

## The Mind-Boggling Interplay of Copyright and Industrial Design Law

By Dave A Wyatt

While the courts of the Malaysian capital Kuala Lumpur remain the centre of gravity for IP disputes, it is encouraging to note growth in the number and scope of cases being decided in other states across the country. A recently reported decision of the Ipoh High Court makes for an interesting example.

The plaintiff commenced an action against the defendant seeking a declaration that two registered designs owned by the plaintiff, in respect of a water sprinkler and clipper, were protected under the Malaysian Copyright Act 1987.

The defendant then took action seeking indemnification from third parties on the ground that the defendant had purchased water sprinklers and clippers that were the subject of the original action from those third parties. One of the third parties applied to the Court for determination of a question of law as a preliminary issue under the Rules of Court. The question of law was whether the plaintiff was barred by Section 7(5) of the Copyright Act from seeking copyright protection for his designs that were registered under the Industrial Designs Act 1996. The action on the preliminary issue has been reported as *Oh Boon Thiam v Yan Ming Agricultural Sdn Bhd (Oh Yoke Choon & Anor, third party)* ([2017] 8 MLJ 265, hereafter the "Ipoh case").

Although the plaintiff opposed the third party application it was held that the question of law posed, if decided in favour of the third party, would dispose of the litigation without the need for a lengthy trial. It thus met the criteria of being a succinct, knockout point which was capable of being decided after only a relatively short hearing as per the UK's House of Lords in *CJ O'Shea Construction Ltd v Bassi*.

Section 7(5) of the Copyright Act declares that:

*Copyright shall not subsist under this Act in any design which is registered under any written law relating to industrial design.*

Since the plaintiff's designs had been registered under the Industrial Designs Act, it was clear that the plaintiff was of the view that his drawings of those two designs were indeed of "industrial designs". This position was further confirmed by the fact that the Registrar of Industrial Designs had seen fit to accept the designs for registration. Therefore, determination of the Section 7(5) question in favour of the defendant and third parties rendered the plaintiff's action for copyright unsustainable.

While the Ipoh case may seem to be black and white at first glance, the underlying legal provisions that determine the interplay of copyright and industrial design law in Malaysia are undoubtedly complex. Perhaps, we should be grateful for the dearth of local court decisions in this difficult area of law. The most famous local case was *Peko Wallsend Operations Ltd & Ors v Linatex Process Rubber Bhd* ([1993] 1 MLJ 225, hereafter "*Peko Wallsend*"). In that case the High Court had determined, under the provisions of the Copyright Act in force at the time, that a technical drawing was entitled to copyright protection as an artistic work irrespective of artistic quality. Moreover, the copyright was infringed by making an article according to the drawing, and by copying such an article. Thus, reverse engineering of an

article was actionable under copyright law, regardless of whether the design of the article was protected by way of registered design. As a result, copyright law at the time provided protection for three-dimensional products that was seemingly just as powerful and of even longer duration than was available through design registration.

When Malaysia's new design law, the Industrial Designs Act 1996 came into force on 01 September 1999, the opportunity was taken to amend the Copyright Act 1987 simultaneously. The effect of the amendments of the copyright law was to effectively remove industrial designs from the regime of copyright protection. Section 7(5) was plainly intended to deny cumulative protection under both industrial design and copyright law. Furthermore, under the newly-added Section 13A there could be no infringement of any copyright in a design document (such as a drawing) or model by making an article according to the design or copying such an article. This exception to copyright infringement is tied to making articles. It does not impugn the existence of any copyright in a design drawing. Such copyright is required to be recognized and protected under the Berne Convention for the Protection of Literary and Artistic Works of which Malaysia is a signatory. Thus, copyright in the drawing may be infringed by reproducing the drawing, for example in an advertisement, instruction manual and the like but is not infringed by making articles to the design. Protecting the latter was essentially reserved to the realm of registered design law.

Having said that, Section 13A is not confined to documents or models recording or embodying a registrable design but extends to any design other than for an "artistic work" or typeface, and comprising any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration. The reference here to "artistic work" is confusing to say the least as this is defined in the Copyright Act as including a drawing irrespective of artistic quality. It is believed the intended meaning was a narrower scope of work such as a sculpture or work of artistic craftsmanship.

Once one has gained an appreciation of the effect of Section 13A, to draw a line between what is protectable through copyright and what is protectable through design registration, in this author's view it is obscure what is the real purpose of Section 7(5). The "design" mentioned in that provision is not defined other than implicitly as one protectable under industrial design law. However, the exclusion of a "design" from copyright protection seems to be unnecessary when one considers that Section 7(1) already sets out the categories of works eligible for copyright and a "design" (whatever that means) is not among them. Presumably, Section 7(5) was added as an avoidance of doubt provision rather than out of legal necessity.

Section 7(6) elaborates that the phrase "any written law relating to industrial design" includes the former laws under which the protection afforded by a UK registered design extended to Malaysia. This seems to reinforce the policy behind Section 7(5) as an avoidance of doubt provision. It covers designs registered both before and after the Industrial Designs Act 1996 came into force.

Finally, one may wonder why the plaintiff in the Ipoh case sought to rely on copyright law when he owned two registered designs. A possible clue may be found in an earlier action in the same court: *Oh Boon Thiam t/a Chaille Polyfitting Trading v Oh Yoke Choon (P), Boey Kam Choy, Boey Jee Yung* ([2011] MLJU 459). In this earlier case, the plaintiff again owned a registered design yet this had been issued in 1998, prior to the changes to the Copyright Act that took effect on 01 September 1999. The transitional provisions of the Copyright Act set out clearly that any copyright that existed before the latter date was unaffected.

Copyright could thus still be infringed by making articles according to a design drawing as was established in *Peko Wallsend*. However, by the time of the subsequent action, the law had moved on and the plaintiff was not so lucky.