



Protecting Your Design in Malaysia: Rights, Registration and Renewal

The fashion industry is one which is constantly evolving – creating new styles and trends that are imposed worldwide. Every year there are new designs and collections which are introduced in the fashion world to attract people in every stage in life, to look attractive and stay ahead in the realm of style and glamour. It is therefore imperative for every business owner to secure exclusive rights to their designs, and if you are one in Malaysia, you may wish to protect your product designs by obtaining registration under the Industrial Designs Act 1996 (the “Act”), which governs the registered designs regime in Malaysia. Designs that are intended to be of industrial application (i.e., commercially mass-produced) must be registered under the Act to be afforded legal protection. However, not every commercially mass-produced design is registrable. The Act necessitates the requirements for a registrable design, as follows:

- *the design must adhere to the meaning of “industrial design” in Section 3 of the Act;*
- *the design must be new at the date of application for registration, as required by Section 12(2) of the Act, and;*
- *the design must not be contrary to public order or morality, as required in Section 13 of the Act.*

Industrial Design and its Registrability

Section 3(1) of the Act, defines “industrial design” as follows:

“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;”*

An industrial design contemplates four features viz. shape, configuration, pattern, or ornament, which may qualify for registration under the Act.

“Pattern” and “ornament” usually connote two-dimensional features which are generally put on articles for decorative purposes rather than usefulness, whereas “shape” and “configurations” are more likely to possess three-dimensional features, which more often than not is the article itself. In the case of *Kestos v Kempat, Luxmoore J*, as he then was, pointed out that “shape” and “configuration” have for all practical purposes been considered as synonymous while “pattern” and “ornaments’ are synonymous. In view of this, an industrial design can be two-dimensional and/or three-dimensional.

It must be noted that the novelty of the design is the element that determines the ambit of the registration and the exclusive rights that is granted to the owner. This requirement is further laid down in Section 14(1)(c) of the Act which should be read together with Regulation 12(1) of the Industrial Designs Regulation 1999 (the “Regulation”) – which stipulates that all applications in respect of textile articles, wallpaper or similar wall covering must contain a Statement of Novelty in respect of the industrial design to which the application relates. Therefore, although the design falls within the definition of “industrial design” as stated in Section 3 of the Act,



it is still necessary that the design must be new, before it can be registered under the Act as required in Regulation 12(1).

The first two requirements for the registrability of a design connote a positive aspect. However, the third requirement, that is, the design is not to be in contrary to public order or morality, takes on a negative aspect. This is because the requirement dictates what the design should not possess in order to be registrable. It must be noted that this requirement has a subjective element to it, as the Registrar owns the discretion on whether a particular factual situation falls within Section 13 of the Act.

The Distinction Between Industrial Designs and Copyright

The intrinsic overlap between the laws governing industrial designs and copyright is that, more often than not, designs are first produced in the form of drawings – and “drawings”, according to the Copyright Act 1987 (the “Copyright Act”), fall within the ambit of “artistic works” irrespective of their quality.

Prima facie, given that a design may also be considered as an artistic work, there appears to be an overlap between the copyright and industrial design regimes. However, pursuant to Section 7(5) of the Copyright Act, any design which is registered under any written law relating to industrial design shall not enjoy copyright protection.

In view of this, if an *artistic work* is eligible for registration as an industrial design under the Act, registration should be sought under the Industrial Designs Act 1996 to obtain ownership rights to the design.

Why Register Your Industrial Design?

The justifications for having any assets protected apply equally to having your industrial design protected. The art of designing is a skill, and especially in the fashion world, the process demands the expenditure of a considerable amount of time, labour and cost. The design of an article is a preliminary factor, among many others, which gives it a competitive edge over other articles in trade. Given the competitive fashion market, it is in your best interest that the subtle acts of competitors copying your design and enjoying the benefits of your creative efforts and investments be prevented.

It must also be noted that as an owner of a registered industrial design, you will possess the exclusive rights to your industrial design including but not limited to the manufacturing, producing, importing, and selling any article to which the design has been applied.

Who Owns the Rights in Registered Designs?

The ownership of an industrial design recites on 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*” – as provided in Section 3(1) of the Act. This means that the industrial design can be created or designed by one person, but it may be owned by the person whose name is registered as the owner in the Register.

This is usually the case in an employer-employee situation - where the industrial design is designed by an employee (who will be recorded as the author), but the exclusive rights to the industrial design is owned by the employer (who will be recorded as the owner). Accordingly, and pursuant to Section 10(2) of the Act, where an industrial design is created in pursuance of a commission for money or money’s worth, the person commissioning the industrial design is the original owner of an industrial design.

Industrial Design Application & Registration Process in Malaysia

The application and registration process for industrial designs are governed by Section 14 of the Act and supplemented by Regulations 3 to 14 of the Regulations.



Upon fulfilling the criteria laid down in the Act for the registrability of an industrial design, an application in the prescribed form (*Form ID1*) accompanied by the filing fee should be submitted to the Industrial Designs Registration Office. A representation (as defined in Section 3(1) of the Act) of the article and a Statement of Novelty must be submitted along with the application form. All requisite documents and the representation of the article must be submitted on the filing date of the application along with the payment of the filing fee.

The Regulations cover matters such as the requirement for the payment of fees, the appropriate forms to be used, the language of the application, the indication of class and subclass in accordance with the International Classification for Industrial Designs, the required details of the applicant, the Statement of Novelty and its exceptions laid down in Regulation 12, priority claims, the appointment of a local representative, the size of your document and the numbering of your industrial design.

Once the application and filing fee is received by the Registry, an official payment receipt will be issued for records. The application will then undergo a formality examination (including a novelty search) by an appointed examiner. As provided in Section 22 of the Act – an industrial design shall be registered as long as it meets the formal requirements laid down in the Act and the Regulations. In view of this and unlike trademark and patent applications, the examiner for industrial designs will only ensure that all formalities for the registrability of the industrial design is complied with, and no further substantive examination will take place.

Should there be any deficiencies in the application submitted, the examiner will then issue a written notice to the applicant or their representative to clarify and/or amend the deficiencies within 3 months of the issuance of the written notice. If the deficiency(s) are settled, the Registry will then issue a Certificate of Registration, evidencing the facts in it and of the validity of the registration.

Duration of Protection & Post Registration

Once your industrial design is registered, the registration is deemed to have come into force on the filing date of the application for registration. Pursuant to Section 25(1) of the Act, an industrial design is afforded legal protection for five years from the date of filing the application. Additionally, the term of protection may be extended for four consecutive terms of five years each, provided that an application for an extension of the period of registration and payment of the extension fees is filed and paid with the Registry, as stated in Section 25(2) of the Act. Accordingly, the maximum duration of protection afforded for a registered industrial design is 25 years from the date of filing.

In the event an application by virtue of the prescribed form and requisite fees for extension of the period of registration is not submitted within the stipulated deadline, Section 25(3) of the Act provides a 6-months' grace period from the date on which the unpaid extension fees was due for the owner of the industrial design to make the requisite payment (with surcharges applicable). If an application for extension is not made or the fees is not paid within the 6-months' grace period, the registration of the industrial design lapses, in accordance with Section 25(4) of the Act. However, by virtue of Section 26(1) of the Act, the owner of the industrial design may apply for restoration of the registration of the industrial design within one year from the date on which the notice of lapse of the registration is published in the Intellectual Property Official Journal. It must be noted that restoration of the industrial design is purely at the discretion of the Registrar.

There are many ways for fashion designers to protect various aspects of a product. While the above discussion is primarily focused on industrial designs, it should give designers a perspective of this intellectual property option for their designs. As with any legal issue, each product will have unique protectable design features and functions – and will require different forms of protection. The form of protection a fashion designer may seek can depend on a variety of factors including the time to market, budget, and the type of protection required. It is always recommended that fashion designers seek advice from intellectual property experts as to how to best protect their products when entering the market.

GATEWAY IP SERVICES

PATENT, DESIGN, TRADEMARKS & GEOGRAPHICAL INDICATION AGENTS



Should you have any queries as to how the content of this article may affect you or your organization or should you require further information, please do not hesitate to email us.



Samantha Lawrence Pillai

Gateway IP Services Sdn. Bhd.

Emails: samantha.pillai@gatewayipasia.com
my@gateway-law.com

This article is intended to provide preliminary insights on industrial designs in Malaysia, and it is not intended to be comprehensive, nor should it be construed as legal advice. This article is updated as of 6 May 2021.