



2nd August, 2010

Mr. Azizan Mohamad Sidin
Director General,
Intellectual Property Corporation of Malaysia
Level 27, 29, 30 & 32, Menara Dayabumi,
Jalan Sultan Hishamuddin,
50623 Kuala Lumpur

Proposal on amendment and reform of Industrial Designs Act 1996

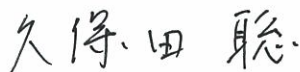
Dear Azizan Mohamad Sidin,

First of all, we would like to express our sincere gratitude for having always given your serious consideration to the opinions and requests of the Japanese business circle in Malaysia.

2. We take great pleasure in sending you **the proposal on amendment and reform of Industrial Designs Act 1996** for your reference in the future policy consideration.

3. We would appreciate it if you could peruse our proposal and give further considerations on amendment and reform of Industrial Designs Act 1996.

Yours respectfully,



Satoshi Kubota
Secretary General, Malaysia IPG
Deputy Managing Director, JETRO



Kenichi Osonoe
Project Leader on Strategy to Asian Countries
Japan Intellectual Property Association

CC: Mrs. Shamsiah Kamaruddin

Opinion for the draft proposal of revised Industrial Design Act

2nd August 2010

Japan Intellectual Property Association (JIPA)
Intellectual Property Group of Japanese Companies in Malaysia (IPG)

Hearing the explanation at Dialogue With Key Stakeholder On Proposed Amendment And Reform Of Industrial Design Act 1996 on 27th July 2010, we JIPA, IPG and JETRO would like to produce our opinion as follows:

Generally, we highly appreciate the big progress by this revision to strengthen the protection of industrial design right, which includes Worldwide novelty, 25 years protection period, 12 months grace period, Design of a part of a product, Design of component parts, Deliver up of infringing goods, and so forth. We would like to express sincere thanks for that.

At the same time, we also have some opinion to improve the proposed draft of the ACT and its implementation as follows:

1. [Section 13 (1) Design Protection]

(i) We would like to request that the term "**materials**" should be deleted from the Section 13 (1) of the proposed draft of the ACT, because, with that term included therein, the clause could be construed to protect the materials themselves.

(ii) The description of the visual effect, i.e. "**being features** which in the finished article **appeal to and are judged by the eye**" (Section 3 of the existing Act) has been deleted from the definition of an "industrial design", and replaced with the phrase "appearance". We would like to request that the description "being features ... appeal to and are judged by the eye" be put back where it was, because it makes the definition of an "industrial design" under the existing Act plain and clear enough to be used as a criterion for judging designs in dispute.

In the event that it is impossible to put back the phrase in the proposal draft of the ACT, we would request that it would be included in regulations, guidelines or the like.

(iii) There is the expression "As a whole **or in a part**" in the Section 13 of the proposed draft of the ACT. We would like you to make it clear that this means that MyIPO

accepts an application of not only whole article design but also a design of a part of the product. If a design application featured only of “a part of a product” is acceptable, we greatly appreciate it and welcome the revision.

2. [Section 13 (2) Design Protection]

We highly appreciate the adoption of Worldwide Novelty and welcome it. We hope that the draft proposal of the Act or the corresponding Regulation has clear stipulation that “worldwide” includes publication and disclosure in **internet**.

3. [Section 14 (8) Registrable Design]

(i) The Section 14 (8) of the proposed draft of the ACT includes a provision to the effect that design protection does not cover designs of parts used for the purpose of repair or maintenance (which can be construed to be similar to the spare parts clause in the EU Community Design Regulation). In the case of a complex product consisting of multiple component parts, the safety and recyclability of the product as a whole are maintained by means of such component parts. If the registrability of designs of parts used for the purpose of repair or maintenance is denied, it would be difficult to maintain the performance of the complex products, which might cause troubles to users.

For this reason, we would like to request that Section 14 (8) be deleted.

4. [Section 12 Registrable Industrial Design]

Basically we welcome the introduction of “**Individual Character**”. We hope this revision will reject similar design applications by third person who imitate the original. But also we hope that too much requirement for high creativity should be avoided. We hope appropriate and mild implementation with controlled objectivity.

5. [Others]

There is a clause related to Industrial Design in the present Copyright Act.

Copyright Act:

Section 7 (Works eligible for copyright.):

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

(6) Copyright in any design which is capable of being registered under any written law relating to industrial design, but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner

of the copyright or, with his license, by any other person.

These stipulations intend to avoid overlapped protection of IPR with Copyright and Design right. But, these clauses make loophole in IPR protection, and result imperfect IPR protection. Then, although this is not the matter of Industrial Design Act, we hope the deletion of Section 7 (5) and (6) of Copyright Act, related to industrial design matter.

Thank you very much in advance for your consideration.