

ENFORCING YOUR INTELLECTUAL PROPERTY (IP) RIGHTS THROUGH THE COURT SYSTEM: WHAT DO IP OWNERS NEED TO KNOW?

Introduction

Intellectual property ("IP") are intangible assets and their intangible nature can often times make them imperceptible. Be that as it may, IP are all around us be it in the more obvious forms such as branding and publications or in more obscure forms such as simple but new ways to solve problems.

As we have highlighted above, IP are assets. Hence, like any other assets, they have commercial value. They can be leveraged in one way or another to generate income. It is for this very reason that protecting IP rights is crucial. This article aims to highlight the rights of IP owners and how they can enforce these rights through the Malaysian courts.

Registration with MyIPO

The first but perhaps most crucial thing that any IP owner must know is that registration of IP with the Malaysian Intellectual Property Corporation (MyIPO) is often times a prerequisite to be able to enforce IP rights. Exceptions to registration of IP can be seen for:

- copyright which protects among others literary, musical and artistic works. However, as good practice, a copyright owner can submit a copyright voluntary notification to MyIPO; and
- unregistered trademarks where under Section 159 of the Trademarks Act 2019, the owner of an unregistered trademark shall still have the right to take action under passing off i.e., the act of representing one person's goods or services as another person's.

To successfully register an IP with MyIPO, an IP owner will have to satisfy certain criteria which vary depending on the type of IP in question. An application to register the IP will be scrutinised by the relevant MyIPO officer before an evaluation is made.

Duration of Protection

Another crucial point for IP owners to know is that their IP rights do not last forever. Each type of IP has a specific timeframe for protection. Thus, it is crucial for IP owners to be aware of the duration of protection of their IP and take necessary steps to enforce their rights timeously.

The types of IP, their brief descriptions and the duration of protection for each IP as per the relevant Malaysian legislations are highlighted in the table below:

| Type of IP | Description of IP | General Protection Duration |
|--------------------------|---|---|
| Copyrights | Literary, musical and artistic works, films, sound recordings, etc. | Subsists until the expiry of 50 years after the death of the author. <i>Section 17 of the Copyright Act 1987</i> |
| Trademarks | Brand logo, labels, names, signatures, stylised words, etc. | 10 years from registration and may be renewed for further periods of 10 years. <i>Section 39 of the Trademarks Act 2019</i> |
| Geographical Indications | Sign used on products that have a specific geographical origin. Ex.: Sarawak pepper, Columbian coffee, etc. | 10 years from registration and may be renewed for further periods of 10 years. <i>Section 18 of the Geographical Indications Act 2022</i> |
| Industrial Designs | Features of shape, configuration, pattern by any individual process. Ex.: The Coca-Cola bottle | 5 years from registration and may be extended for 2 further consecutive terms of 5 years each. <i>Section 25 of the Industrial Designs Act 1996</i> |
| Patents | A product or process invention that provides a new way of doing something or offers a new solution. | 20 years from the filing of the application. <i>Section 35 of the Patents Act 1983</i> |
| Utility Innovations | A minor invention similar to patents but not requiring inventiveness. | 10 years from the filing of the application and may be extended for an additional period of 5 years and a second period of 5 years. <i>Modifications to Section 35 of the Patents Act 1983</i> |

Claims in the Courts

We now delve into another crucial aspect that IP owners need to know and that is, how IP rights can be enforced in the Malaysian Courts. Where the Courts are concerned, IP owners may be able to enforce their rights through criminal and/or civil actions.

Criminal actions in respect of IP are taken by the relevant authorities against persons who misuse another's IP. Where a criminal action is successful, the persons who had misused the IP may be subjected to fine or penalty. IP owners may lodge complaints with the Ministry of Domestic Trade and Cost of Living (MDTCOL) if a party misuses their IP. This will allow MDTCOL to make the necessary investigations and take the necessary actions.

Civil actions in respect of IP on the other hand, are actions that can be taken by IP owners against persons who misuse their IP. Through civil actions, an IP owner can seek for orders that prohibit these persons from misusing the IP and to compel them to among others, destroy any products or material that infringe said IP. An IP owner can also claim damages which are compensation for the misuse of their IP.

Conclusion

As far as enforcing IP rights are concerned, IP owners should bear in mind that certain IP require registrations with MyIPO and have limited durations of protection. Where registered and under the duration of protection, IP owners may enforce their IP rights in Court either through lodging complaints in respect of misuse of IP or through the commencement of a civil action. Enforcing these rights is crucial in order to ensure that IP owners protect and make good use of their exclusive rights to the IP.

Written by:



Ammera Hadi
Senior Associate
ammera@azmilaw.com

Corporate Communications
Azmi & Associates
07 October 2024