

# INDUSTRIAL DESIGN PROTECTION IN MALAYSIA

## Introduction

The Malaysian Industrial Design Act 1996 (IDA96) has come into force on the 1<sup>st</sup> September 1999. By the coming into force of this Act, the previous three statutes, namely (1) *the United Kingdom Designs (Protection) Act 1949*; (2) *the United Designs (Protection) Ordinance of Sabah*, and (3) *the Designs (United Kingdom) Ordinance of Sarawak* are repealed.

The implementation of the IDA'96 is aimed at reducing the cost involved in registering industrial designs, which are previously done in the UK. The new act aims to encourage local industrial designers to design products which are innovative, sophisticated and functionally appropriate to compete in the World Market.

## What is an Industrial Design

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.

To be registrable, an industrial design must comply with the formal requirements as laid down in the Industrial Design Act 1996 and the Industrial Design Regulations 1999. In addition, the design for which the registration is sought for must also be new in Malaysia and not contrary to public order or morality.

## Examination

Where an application for the registration of an industrial design is filed, a filing date and number will be accorded. The application will then be examined by the Registrar to determine whether it complies with the formal requirements as set down in the regulations 3 to 14 of Industrial Design Regulation 1999. Should the application fulfill the requirements, the Registrar will accept the application to be registered. A certificate of registration will be issued and a notice will be published in the *Malaysian Government Gazette*.

## Period of Registration

Registration of a design is valid for a period of an initial 5 years from the date of filing and may be extended for two further consecutive terms of five years each by paying the prescribed extension fee.

## **Rights Conferred**

Section 32(1) of IDA'96 lays down that the owner of a registered industrial design should have the **exclusive right** to make or import for sale or hire, or for use for the purpose 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.

## **Remedies for Infringement**

Section 35 of IDA96 states that on the registered industrial design proving infringement, the court may award damages or an account of profits and may grant an injunction to prevent further infringement and any other legal remedies.

Please note that there is no criminal sanction for registered design infringement. All action for infringement of a registered design is brought in the High Court of Malaysia.

## **Significant Changes**

Before the amendment to the Copyright Act 1987, an industrial design owner may still rely on Copyright for protection. With the implementation of the Copyright (Amendment) Act 1996 and the IDA96, there will be no dual protection after 1<sup>st</sup> September 1999.

There will be no copyright protection for any design which is registered and also for any design which is capable of being registered but is not actually registered as soon as any article to which the design has been applied, has been reproduced more than fifty times by the copyright owner or with his permission.

Consequently, a registrable design must be registered in order to obtain protection for his intellectual property.

