

USING FONTS LEGALLY: AVOIDING COPYRIGHT INFRINGEMENT IN UNLICENSED FONTS

Introduction

In the world of design and branding, every detail counts, shaping not only how a brand looks but also how it is perceived. Yet, when it comes to fonts and typefaces, companies and designers often do not give this element the legal consideration it deserves. They might download a stylish font from the internet or a font-sharing platform, unaware that there could be licensing terms governing how, where, and by whom that font can be used. Due to a general lack of awareness, many companies unknowingly expose themselves to significant legal risks, which can result in costly disputes or even rebranding.

Fonts and Typefaces

Essentially, a font is a computer program that instructs your screen on how each letter or symbol should appear or tells your printer the exact shapes to print. Fonts are often installed through word-processing programs like Microsoft Word, which make them easily accessible and ready to use. A typeface, on the other hand, is a collection of fonts that share the same overall design or style. Think of a typeface as the “family name” for related fonts, describing the consistent look and feel of characters across different styles. In the digital era, the distinction between these two terms has become blurred, as many people use “font” to refer to what is technically a typeface. For example, although many people would call “Helvetica” a font, it is actually a typeface. Variations of Helvetica, such as Helvetica Regular, Helvetica Italic, Helvetica Bold, etc., are fonts.[1]

Copyright Protection for Fonts and Typefaces

(a) Font and Typeface Design – Copyright Protection as an ‘Artistic Work’

It is difficult to conclusively say that font and typeface design is copyrightable as an

“artistic work” in Malaysia. The Malaysian Copyright Act 1987 (“**CA 1987**”), does not explicitly recognize nor exclude font or typeface design with copyright protection as an “artistic work”. Furthermore, there seems to be no judicial guidance in Malaysia that has affirmatively established this too.

Section 3 of the CA 1987 defines “artistic work” as “(a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality; (b) a work of architecture being a building or a model for a building; or (c) a work of artistic craftsmanship...”. In **Siti Khadijah Apparel Sdn Bhd v Ariani Textiles & Manufacturing (M) Sdn Bhd [2019] 7 MLJ 478**, [2] the Court has established that if an ‘artistic work’ falls within the scope of a “graphic work”, the interpretation can be broad, as the CA 1987 is non-exhaustive in this regard.[3] Arguably, this allows for some flexibility in recognizing font and typeface design as an “artistic work”. Apart from this, on the surface, the presentation and design of a “typeface” may be construed as an “artistic craftsmanship”. However, there is limited judicial guidance in Malaysia as to the interpretation of “work of artistic craftsmanship”. [4]

The United Kingdom (“**UK**”)’s Copyright, Designs, and Patents Act 1988 (“**CDPA 1988**”) generally recognizes that typefaces may be copyrightable as “artistic work”. However, it can be said that such recognition, was due to the inclusion of Section 54 and Section 55 of the CDPA 1987.[5] While the Malaysian court may be inclined to apply the principles decided by the UK court to Malaysian case (more so when the definition provision of an “artistic work” under the CDPA 1988 are very similar to the CA 1987), there is no provision in CA 1987 which is in *pari materia* to Section 54 and Section 55 of CDPA 1988. Therefore, it is quite challenging to apply the principles decided in the UK to the Malaysian case.

Regardless of the above, some fonts and typefaces have been filed and recorded under the “artistic work” category in the Malaysian Intellectual Property Office (“**MyIPO**”)’s copyright registry. Yet, it is important to note that MyIPO’s Copyright Voluntary Notification (“**CVN**”) system is primarily procedural — as copyright protection subsists automatically in a work if the prerequisites are met, without the need for any formality or registration. In other words, the CVN does not necessarily confirm the subsistence of copyright[6] and it can still be challenged in Court. Therefore, the copyright status of fonts and typefaces as an “artistic work” in Malaysia remains open to debate.

(b) Font Software – Copyright Protection as a ‘Computer Program’

Bearing in mind that copyright can only subsist by virtue of the CA 1987, Section 3 and Section 7 of the CA 1987 provide for copyright to subsist in computer programs as literary works. Section 3 of the CA 1987 defines a “computer program” as follows:

“an expression, in any language, code or notation, of a set of instructions (whether with or without related information) intended to cause a device having an information processing capability to perform a particular function either directly or after either or both of the following:

(a) conversion to another language, code or notation;

(b) reproduction in a different material form;"

Since the expression can be in any language, code or notation, it has been held by the Court of Appeal in ***Petraware Solutions Sdn Bhd & Anor v Readsoft Aktiebolag & Anor [2014] 1 AMCR 112***[7] that a computer program is sufficiently broad to encompass both its source code, object code, and any set of instructions in whatever converted form which could be read by a computer.[8] Therefore, insofar as the font qualifies as computer software (which is often the case), the software code that generates digital typefaces is generally copyrightable.[9]

Understanding Font Licensing

Font licensing is a crucial aspect of using fonts legally, as fonts are primarily a software product and, like other software, they are subject to licensing agreements. Font licensing refers to the permissions granted by the font's creator or foundry, defining how the font can be used. There are several types of font licenses, each with different terms:

(a) Free for Personal Use: This license allows users to install and use the font for non-commercial, personal projects, such as personal blogs, invitations or personal social media graphics. However, this type of license restricts the font from being used in any business-related or commercial context.

(b) Free for Personal & Commercial Use: With this license, users can use the font in both personal and commercial projects without the need for a paid license. This license is less common, as it grants extensive permissions for free, often resulting in more restrictions on usage scope to protect the creator's work.

(c) Requires the Purchase of a License: Many fonts require users to buy a license before using them in either personal or commercial projects. Purchased licenses come with defined terms, which may limit the number of users, devices or distribution channels, such as print, web, or mobile applications. Some licenses cover only one use, like website embedding, while others offer options for multiple uses.

Best Practices for Ensuring Legal Font Use

To avoid the potential legal pitfalls of font misuse, adopting best practices for font licensing is essential. Here are some steps to ensure that fonts are used legally and responsibly:

(a) Take the time to read the fine print, verify where and how the font can be used, and ensure that your intended use complies with the license. It is crucial to confirm and fully understand the licensing terms of any font before using it.

(b) Maintaining documentation for font licenses and purchase histories is invaluable. This

documentation can include purchase receipts, license agreements, and any correspondence with the font provider.

(c) It is also crucial to consider using reputable and trusted font libraries and licensing platforms, as these platforms typically offer clear licensing terms and a wide range of options.

(d) When licensing fonts, it can sometimes be more practical to obtain a license for the entire typeface family. This way, you have access to a range of fonts — bold, italic, and more — within the same design style.

What to Do If You've Used Fonts Without a License

If you realise that you have used a font without proper licensing, taking proactive steps can help minimise potential legal consequences and future risks.

(a) Conduct a self-audit of all the fonts you have used in projects to identify unlicensed fonts. Once you have pinpointed instances of unlicensed use, contact the font creators or foundries to explain the situation. Many font creators allow retroactive licensing fees, which enable you to correct the oversight without severe penalties. Taking the initiative to resolve the matter shows good faith and reduces the likelihood of legal repercussions. If you need to replace unlicensed fonts, consider transitioning to legally compliant alternatives.

(b) Consulting an intellectual property lawyer can help you understand any legal liabilities. If you receive a letter or threat of infringement from a font owner, an intellectual property lawyer may assist to assess the legal merits of the claim. In addition to this, if you have engaged a creative agency, an intellectual property lawyer may assist in negotiating with the agency to make sure it has the proper font licenses, clarify font usage rights and at the very least, to ensure that you are indemnified for any claims of misuse of a font.

Conclusion

In conclusion, font licensing plays a crucial role in ensuring that the rights of font creators and foundries are respected, while also protecting companies and designers from potential legal risks. By understanding the importance of licensing, companies and designers can ensure they respect the intellectual property rights of font creators while safeguarding their own projects from potential infringements.

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1. Ross Kimbarovsky, 'The Law on Fonts and Typefaces in Design and Marketing: Frequently Asked Questions (about Commercial and Non-commercial Use)' (Crowdspring, 19 September 2023) <https://www.crowdspring.com/blog/font-law-licensing/> accessed 5 November 2024.
 2. Siti Khadijah Apparel Sdn Bhd v Ariani Textiles & Manufacturing (M) Sdn Bhd [2019] 7 MLJ 478.

3. Ibid.
4. Ibid.
5. Copyright, Designs and Patents Act 1988, s 54 & s 55.
6. Rock Records v Audio One Entertainment [2005] 3 MLJ 552.
7. Petraware Solutions Sdn Bhd & Anor v Readsoft Aktiebolag & Anor [2014] 1 AMCR 112.
8. Creative Purpose Sdn Bhd & Anor v Integrated Trans Corp Sdn Bhd & 2 Ors [1997] 2 MLJ 429, HC; Onestop Software Solutions (M) Sdn Bhd & Anor v Masteritec Sdn Bhd & 2 Ors [2009] 8 MLJ 528, HC.
9. It is also important to note that copyright protection provides a different form of protection for fonts compared to trademark law. Trademark law safeguards only the name of a typeface, such as "Cooper Black" or "Helvetica," and does not extend to the actual design or appearance of the font itself.

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