

Enforcement of Intellectual Property Rights (IPR)

MALAYSIA

1. INTRODUCTION TO IPR ENFORCEMENT IN MALAYSIA

The Laws Governing Intellectual Property in Malaysia are:-

- Patents Act 1983
- Trade Marks Act 1976
- Industrial Design Act 1996
- Copyrights Act 1987
- Geographical Indications Act 2000
- Layout Designs of Integrated Circuits Act 2000
- Plant Varieties Act 2004

Intellectual Property Rights in Malaysia may be enforced by instituting legal proceedings. All Malaysia IP Laws provide for civil action to be taken by the IP owners themselves. The remedies available are damages, injunctions, accounts of profits etc.

Criminal sanctions are available under the Copyrights Act 1987, Trade Description Act 1972 as well as Optical Discs Act 2000.

2. CIVIL IPR ENFORCEMENT

2.1. COMPETENT COURTS

The relevant Courts that hear enforcement of civil IPRs in Malaysia are the High Court, Court of Appeal and Federal Court.

2.1.1. First instance

High Court

2.1.2. Appeal

Court of Appeal and Federal Court

2.2. REMEDIES AVAILABLE (COMPENSATION, INJUNCTIONS - PRELIMINARY AND FINAL)

Various remedies that are available to the owner of the Intellectual Property (IP) for a suit of infringement are such as damages or accounts of profit, injunction, delivery up, order for disposal and any other legal remedies

2.3. EXECUTION OF COURT ORDERS

2.3.1. Local Court Orders

Parties in favour of whom the Court Order is made shall take the necessary action.

2.3.2. Overseas Court Orders

An application for reciprocal enforcement of judgments may be made by the relevant party to the High Court in accordance with the Reciprocal Enforcement of Judgments Act, 1958 and the High Court Rules 1980.

3. CRIMINAL IPR ENFORCEMENT

3.1. POLICE AUTHORITIES (COMMERCIAL, MARKET, ECONOMIC POLICE ETC.)

For Copyright matters, Section 41 of the Copyright Act 1987 provides a list of activities which if are carried out, would amount to an offence. Enforcement is carried out by the Assistant Controller of Copyright or police officers not below the rank of Inspector.

For false trade description matters, Assistant Controllers of Trade Descriptions are empowered to inspect and seize goods of such nature.

3.2. COMPETENT COURTS AND JURISDICTION (INCLUDING APPEAL)

For Copyright matters, Sessions Court is the competent court to hear offences on Copyright and appeals may go up to High Court, Court of Appeal and Federal Court.

An application for a Trade Description Order shall be made to the High Court.

3.3. PENALTIES

Examples of penalties may be seen from Section 41 of the Copyrights Act, 1987 as contained in *Annexure A*.

4. BORDER CONTROL

4.1. REGISTRATION PROCEDURE

Part XIVA of the Trade Marks Act, 1976 provides for Border Measures on issues of trademark particularly counterfeit trademark goods. An application for restriction of on importation of counterfeit trade marks goods may be made to the Registrar of Trade Marks via form TM 30 as attached. Enclosed as *Annexure B* is Part XIVA of the Trade Marks Act 1976 stipulating the procedures in such matters.

Additional Information:

Malaysia has a unique border measures provision where there are a few government agencies namely the Royal Customs Department, Enforcement Division of the Ministry of Domestic Trade & Consumer Affairs, the Royal Malaysia Police Department as well as the local authorities that are involved in enforcing IPR with regards to Trade Marks Act 1976, Copyrights Act 1987 and Trade Descriptions Act 1972. The Customs officers have jurisdiction to stop the importation of counterfeit trademark or pirated copyright goods at the point of entry, where these parallel powers are being provided for under the three respective legislations mentioned above.

4.2. REGISTRATION AUTHORITY

The Registrar of Trade Marks.

4.3. RELEVANT COURTS

High Court for purposes as specified in this Part XIVA.

4.4. REMEDIES (INJUNCTION)

Would be made based on the infringement suit brought by the owner of trade mark such as the seized goods be released to the importer, seized goods not to be released before a certain period of time or seized goods be forfeited and disposed as may be directed by the Court.

5. ADMINISTRATIVE IPR ENFORCEMENT

5.1. ROLE OF PATENT OFFICE (IF ANY)

The Registrar of Patents is responsible to grant patents as provided for under the Patents Act 1983 while the civil enforcement of IPR is entrusted with the owners.

5.2. RELEVANT COURTS

High Court, Court of Appeal & Federal Court.

6. COMMENTS

Malaysia is studying the establishment of an IP Court System.