

JETRO

Kuala Lumpur

(JAPAN EXTERNAL TRADE ORGANIZATION)
9th Floor, Chulan Tower, No. 3 Jalan Conlay, 50450 Kuala Lumpur,
MALAYSIA
Tel: 60-3-2171-6100 Fax: 60-3-2171-6077



日本知的財産協会

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

ASAHI SEIMEI OTEMACHI BLDG.18F
6-1 Otemachi 2-chome, Chiyoda-ku Tokyo, 100-0004, JAPAN
TEL: 81 3 5205 3321 FAX: 81 3 5205 3391

15th June, 2009

Mr. Kamel Mohamad
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 Mr. Kamel Mohamad

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,

Hiroshi Onomura
Secretary General, Malaysia IPG
Deputy Managing Director, JETRO

Tsuneaki Hagiwara
President
Japan Intellectual Property Association

CC: Assoc. Prof Rohazar Wati Zuallcoblely

Proposal on amendment and reform of Industrial Designs Act 1996

1. Definition of industrial designs:

- Exclude "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".
- We greatly appreciate MyIPO's proposal of "Must-Match" exception.
- In addition, we would like to request to stipulate the protection of "the partial design" or "design of a part of an article" in the Act.
- Japanese Designs Act has also been amended from January 1999.
- It is stipulated that "<Design> in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article (including a part of an article)..."

2. Novelty;

- Japanese industries have requested the adoption of "world-wide novelty".
- We greatly appreciate MyIPO's proposal as a big advance.
- Even though Japan is a member of Paris convention, Japanese industries are expanding, not only in the Japanese market, but also worldwide. Hence, from the perspective of international or ASEAN wide harmonization sooner or later, we would like to insist in "world wide novelty".
- If Malaysia needs technical support to adopt "world-wide novelty", we will ask for JPO's support.

3. Terms of protection;

- The proposal from MyIPO amending to maximum of 5 terms of 25 years makes it possible that the industry protect their long life product's design.
- For that reason, we greatly appreciate MyIPO's proposal.

4. Other issues;

1) Expansion of exception to novelty loss provision;

- In article 12 (3), Industrial designs act, the exception to novelty loss provision is applicable only to "it appeared in official or officially recognized exhibition" and "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".

- We would like to request to add to this provision "it has been voluntarily disclosed by the applicant through the Internet, at an exhibition, in the product launch announcement, etc".
- Nowadays, the design is greatly important as a user's decision factor. The industry has to research on whether the design concerned suits the demand of a market.
- In Japan, Philippines, EC and other countries loss of novelty provision is also applicable to the public-known design due to activities of applicant himself.

2) Introduction of publication postponement system;

- We would like to request to introduce the system where publication of a registered design in official gazette is deferrable based on a petition by an applicant.
- Although early granting of design right is preferable for applicant, however, disclosure of the drawings in the official gazette bring about negative effect, such as design concerned is exposed to an act of imitation before product sale because imitation of design is easy.

3) Adoption of injunction system at the border on industrial designs;

- In Malaysian IP relations act, only infringement of copyright and trademark right can be suspended for import at the border.
- Now many counterfeit products without trademark are imported and assembled in Malaysia.
- We would like to request for the adoption of the injunction system on designs also.