industrial design shall include references to a right to apply for the registration of an industrial design.

Use of title “Industrial Designs Registration Office”

38. Any person who uses on his place of business or any document issued by him or otherwise the words “Industrial Designs Registration Office” or any other words suggesting that his place of business is, or is officially connected with, the Industrial Designs Registration Office 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.

Offences by body corporate

39. (1) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of a director, manager, secretary or other similar officer of the body corporate, or any person who was

purporting to act in any such capacity, he, as well as the body corporate, shall be guilty of that offence and shall be liable to be prosecuted against and punished accordingly as provided by this Act.

(2) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

PART VIII

OTHER POWERS OF THE REGISTRAR

Amendment of registered industrial design

40. (1) The owner of a registered industrial design may, in accordance with regulations prescribed by the Minister, request the Registrar to amend a registered industrial design or any document associated therewith for the purpose of correcting a clerical error, obvious mistake or for any other reason acceptable to the Registrar.

(2) The request for amendment shall be accompanied by the prescribed fee.

(3) Except for the purpose of correcting a clerical error or an obvious mistake, no amendment shall be permitted under this section if the amendment would have the effect of disclosing matters which extend beyond that disclosed before the amendment, or extending the protection conferred at the time of registration of the industrial design in question.

(4) No amendment shall be allowed to be made in the registration of an industrial design under this section where there are pending before the court proceedings in which the validity of the registration of the industrial design may be put in issue.

(5) Where the Register has been amended under this section, the Registrar may require the certificate of registration to be submitted to him and may cancel the certificate of registration and issue a new certificate of registration with such consequential amendments as are rendered necessary by the amendment of the Register.

General powers of Registrar

41. (1) The Registrar may generally for the purposes of this Act—

- (a) summon witnesses;
- (b) receive evidence on oath;
- (c) require the production of any document or article; and
- (d) award costs as against a party to any proceedings before him.

(2) Any person who without any lawful excuse fails to comply with any summons, order or direction made by the Registrar under paragraph (1)(a), (1)(b) or (1)(c) commits an offence and is liable on conviction to a fine not exceeding two thousand ringgit or to imprisonment for a term not exceeding six months or to both.

(3) Costs awarded by the Registrar may in default of payment be recovered in a court of competent jurisdiction by the person to whom the costs were awarded.

Exercise of discretionary power

42. Where any discretionary power is given to the Registrar by this Act or any regulations made under this Act, he shall not exercise the power on any person who may be adversely affected by his decision without giving to the person an opportunity of being heard.

Extension of time

43. Subject to subsection 17(2) and section 50, where by this Act or any regulations made under this Act, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly directed by the Court, extend the time either before or after its expiration, upon payment of the prescribed fee.

PART IX

MISCELLANEOUS

Service by post

44. Any notice required or authorized to be given under this Act or regulations made under this Act, and any application or other document so required or authorized to be made or filed, may be given, made or filed by post.

Agent

45. (1) Where by this Act or any regulations made under this Act any act has to be done by or to any person in connection with an industrial design or any procedure relating thereto, the act may, under and in accordance with this Act and any regulations made under this Act or in particular cases by special leave of the Registrar, be done by or to an agent of that person duly authorize in the prescribed manner.

(2) The Registrar shall not be bound to recognize such agent who has been convicted of crimes involving fraud or dishonesty, or is an undischarged bankrupt or had been struck off or otherwise removed from the register of membership of any professional body, or suspended for the time being from practising by any such body or committee thereof.

Appeal

46. (1) Any person aggrieved by any decision or order of the Registrar may appeal to the Court.

(2) The same rules of procedure on appeal shall apply to appeals made under subsection (1) as to appeals to the High Court from a decision of a subordinate court in civil matters.

Intellectual Property Official Journal

46A. (1) The Registrar shall publish an Intellectual Property Official Journal which shall contain-

(a) all matters relating to industrial designs which is required to be published under this Act or any regulations made under this Act; and

(b) such other information or matters relating to industrial designs as the Registrar considers generally useful or important.

(2) The Official Journal shall be made available to the public on payment of the prescribed fee.

(3) Publication in the Official Journal shall constitute sufficient notice of any matter required to be published under this Act or any regulations made under this Act.

(4) A copy of the Official Journal shall on its production be admitted in legal proceedings as evidence without further proof being given that the copy was so published.

(5) A copy of the Official Journal shall be *prima facie* evidence of the facts stated

therein.

(6) Where the Official Journal is published in more than one form, the date of publication of the Official Journal shall be deemed to be the date the Official Journal is first published in any form.

Regulations

47. (1) Subject to the provisions of this Act, the Minister may make regulations for the purpose of carrying into effect the provisions of this Act.

(2) In particular and without prejudice to the generality of subsection (1), regulations made under this section may provide for all or any of the following:

- (a) to regulate the procedure to be followed in connection with any proceeding or other matter before the Registrar or the Industrial Designs Registration Office under this Act including the service of documents;
- (b) to classify articles for the purpose of registration of industrial designs;
- (c) to make or require duplication of documents connected with the registration of industrial designs;
 - (ca) to regulate the procedure for the recording of the matters required under section 30;
 - (cb) to prescribe any matters or information required to be published in the Official Journal;
- (d) to prescribe fees to be paid in connection with any proceeding or other matter or in connection with the provision of any service by the Registrar or the Industrial Designs Registration Office, and to prescribe the amount of such fees and to allow different fees in certain circumstances for certain prescribed cases;
- (e) to prescribe forms and other matters to be used under this Act;
- (f) to regulate the keeping of the Register and to prescribe the form and contents thereof;
- (g) to regulate the mode of giving evidence in any proceeding before the Registrar under this Act and to empower the Registrar to compel the attendance of witnesses and the discovery and production of

documents;

- (h) for doing anything required to be done in connection with any proceeding or other matter before the Registrar or the Industrial Designs Registration Office;
- (i) to govern the recognition of agents representing applicants or other parties before the Registrar or the Industrial Designs Registration Office, and to prescribe qualifications and other conditions to be satisfied by such agents before being permitted to appear before the Registrar or the Industrial Designs Registration Office, and to otherwise regulate their conduct as such agents;
- (j) to prescribe time limits; and
- (k) to regulate generally matters pertaining to the business of the registration of industrial designs carried on in the Industrial Designs Registration Office whether or not specially prescribed under this Act.

Convention countries

48. (1) The Minister may, by order published in the *Gazette* with a view to the fulfilment of a treaty, convention, arrangement or engagement between Malaysia and another country, declare that a country specified in the order is a convention country for the purposes of this Act.

(2) Where the Minister, by order declares that an application for protection in respect of an industrial design is, in accordance with the terms of a treaty subsisting between two or more convention countries, equivalent to an application made in one of those convention countries, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that convention country.

(3) Where the Minister, by order, declares that an application for protection in respect of an industrial design is, in accordance with the law of a convention country, equivalent to an application made in that convention country, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that convention country.

Repeal and saving provisions

49. (1) The United Kingdom Designs (Protection) Act 1949 [Act 214], the United Kingdom Designs (Protection) Ordinance of Sabah [*Sabah Ord. Cap. 152*], and the Designs (United Kingdom) Ordinance of Sarawak

[*Sarawak Ord. Cap. 59*] (hereinafter collectively referred to as the “repealed laws”) are repealed.

(2) Notwithstanding subsection (1)—

- (a) any subsidiary legislation made under the repealed laws shall in so far as such subsidiary legislation is not inconsistent with the provisions of this Act continue in force and have effect as if it had been made under this Act and may be repealed, extended, varied or amended accordingly;
- (b) any appointment made under the repealed laws or subsidiary legislation made under the repealed laws shall continue in force and have effect as if it had been made under this Act unless the Minister otherwise directs;
- (c) any registration protected under the repealed laws and in force immediately prior to the coming into force of this Act shall, subject to the terms, conditions and the period of validity specified in the registration, continue in force and have the like effect as if it had been effected under this Act, but any extension thereafter shall be in accordance with subsection 50(2).

Transitional

50. (1) Where, prior to the coming into force of this Act, an application for registration of an industrial design has been made under the Registered Design Act 1949 of the United Kingdom [*12, 13 & 14 Geo VI (U.K. 1949) c. 88*] as amended by the Copyright, Designs and Patents Act 1988 of the United Kingdom [(*U.K. 1988*) c. 48] and is pending registration, the applicant may, within a period of twelve months from the coming into force of this Act, make an application for the registration of the industrial design under this Act, and such application shall be accorded the priority date which has been accorded to it in the United Kingdom.

(2) A certificate of registration granted under the Registered Designs Act 1949 of the United Kingdom shall have the maximum period of validity accorded under the repealed laws and for this purpose, the extension procedure shall be as prescribed in the regulations made under section 47 of this Act.

DISCLAIMER: Although MyIPO makes every effort to provide accurate, complete and up-to-date information, MyIPO does not invite reliance upon, nor accept responsibility for, the information it provides. Confirmation from another source should be made if it is of sufficient importance for user to do so.